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TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1883.

No. ~~944~~ 257 21

THEODORE T. WHITE, WILLIAM A. GORDON, AND EMMET C. PECOR, APPELLANTS,

vs.

GEORGE H. DUNBAR, FRANCIS B. DUNBAR, AND CHARLOTTE Z. DUNBAR.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE EASTERN DISTRICT OF LOUISIANA.

FILED AUGUST 16, 1883.

SUPREME COURT OF THE UNITED STATES.

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THEODORE T. WHITE, WILLIAM A. GORDON, AND EMMET C. PECOR, APPELLANTS,

vs.

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A UNITED STATES OF AMERICA.

Circuit Court of the United States in and for the 5th judicial circuit and eastern district of Louisiana.

GEORGE H. DUNBAR et als.
vs.
T. T. WHITE et al. } No. 9858.

Messrs. Albert H. Leonard and J. W. Gurley, solicitors for Geo. H. Dunbar et als., complainants, appellees.

Messrs. Joseph P. Hornor and F. W. Baker, solicitors for T. T. White et al., respondents, appellants.

Appeal.

Returnable to the Supreme Court of the United States on the second Monday of October, A. D. 1883.

1 UNITED STATES OF AMERICA.

Circuit Court of the United States for the fifth judicial circuit and eastern district of Louisiana.

GEORGE H. DUNBAR et als.
vs.
T. T. WHITE et al. } No. 9858.

Bill of Complaint and Order thereon.—Filed March 15th, 1882.

To the honorable the Judges of the Circuit Court of the United States for the eastern district of Louisiana, in the fifth circuit:

George H. Dunbar, Francis P. Dunbar, and Charlotte Z. Dunbar, residents of the city of New Orleans, Louisiana, bring this their bill against Theodore T. White, William A. Gordon, and Emmett C. Picor, of the city of New Orleans, State of Louisiana.

And thereupon your orators complain and say:

That heretofore, and on or about the 14th day of January, A. D. 1876, George W. Dunbar, George H. Dunbar, and Francis B.
2 Dunbar were the true, original, and first inventors or discoverers of a certain new and useful invention, to wit, a new and useful improvement in preserving shrimps in metals cans, not known or used by others before their invention or discovery thereof, and not at the time of the application of letters patent therefor in public use or sale with their consent.

That on or about the 1st day of February, A. D. 1876, and prior to the death of said George W. Dunbar, the said George W. Dunbar and your orators, George H. Dunbar and Francis B. Dunbar, made application, in writing, to the Commissioner of Patents of the United States for the granting of letters patent of said invention, and paid into the Treasury of the United States the fees required by law, and then and there also duly complied in all other respects with all the necessary conditions and requirements of the statutes of the United

States in such case made and provided, prior to the granting of the letters patent hereinafter mentioned.

3 That on due proceedings had in the court having jurisdiction of the estate of George W. Dunbar, deceased, and of the administration thereof, James T. Emerson was duly appointed administrator of the estate of said George W. Dunbar, and duly qualified as such administrator.

That on the twentieth (20th) day of June, A. D. 1876, and during the life of said George W. Dunbar, letters patent of the United States, bearing date on that day, were issued to the said George W. Dunbar and to your orators, George H Dunbar and Francis B. Dunbar, according to law, whereby was granted to them, their successors or assigns, for the term of seventeen years from the 20th June, A. D. 1876, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the invention or discovery aforesaid, a description whereof was given in the words of said George W. Dunbar and your orators, George H. and

4 Francis B. Dunbar, in the schedule annexed to and made part of said letters patent; said invention or discovery being "a new and useful improvement in preserving shrimps in metal cans."

That said letters patent were issued in the name of the United States of America, and were signed by the Acting Secretary of the Interior, and were countersigned and sealed with the seal of the Patent Office by the Commissioner of Patents, and were numbered 178,916, and were issued and delivered to the said George W. Dunbar and your said orators, George H. and Francis B. Dunbar.

That thereupon, after the issuing of the said letters patent, the said George W. Dunbar and your said orators, George H. and Francis B. Dunbar, put the said invention into use, and same is now, and for years has been, in the exclusive use and possession of your orators.

And your orators pray that said letters patent, and the schedule thereto annexed as aforesaid, may be deemed and taken as a

5 part of their bill; and to the originals of said letters patent and schedule, or a duly authenticated copy thereof now in your orators' possession and ready to be produced, they crave leave to refer.

And your orators further show to your honors that on or about the sixth day of December, A. D. 1881, said George W. Dunbar being then deceased, his administrator, the said James T. Emerson, and your orators, George H. Dunbar and Francis B. Dunbar, finding that said letters patent No. 178,916 were inoperative by reason of a defective or insufficient specification, and the said error having arisen by inadvertency, accident or mistake, and without any fraudulent or deceptive intention on the part of the said George W. Dunbar, or on part of your said orators, George H. and Francis B. Dunbar, the said Emerson, administrator, and your orators, George H. and Francis B. Dunbar, surrendered said letters patent to the Commissioner of Patents, according to the statutes of the United

6 States in such case made and provided; and having amended

the specification of claim in accordance with the decision of said Commissioner in the premises, and having paid the fees prescribed by and in all other things having complied with the statutes of the United States in such case made and provided, new letters patent (a reissue) of the United States for the same invention were, on the 6th day of December, A. D. 1881, issued and delivered to the said Emerson, adm'r, and to George H. Dunbar and Francis B. Dunbar, whereby was granted to them and their successors or assigns for the then unexpired term of seventeen years from the 20th June, 1876, the full and exclusive right and liberty of making, constructing, using, and vending said invention or discovery of "a new and useful improvement in preserving shrimps in metal cans;" a description whereof was given in the words of said Emerson, adm'r, and of said George H. Dunbar and said Francis B. Dunbar in
7 the schedule annexed to said reissued letters patent. That said new letters patent were issued in the name of the United States, and were signed by the Acting Secretary of the Interior, and were countersigned and sealed with the seal of the Patent Office by the Acting Commissioner of Patents, were numbered 9957, and were issued and delivered to the said Emerson, administrator, and to George H. Dunbar and Francis B. Dunbar, who thereupon put the said invention into use through your orators, and same has since been and now is in their exclusive use and possession.

And your orators pray that the said reissued letters patent and the schedule thereto annexed may be deemed and taken as a part of their bill; and to the originals of said reissued letters patent and schedule, or a duly authenticated copy thereof now in their possession ready to be produced, they crave leave to refer.

8 And your orators say that the said George W. Dunbar died on the 5th day of June, A. D. 1878, leaving as his heirs and representatives his surviving widow in community, your oratrix Charlotte Z. Dunbar, and his children, your orators George H. Dunbar and Francis B. Dunbar, and their sister Emilie M. Dunbar.

That subsequent to the issuance of said reissued letters patent the said James T. Emerson, administrator of the estate of George W. Dunbar, deceased, transferred and assigned all the interest of the said estate in said letters patent to your orators and to said Emeline Dunbar; that said Emilie M. Dunbar transferred and assigned all her interest therein to your orators George H. Dunbar and Francis B. Dunbar, and that all the interest of the said George W. Dunbar in said invention or discovery is now owned and possessed exclusively by your orators.

And your orators say that during the life of said George W. Dunbar, he, the said George W. Dunbar, and your orators, George
9 H. Dunbar and Francis B. Dunbar, and since the death of said George W. Dunbar the administrator of his estate and the heirs thereof, until said assignments hereinbefore set forth, and since then your orators have been, and your orators now are, entitled to all the rights, interests, and privileges in and to the said invention or discovery in the said letters patent particularly set forth,

and ever since the date thereof have been entitled to the exclusive use of the said invention and improvement within the limits aforesaid.

And your orators further show unto your honors that the said invention or discovery, so patented as aforesaid, is of very great utility, and that the same has been extensively introduced into public use; that the public have generally acquiesced in the exclusive right of your orators to same; that your orators have made extensive sales of shrimp preserved in metal cans by means of their new and useful improvement patented as aforesaid, and have derived there-
10 from large gains and profits.

And your orators further show unto your honors, upon information and belief, that the said defendants, well knowing the premises and the rights and privileges secured unto your orators, and in order to deprive your orators of the profits, benefits, and advantages which might and otherwise would have accrued to them at New Orleans and within the said eastern district of Louisiana, and without the license or permission of your orators, have, since the 1st day of March, A. D. 1882, unlawfully used the improvement in preserving shrimps in metal cans, so as aforesaid exclusively granted, as hereinbefore set forth by said letters patent, and have since said 1st of March, A. D. 1882, preserved shrimps in metal cans by the means and processes constituting the new and useful improvement set forth in said letters patent and schedule or specifications thereto an-
11 nexed, and have sold same, to the damage of your orators and in violation of their rights.

That said defendants are, and have been since said 1st March, A. D. 1882, preserving shrimps in metal cans by providing the cans by them used with a lining to prevent direct contact of the shrimps with the metal, and by placing the shrimps in the lined cans while they are in a dry or moist condition and devoid of free liquor or gravy; sealing the cans without adding any liquid to their contents and cooking the contents of the cans after sealing, which means and process are those invented or discovered by said George W. Dunbar, deceased, and by your orators, George H. Dunbar and Francis B. Dunbar, and constitute the new and useful improvement in preserving shrimps, for which letters patent were issued and reissued, as hereinbefore set forth.

And your orators aver that the defendants, though requested to desist from such unlawful use, and to account for and pay
12 over to your orators such gains and profits as they have actually made, refuse so to do; by means whereof your orators are, and have been, greatly injured, and are deprived and prevented from receiving the gains and profits to which they are lawfully entitled from the exclusive rights and privileges granted and secured to them as aforesaid, and which they would have derived and acquired, and would now derive and acquire, but for the wrongful acts of the said defendants.

And your orators pray that the said defendants be compelled, by a decree of this honorable court, to account for and pay over unto your orators all such gains and profits as have accrued, or arisen to,

or been earned, or received by the said defendants, and all such gains and profits as your orators would have received but for the said wrongful acts and doings of the said defendants; and all
13 such damages as your orators have sustained thereby. And that this honorable court will assess the same, or cause them to be assessed under its direction, and will increase same in its discretion as provided by law.

And that defendants, their associates, attorneys, solicitors, clerks, servants, agents, and workmen, may be perpetually enjoined and restrained by the decree of this court from directly or indirectly making or causing to be made, using or causing to be used, in any manner, the said invention granted by said letters patent as issued aforesaid; and from infringing upon or violating the said letters patent by the use or sale of shrimps preserved in metal cans by means of said improvement so as aforesaid patented; and that said defendants may be decreed to pay the costs, charges, and disbursements of this suit, and that your orators may have such other relief as the equity of the case may require and to your honors may seem meet.
14 To the end, therefore, that said defendants may, if they can, show why your orators should not have the relief hereby prayed, and may full, true, direct, and perfect answer make, according to the best of their, or their clerks', agents', or workmen's knowledge, remembrance, information, and belief to the several matters hereinbefore averred and set forth as fully and particularly as if the same were here repeated paragraph by paragraph, and they were thereto severally and specifically interrogated:

May it please your honors to grant to your orators writs of *subpœna ad respondendum* issued out of and under the seal of this honorable court, directed to the said defendants, Theodore T. White, William A. Gordon, and Emmet C. Picor, commanding them, and each of them, to be and appear and make answer unto this bill of complaint, and to perform and abide by such order and decree
15 herein as to this court may seem required by the principle of equity and good conscience.

May it also please your honors to grant to your orators a provisional or preliminary injunction issuing out of and under the seal of this honorable court, enjoining and restraining the defendants, their attorneys, solicitors, associates, clerks, servants, workmen, and agents, to the same purport, tenor, and effect hereinbefore prayed for in regard to said perpetual injunction.

And your orators will ever pray, &c.

(Signed) GEO. H. DUNBAR.
(") F. B. DUNBAR.
(") CHARLOTTE Z. DUNBAR.

(Signed) A. H. LEONARD,
Complainants' Solicitor.

UNITED STATES OF AMERICA, }
Eastern District of Louisiana. }

On this 15th day of March, A. D. 1882, before me came George

H. Dunbar, Francis B. Dunbar, and Charlotte Z. Dunbar, who, being by me duly sworn, did depose and say they are the complain-
16 ants in the foregoing bill of complaint named; that they have read said bill subscribed by them and know the contents thereof, and that same is true of their own knowledge, except as to matters which are therein stated to be on information and belief, and as to those matters they believe it to be true.

(Signed) GEO. H. DUNBAR.
F. B. DUNBAR.
CHARLOTTE Z. DUNBAR.

Sworn to and subscribed before me on this day, 15th of March, A. D. 1882.

(Signed) F. V. COUPLAND,
U. S. Commissioner.

Let the defendants show cause on the 25th day of March, A. D. 1882, at 11 o'clock a. m., why the injunction should not be granted *pendente lite* as prayed for in the within bill.

March 15th, A. D. 1882.

(Signed) EDWARD C. BILLINGS, *Judge.*

17 *Letters Patent* ("*Exhibit A*") *referred to in and made part of the foregoing bill.—Filed March 15th,* 1882.

[2—175.]

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE.

To all persons to whom these presents shall come, greeting:

This is to certify that the annexed is a true copy from the records of this office of the letters patent granted George W., George H., and Francis B. Dunbar, June 20th, 1876, No. 178916, for improvement in methods of preserving shrimps and other shell-fish.

In testimony whereof, I, E. M. Marble, Commissioner of Patents, have caused the seal of the Patent Office to be hereunto affixed this thirty-first day of March, in the year of our Lord one thousand eight hundred and eighty-one, and of the Independence of the
18 United States of America the one hundred and fifth.

(Signed) E. M. MARBLE,
Commissioner.

[No. 178,916.]

THE UNITED STATES OF AMERICA.

To all whom these presents shall come:

Whereas George W. Dunbar, George H. Dunbar, and Francis B. Dunbar, of New Orleans, Louisiana, have presented to the Commissioner of Patents a petition praying for the grant of letters patent for

an alleged new and useful improvement in methods of preserving shrimps and other shell-fish, a description of which invention is contained in the specification of which a copy is hereto annexed and made a part hereof, and have complied with the various requirements of law in such cases made and provided; and

Whereas, upon due examination made, the said claimants are adjudged to be justly entitled to a patent under the law:

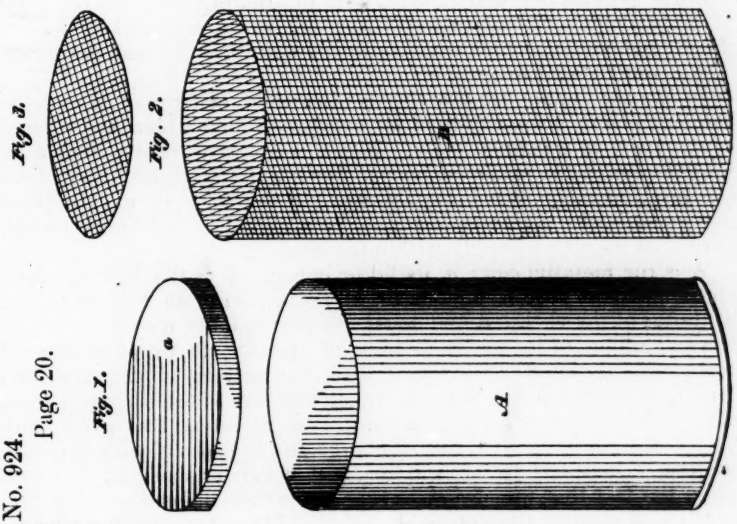
19 Now, therefore, these letters patent are to grant unto the said George W., George H., and Francis B. Dunbar, their heirs or assigns, for the term of seventeen years from the twentieth day of June, one thousand eight hundred and seventy-six, the exclusive right to make, use, and vend the said invention throughout the United States and the territories thereof.

In testimony whereof, I have hereunto set my hand and caused the seal of the Patent Office to be affixed, at the city of Washington, this twentieth day of June, in the year of our Lord one thousand eight hundred and seventy-six, and of the Independence of the United States of America the one hundredth.

[SEAL.] CHAS. T. GORHAM,
Acting Secretary of the Interior.

Countersigned—
R. H. DUELL,
Commissioner of Patents.

G. W., G. H., and F. B. Dunbar.—Method of preserving shrimps
20 *and other shell-fish.—No.* 178,916.—*Patented June* 20, 1876.



No. 924. Page 20.

Witnesses:
H. N. JENKINS.
J. C. HUBBELL.

Inventors:
G. W. DUNBAR.
GEO. H. DUNBAR.
F. B. DUNBAR.

UNITED STATES PATENT OFFICE.

George W. Dunbar, George H. Dunbar, and Francis B. Dunbar, of New Orleans, Louisiana.

Improvement in methods of preserving shrimps and other shell-fish.

Specification forming part of letters patent No. 178,916, dated June 20th, 1876; application filed February 1, 1876.

To all whom it may concern:

Be it known that we, George W. Dunbar, George H. Dunbar, and Francis B. Dunbar, residents of the city of New Orleans and
21 State of Louisiana, have invented a certain new and useful improvement in linings for cans; and we do hereby declare the following to be a full, clear, and correct description of the same, reference being had to the annexed drawing, making a part of this specification.

The object of our present invention is to provide an improved method of preserving shrimps or prawns, and, indeed, all kinds of shell-fish, preventing their discoloration, and insuring the retention of their original freshness and flavor.

Primarily, our improvement consists in so placing a suitable textile fabric between the fish or other article of food to be preserved as to cause it to intervene as to prevent, under all circumstances, any direct contact between the metallic surface of the can and its contents; and it is the employment of such textile fabric, in connection with the process hereinafter described, of treating the fish or other
22 article, both before and after the same is placed in the can and sealed, which constitutes the nature or subject-matter of our present invention.

In the accompanying drawing is illustrated, at figure 1, a metallic can, such as is ordinarily used for articles of food which are offered to the trade in a canned state. Fig. 2 is a textile lining, which we propose usually to make (although there is nothing arbitrary about the form, as other forms may be used,) in the form of a cylindrical bag or sack, the diameter of which, when filled, is to be such as will permit of its fitting snugly within the can.

A is the metallic can; *a*, its lid or cover. B is the bag or sack, constructed of cotton, muslin, or any other suitable textile fabric. Material of the cheapest and most inferior quality may be used, as the sole object of its use is to prevent the article to be preserved from coming in direct contact with the surface of the can, and
23 which contact with the metal, in the case of the shrimp, causes, during the process of boiling, and all along thereafter until the can is opened, a profuse precipitation of a black substance, generally believed to be sulphur, and which supposition is based upon the fact that the shrimp is said to possess a much larger proportion of sulphur than other shell-fish. The substance thus precipitated not only discolors the fish, (shrimp,) but detracts much from

the color, freshness, and richness of its flavor. Now, practical experience has fully demonstrated the fact that, by using a textile fabric as described, the precipitation of the substance alluded to is prevented, or at least does not appear either on the fabric or metal; hence the value and importance of this feature of our invention. *b*, Fig. 3, is a circular piece cut out of material similar to that of which the bag B is made, and which is inserted within the mouth of the latter after the same is filled with the fish or other article to be preserved.

Such a can and lining, as herein described, are admirably adapted for the purpose attained by our present invention; but, as before stated, there is nothing arbitrary about the peculiar form or construction of the textile fabric lining, as other forms and arrangements might be substituted therefor without in any manner altering the principle of the invention.

Having now fully described, as it were, the mechanical features of the invention, we will briefly state the process employed in connection therewith, especially when shrimps are the articles to be preserved.

The shell having been removed from the shrimp in the usual manner, the fish is thrown into salt water of about six degrees, and there remains for an hour, more or less, and from thence to kettles filled with water and brought to a boiling heat, after which they are placed on drippers, and cooled and thoroughly rinsed with fresh cold water, and from which, so soon as thoroughly dripped, in a moist condition, they are placed in the sack B, the same having been previously arranged in the can A, and without the addition of any salted or otherwise prepared liquid. So soon as the sack is filled, the mouth thereof being properly secured, the lid or head *a* is placed in position on the can A and immediately sealed.

The cans are then subjected to a steam bath, or placed in kettles containing boiling water, and boiled for two hours at the highest temperature attainable, and which completes the process.

What we claim as new and desire to secure by letters patent is—

The herein-described method of preserving shrimps, &c., preventing their discoloration, which consists in placing textile fabric between the can and its contents, and then sealing the can and subjecting the same to a boiling process, substantially as and for the purpose specified.

G. W. DUNBAR.
GEO. H. DUNBAR.
F. B. DUNBAR.

Witnesses:
H. N. JENKINS.
T. J. ROACH.

Letters Patent (reissue), "Exhibit B," referred to in and made part of the foregoing bill.—Filed March 15th, 1882.

REISSUE.

The United States of America.—No. 9957.

To all to whom these presents shall come:

Whereas James F. Emerson, (administrator of George W. Dunbar, deceased,) of Wakefield, Massachusetts, and George H. Dunbar and Francis B. Dunbar, of New Orleans, Louisiana, have presented to the Commissioner of Patents a petition praying for the reissue of letters patent for an alleged new and useful improvement in preserving shrimps in metal cans, for which letters patent were issued
27 to said George W. Dunbar, George H. Dunbar, and Francis B. Dunbar, dated June 20th, 1876, which letters patent having been surrendered the same have been cancelled and new letters ordered to issue to said James F. Emerson, as administrator, and George H. Dunbar and Francis B. Dunbar, on an amended specification, a description of which invention is contained in the specification of which a copy is hereunto annexed and made a part hereof, and have complied with the various requirements of law in such cases made and provided; and

Whereas, upon due examination made, the said claimants are adjudged to be justly entitled to a patent under the law—

Now, therefore, these letters patent are to grant unto the said James F. Emerson, as administrator, his successor or assigns, George H. Dunbar and Francis B. Dunbar, their heirs or assigns, for the term of seventeen years from the twentieth day of June, one thousand eight hundred and seventy-six, the exclusive right to make,
28 use and vend the said invention throughout the United States and the territories thereof.

In witness whereof, I have hereunto set my hand and caused the seal of the Patent Office to be affixed, at the city of Washington, this sixth day of December, in the year of our Lord one thousand eight hundred and eighty-one, and of the Independence of the United States of America the one hundred and sixth.

[SEAL.] (Signed) A. BELL,
Acting Secretary of the Interior.

Countersigned:
(Signed) V. D. STOCKBRIDGE,
Acting Commissioner of Patents.

G. W. DUNBAR, dec'd, and G. H. & F. B. DUNBAR; J. F. EMERSON, administrator.

Preserving shrimps in metal cans.—No. 9957. Reissued Dec. 6, 1881.

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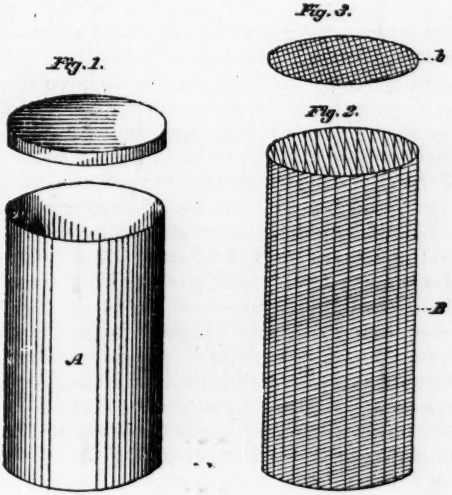


Witnesses:
H. G. WADLIN.
W. CLIMO.

JAMES F. EMERSON,
Administrator of estate of G. W. Dunbar.
GEORGE H. DUNBAR,
FRANCIS B. DUNBAR,
Surviving Joint Inventors.
By WRIGHT & BROWN, *Att'ys.*

UNITED STATES PATENT OFFICE.

James F. Emerson, (administrator of George W. Dunbar, deceased,) of Wakefield, Massachusetts, and George H. Dunbar and Francis B. Dunbar, both of New Orleans, Louisiana.

Preserving shrimps in metal cans. Specification forming part of reissued letters patent No. 9957, dated December 6th, 1881.

Original No. 178,916, dated June 20, 1876. Application for reissue filed April 9, 1881.

To all whom it may concern:

30 Be it known that George W. Dunbar, George H. Dunbar and Francis B. Dunbar, residents of the city of New Orleans,

[5] and State of Louisiana, did, during the lifetime of said George W. Dunbar, invent a certain new and useful improvement in methods of preserving shrimps in metal cans; and we do hereby declare the following to be a full, [10] clear, and correct description of the same, reference being had to the annexed drawings, making a part of this specification.

The object of our present invention is to provide an improved method of preserving shrimps [15] or prawns, and, indeed, all kinds of shell-fish, preventing their discoloration and insuring the retention of their original freshness and flavor.

In canning the shrimps [20] or prawns we have found that direct contact of the shrimps with the can and the presence of free liquid or gravy in the shrimps, after they are placed in the cans, are very [3] objectionable, for the following reasons:

31 [25] First. The direct contact of the shrimps with the can causes, during the process of cooking and thereafter, a precipitation of black or dark matter which discolors the shrimps and detracts from their flavor and richness. [30] This precipitation is believed to be caused by the action of sulphur contained in the shrimps on the metal of the can.

Second. Free liquid or gravy in the shrimps constitutes a vehicle [35] or medium to diffuse the dark precipitate or coloring matter throughout the entire mass of shrimps in the can, so that all portions of the contents of the can are equally affected and discolored.

Our invention has for its [40] object to obviate the above-named objections; and it consists in first providing the can with a lining to prevent direct contact of the shrimps with the metal, and, second, placing the shrimps in the lined can while they are in a dry or moist condition [45] and devoid of free liquid or gravy, sealing the

32 can without adding any liquid to its contents, and cooking the contents of the can after sealing, all of which we will now proceed to describe.

[50] In the accompanying drawings is illustrated, at Figure 1, a metallic can, such as is ordinarily used for articles of food which are offered to the trade in a canned state. Fig. 2 is the lining, which we propose usually to make in the [55] form of a cylindrical bag or sack, the diameter of which, when filled, is to be such as will permit of its fitting snugly within the can. Fig. 3 represents a circular mouth-piece for said lining.

[60] A is the metallic can; *a* its lid or cover. B is the lining, constructed, preferably, of cotton or muslin. Material of the cheapest and most inferior quality may be used, as the sole object of its use is to prevent [65] the article to be preserved from coming in direct contact with the surface of the can, which contact with

33 the metal in the case of the shrimp causes, as before stated, during the process of boiling, and all along thereafter until the can is opened, [70] a profuse precipitation of a black substance, generally believed to be sulphur, and which supposition is based upon

the fact that the shrimp is said to possess a much larger proportion of sulphur than any other shell-fish.

[75] *b*, Fig. 3, is a circular piece cut out of material similar to that of which the bag B is made, and which is inserted within the mouth of the latter after the same is filled with the fish or other article to be preserved.

[80] Such a can and lining as herein described are admirably adapted for the purpose attained by our present invention; but, as before stated, there is nothing arbitrary about the peculiar form and construction of the textile [85] fabric lining, as other forms and arrangements might be substituted therefor without in any manner altering the principle of the invention.

34 In canning the shrimps we employ the following process: The shell having been removed [90] from the shrimp in the usual manner, the fish is thrown into salt water of about six degrees, and there remains for an hour (more or less), and from thence to kettles filled with water and brought to a boiling-heat, after [95] which they are placed on drippers and cooled and thoroughly rinsed with fresh cold water, from which, so soon as thoroughly dripped and in a moist condition, and without the addition of any salted or otherwise prepared liquid, they are placed in the sack B, the same having been previously arranged in the can A. So soon as the sack is filled, the mouth [5] thereof being properly secured, the lid or head *a* is placed in position on the can A and immediately sealed. The cans are then subjected to a steam bath, or placed in kettles containing boiling water, and boiled for two hours at the highest temperature [10] attainable, and which completes the process.

35 What we claim as new, and desire to secure by letters patent, is—

As an improvement in the art [15] of preserving shrimps in metal cans, the mode of preventing the discoloration of the shrimps, which consists in interposing between the metal can and the shrimps an enveloping material for the shrimps, which is not itself capable of discoloring the shrimps, and then sealing the cans and subjecting the same and its contents to a boiling process, substantially as described.

JAMES F. EMERSON,
Administrator of the estate of George W. Dunbar, deceased.
GEO. F. DUNBAR,
F. B. DUNBAR.

Witnesses to signature of James F. Emerson—
H. G. WADLIN.
C. F. BROWN.

Witnesses to signatures of Geo. H. Dunbar and F. B. Dunbar—
D. I. DOWERS.
P. A. ORY.

Subpœna in Chancery to Emmet C. Pecor.—Issued March 15th, 1882.

UNITED STATES OF AMERICA.

The President of the United States to the marshal for the eastern district of Louisiana, greeting:

You are hereby commanded to summon Emmet C. Pecor to appear before the honorable the judges of the fifth judicial circuit of the United States of America, at a Circuit Court to be holden
42 on the first Monday of May, 1882, then and there to answer a bill in chancery filed against him and others, wherein George H. Dunbar, Francis B. Dunbar, and Charlotte Z. Dunbar are complainants, and said Emmet C. Pecor and others are defendants.

Herein fail not, and have you then and there this writ, with your endorsement thereon how you have executed the same.

Witness the Honorable Morrison R. Waite, chief justice of the Supreme Court of the United States of America, this 15th day of March, in the year of our Lord one thousand eight hundred and eighty-two, and the 106th year of American Independence.

[SEAL.] (Signed) F. A. WOOLFLEY, *Clerk.*

The defendant is hereby notified that he is required to enter his appearance in the clerk's office of the United States Circuit Court on or before the first Monday of May, 1882; otherwise the bill
43 may be taken *pro confesso.*

(Signed) F. A. WOOLFLEY, *Clerk.*

Marshal's Return.

Received March 15th, 1882, by the U. S. marshal, and on March 17th, 1882, I served a true copy of the within subpœna in chancery on the within named E. C. Pecor, by handing the same to him in person in the city of New Orleans.

(Signed) E. S. CURRY,
D'y U. S. Marshal.

Affidavit of Geo. H. Dunbar.—Filed March 15th, 1882.

Circuit Court U. S., 5th circuit, eastern dist. Louisiana.

GEORGE H., FRANCIS B., and CHARLOTTE Z. DUNBAR
vs.
T. T. WHITE, WM. GORDON, and EMMET C. PECOR. } In Circuit Court. No. —.

George H. Dunbar, being duly sworn, deposes and says that he is a resident of the city of New Orleans, aged — years.

That on or about the 14th January, A. D. 1876, George
44 W. Dunbar, now deceased, Francis B. Dunbar and affiant, who for some time previous had been experimenting with a

view of preserving shrimps so as to make same an article of commerce, discovered or invented a process and means by which shrimps could be successfully preserved, and all discoloration of the shrimp prevented; that previous to said discovery or invention shrimps could not successfully preserved, or their discoloration prevented, and as a consequence canned shrimps were not to any considerable extent an article of commerce.

That said George W. Dunbar, Francis B. Dunbar, and affiant applied for and obtained a patent for such discovery or invention, issued on June 20th, 1876, and the nature of such invention or discovery is set forth in the specification annexed to and forming part of the letters patent so issued, a copy of which is hereto an-
45 nexed and marked "A."

That immediately after the issuance of said letters patent the said George W. Dunbar, George H Dunbar, and Francis P. Dunbar put the said invention into use and by means thereof preserved large quantities of shrimps successfully; sold same throughout the United States and for export, and derived large profits therefrom; that said invention or discovery was, so far as affiant knows, and as he verily believes, never known or used prior to its being used as aforesaid by George W. Dunbar, George H. Dunbar, and Francis B. Dunbar, and has been since the issuance of said letters patent exclusively used and possessed by said inventors, until the death of George W. Dunbar, which occurred on the 5th day of June, A. D. 1878, and since the death of said George W. Dunbar has been exclusively used and possessed by his heirs and legal representatives and by said George H. Dunbar and Francis B. Dunbar.

That said invention or discovery for which letters patent
46 were so as aforesaid issued, was, at date of said letters patent, new and useful. That subsequent to the death of George W. Dunbar, the administrator of his estate, James F. Emerson, and said George H. Dunbar and Francis B. Dunbar, applied for and obtained a reissue of said letters patent, as shown by copy of said reissue, with specification forming part of same, hereto annexed and made part hereof, marked B.

That the invention therein set forth was at the date of said reissue in the exclusive use and possession of George H. Dunbar, Francis B. Dunbar and the legal representatives of George W. Dunbar, deceased, and has since remained in their exclusive use and possession.

That from the issuance of original letters patent in June, 1876, down to the present time George H. Dunbar, Francis B. Dunbar, and the said George W. Dunbar, during his lifetime, and after his death his legal representatives and heirs, have been contin-
47 uously engaged in preserving shrimps by means of said invention or discovery.

That he, affiant, has examined the shrimps in metal cans recently put up and placed on the market by the defendants, and that the shrimps so put up are preserved by means of the new and useful improvement for which letters patent, herewith filed, were granted,

and that the defendants have infringed upon and violated the rights of complainants in said cause in and under said letters patent, and that in consequence of such infringement damage has resulted and will result to the complainants in said cause.

(Signed) GEO. H. DUNBAR.

Sworn to and subscribed before me this March 15th, A. D. 1882.

(Signed) T. V. COUPLAND,
U. S. Commissioner.

The letters patent referred to in the foregoing affidavit as
48 Exhibits "A" and "B" have already been transcribed, and are to be found at pages 16 and 26 respectively of this transcript.

Affidavit of A. L. Gaudin.—Filed March 15th, 1882.

Circuit Court U. S., 5th circuit, eastern dist. of La.

GEORGE H., FRANCIS B., and CHARLOTTE Z. DUNBAR
vs.
T. T. WHITE, WM. GORDON, AND EMMETT C. PECOR.
} In Circuit Court. No. —.

A. L. Gaudin, being duly sworn, deposes and says that he is a resident of the city of New Orleans, aged twenty-seven years; that during the lifetime of George W. Dunbar, deceased, said George W. Dunbar, with George H. Dunbar and Francis B. Dunbar, from some time in the year 1876 up to the death of said George W. Dunbar, were engaged extensively in the business of putting up and selling shrimps preserved in metal cans by means of a new and useful improvement in preserving shrimps in metal cans, for which
49 letters patent were granted to said George W., George H., and Francis B. Dunbar; that since the death of said George W. Dunbar the said George H. Dunbar and Francis B. Dunbar, and the heirs and representatives of George W. Dunbar, dec'd, have continued said business under said patent and a reissue of same; that large quantities of shrimps were by them preserved in metal cans by means of said improvement and sold at remunerative prices; that said improvement, for which letters patent were so as aforesaid issued, was, as affiant verily believes, exclusively used and possessed by said George W. Dunbar during his lifetime, in connection with George H. Dunbar and Francis B. Dunbar, and, after the death of said George W., has been exclusively used by his heirs and legal representatives in connection with George H. and Francis B. Dunbar, until an infringement on said patent recently committed by defendants in above cause; that he has examined the shrimps
50 put up and sold by defendants, and that same are preserved in metal cans by means of the improvement for which letters

patent were granted, as hereinbefore stated; that prior to the issuance of said letters patent in year 1876, shrimps were not to any considerable extent an article of commerce, and that affiant believes said improvement was a new and useful invention.

(Signed) ALF. L. GAUDIN.

Sworn and subscribed before me this 15th day of March, 1882.

(Signed) T. V. COUPLAND,
U. S. Commissioner.

Affidavit of A. N. Tourné.—Filed March 15th, 1882.

Circuit Court U. S., 5th circuit, eastern dist. of La.

GEORGE H., FRANCIS B., and CHARLOTTE Z. DUNBAR
vs.
T. T. WHITE, WM. GORDON, and EMMETT C. PECOR.
} In Circuit Court. No. —.

A. N. Tourné, being duly sworn, deposes and says that he
51 is a resident of the city of New Orleans, aged sixty-nine years; that he is, and has been for some fifteen years, engaged in business of buying and selling canned goods; among others shrimps preserved in metal cans under process, and by means for which George W. Dunbar, George H. Dunbar, and Francis B. Dunbar obtained letters patent; that on or about the 20th June, 1876, the said Messrs. Dunbar put said patent into use and engaged extensively and successfully in the business of putting up shrimps thereunder.

That the invention of the Messrs. Dunbar, for which letters patent were issued them, was, as affiant verily believes, new and useful. That prior to the time when the Messrs. Dunbar successfully canned shrimps by their patented process, canned shrimps did not to any considerable extent constitute an article of commerce, because of the difficulty of preserving same, and in consequence of the discoloration of the shrimp when canned, and that prior to said time no
52 one, so far as affiant has any knowledge, ever successfully canned shrimps.

That after the death of George W. Dunbar the business of putting up shrimps, preserved by means of said invention, was continued and is now conducted by G. W. Dunbar's sons—George H. Dunbar and Francis B. Dunbar.

That, as affiant verily believes, said invention was exclusively used and possessed by said George W. Dunbar during his lifetime, and after his death by his heirs and legal representatives, and by George H. Dunbar and Francis B. Dunbar.

That recently, and since 1st January last, 1882, T. T. White & Co., of New Orleans, have engaged in business of preserving shrimp in metal cans, and have sold shrimp so put up by them.

That affiant has bought cans of shrimp from said T. T. White & Co., and presents herewith two of such cans so bought by him.

Affiant further states that he has examined cans of shrimp
53 put up by said T. T. White & Co., and, as affiant verily believes, said T. T. White & Co. use the improvement in preserving shrimp in metal cans for which letters patent were issued to George W. Dunbar, George H. Dunbar, and Francis B. Dunbar; reissued to James F. Emerson, adm'r, and to said George H. and Francis B. Dunbar.

(Signed) A. N. TOURNE.

Sworn to and subscribed before me this 15th day of March, A. D. 1882.

(Signed) T. V. COUPLAND,
U. S. Commissioner.

Affidavit of Paul Gelpi.—Filed March 24th, 1882.

U. S. Circuit Court, 5th circuit, eastern dist. of Louisiana.

GEORGE H. DUNBAR et al.
vs.
T. T. WHITE et al. } No. —.

Personally appeared before me, undersigned authority, Paul Gelpi, who, being duly sworn, deposes and says that his age is 34 years; that he is a resident of New Orleans; that for nine years he
54 has been engaged in business in New Orleans and dealing in canned goods; that he has frequently bought and sold shrimps preserved in metal cans by Messrs. G. W. Dunbar & Sons, viz., George H. Dunbar and Francis B. Dunbar, during lifetime of said G. W. Dunbar, now deceased, and since his death by complainants under name and style of G. W. Dunbar's Sons, which shrimps were preserved under processes and by means of a new and useful improvement for which letters patent were granted to said George W. Dunbar, George H. Dunbar, and Francis B. Dunbar in the year 1876; that prior to said year canned shrimps were not successfully preserved and did not constitute to any extent an article of commerce, but that the Messrs. Dunbar were successful in preserving shrimps in metal cans, under their process and by means of their improvement aforesaid, and that shrimps as preserved by them in metal cans became an article of commerce and entered largely
55 into general consumption; that the Messrs. Dunbar continuously and exclusively used their said invention or discovery from date of said letters patent issued in 1876 up to present time; that until shrimps were successfully preserved by the Messrs. Dunbar, no one had successfully preserved them, and that no one but the Messrs. Dunbar successfully preserved shrimps in metal cans.

That said invention or discovery of the Messrs. Dunbar was at date of said letters patent both new and useful.

(Signed) PAUL GELPI.

Sworn and subscribed before me this 23d day of March, 1882.
(Signed) T. V. COUPLAND,
U. S. Commissioner.

Affidavit of Herman Meader.—Filed March 24, 1882.

U. S. Circuit Court, 5th circuit, eastern district of Louisiana.

GEORGE H. DUNBAR et al.
vs.
T. T. WHITE et al. } No. —.

Personally appeared before me, the undersigned authority,
56 came and appeared Herman Meader, who, being duly sworn, deposes and says that his age is forty-one years; that he is a resident of New Orleans; that for eighteen years he has been engaged in business in New Orleans and dealing in canned goods; that he has frequently bought and sold shrimps preserved in metal cans by Messrs. G. W. Dunbar & Sons, viz., George H. Dunbar and Francis B. Dunbar, during lifetime of said G. W. Dunbar, now deceased, and since his death by complainants under name and style of G. W. Dunbar's Sons, which shrimps were preserved under processes and by means of a new and useful improvement for which letters patent were granted to said George W. Dunbar, George H. Dunbar, and Francis B. Dunbar in the year 1876; that prior to said year canned shrimps were not successfully preserved, and did not constitute to any extent an article of commerce, but that the Messrs.
57 Dunbar were successful in preserving shrimps in metal cans under their process and by means of their improvement aforesaid, and that shrimps as preserved by them in metal cans became an article of commerce and entered largely into general consumption; that the Messrs. Dunbar continuously and exclusively used their said invention or discovery from date of said letters patent issued in 1876 up to the present time; that until shrimps were successfully preserved by the Messrs. Dunbar no one had successfully preserved them, and that no one but the Messrs. Dunbar have successfully preserved shrimps in metal cans; that said invention or discovery of the Messrs. Dunbar was at the date of said letters patent both new and useful.

(Signed) HERMAN MEADER.

Sworn and subscribed before me, at New Orleans, this 23d day of March, 1882.
[SEAL.] (Signed) CHAS. G. ANDRY,
Notary Public.

Hearing and continuance of Application for Injunction.

58 Extract from the minutes.—November Term, 1881.

NEW ORLEANS, SATURDAY, *March* 25, 1882.

Court met pursuant to adjournment. Present, Hon. E. C. Billings, district judge.

Affiant further states that he has examined cans of shrimp
53 put up by said T. T. White & Co., and, as affiant verily believes, said T. T. White & Co. use the improvement in preserving shrimp in metal cans for which letters patent were issued to George W. Dunbar, George H. Dunbar, and Francis B. Dunbar; reissued to James F. Emerson, adm'r, and to said George H. and Francis B. Dunbar.

(Signed) A. N. TOURNE.

Sworn to and subscribed before me this 15th day of March, A. D. 1882.

(Signed) T. V. COUPLAND,
U. S. Commissioner.

Affidavit of Paul Gelpi.—Filed March 24th, 1882.

U. S. Circuit Court, 5th circuit, eastern dist. of Louisiana.

GEORGE H. DUNBAR et al.
vs.
T. T. WHITE et al. } No. —.

Personally appeared before me, undersigned authority, Paul Gelpi, who, being duly sworn, deposes and says that his age is 34 years; that he is a resident of New Orleans; that for nine years he
54 has been engaged in business in New Orleans and dealing in canned goods; that he has frequently bought and sold shrimps preserved in metal cans by Messrs. G. W. Dunbar & Sons, viz., George H. Dunbar and Francis B. Dunbar, during lifetime of said G. W. Dunbar, now deceased, and since his death by complainants under name and style of G. W. Dunbar's Sons, which shrimps were preserved under processes and by means of a new and useful improvement for which letters patent were granted to said George W. Dunbar, George H. Dunbar, and Francis B. Dunbar in the year 1876; that prior to said year canned shrimps were not successfully preserved and did not constitute to any extent an article of commerce, but that the Messrs. Dunbar were successful in preserving shrimps in metal cans, under their process and by means of their improvement aforesaid, and that shrimps as preserved by them in metal cans became an article of commerce and entered largely
55 into general consumption; that the Messrs. Dunbar continuously and exclusively used their said invention or discovery from date of said letters patent issued in 1876 up to present time; that until shrimps were successfully preserved by the Messrs. Dunbar, no one had successfully preserved them, and that no one but the Messrs. Dunbar successfully preserved shrimps in metal cans.

That said invention or discovery of the Messrs. Dunbar was at date of said letters patent both new and useful.

(Signed) PAUL GELPI.

Sworn and subscribed before me this 23d day of March, 1882.

(Signed) T. V. COUPLAND,
U. S. Commissioner.

Affidavit of Herman Meader.—Filed March 24, 1882.

U. S. Circuit Court, 5th circuit, eastern district of Louisiana.

GEORGE H. DUNBAR et al.
vs.
T. T. WHITE et al. } No. —.

Personally appeared before me, the undersigned authority,
56 came and appeared Herman Meader, who, being duly sworn, deposes and says that his age is forty-one years; that he is a resident of New Orleans; that for eighteen years he has been engaged in business in New Orleans and dealing in canned goods; that he has frequently bought and sold shrimps preserved in metal cans by Messrs. G. W. Dunbar & Sons, viz., George H. Dunbar and Francis B. Dunbar, during lifetime of said G. W. Dunbar, now deceased, and since his death by complainants under name and style of G. W. Dunbar's Sons, which shrimps were preserved under processes and by means of a new and useful improvement for which letters patent were granted to said George W. Dunbar, George H. Dunbar, and Francis B. Dunbar in the year 1876; that prior to said year canned shrimps were not successfully preserved, and did not constitute to any extent an article of commerce, but that the Messrs.
57 Dunbar were successful in preserving shrimps in metal cans under their process and by means of their improvement aforesaid, and that shrimps as preserved by them in metal cans became an article of commerce and entered largely into general consumption; that the Messrs. Dunbar continuously and exclusively used their said invention or discovery from date of said letters patent issued in 1876 up to the present time; that until shrimps were successfully preserved by the Messrs. Dunbar no one had successfully preserved them, and that no one but the Messrs. Dunbar have successfully preserved shrimps in metal cans; that said invention or discovery of the Messrs. Dunbar was at the date of said letters patent both new and useful.

(Signed) HERMAN MEADER.

Sworn and subscribed before me, at New Orleans, this 23d day of March, 1882.

[SEAL.] (Signed) CHAS. G. ANDRY,
Notary Public.

Hearing and continuance of Application for Injunction.

58 Extract from the minutes.—November Term, 1881.

NEW ORLEANS, SATURDAY, *March* 25, 1882.

Court met pursuant to adjournment. Present, Hon. E. C. Billings, district judge.

GEORGE H. DUNBAR et al.
vs.
T. T. WHITE et als. } No. 9858.

This cause came on to be heard on the complainant's application for injunction *pendente lite.*

A. H. Leonard, for complainants; Joseph P. Hornor, for defendants.

And after hearing counsel for the respective parties it was ordered that the matter stand over till Thursday, 30th instant, at 11 a. m.

Affidavit of A. N. Tourné.—Filed March 29, 1882.

Circuit Court U. S., 5th circuit, east. dist. of La.

GEORGE H. DUNBAR et al.
vs.
T. T. WHITE et al. } No. —.

59 Personally appeared before me, undersigned authority, A. N. Tourné, who, being duly sworn, deposes and says that, adoping affidavit by him made on 15th instant, filed in said cause, he deposes further that the shrimps preserved in metal can by the Messrs. Dunbar and by them sold on market as stated in affidavit referred to were and are preserved by providing the cans by them used with a lining to prevent direct contact of the shrimp with the metal, and by placing the shrimps in the lined can while they are in a dry or moist condition, devoid of free liquor or gravy, and by cooking the contents of the can after sealing, the lining used by the Messrs. Dunbar being a bag of cotton or muslin, which means and process successfully preserve the shrimps and prevent their discoloration.

That the shrimps canned and sold by the defendants are preserved in a similar manner in lined cans, the lining used by defendants being paper; and the shrimps are put in such lined cans while in a dry or moist condition and devoid of free liquor or
60 gravy, and by such means defendants accomplish substantially the same result arrived at by the Messrs. Dunbar under their letters patent, with which affiant is familiar.

(Signed) A. N. TOURNÉ.

Subscribed and sworn before me March 28th, 1882.

(Signed) T. U. COUPLAND,
Comm'r U. S. Circuit Court, Eastern Dist. of Louisiana.

Affidavit of J. Chauvet.—Filed March 29th, 1882.

Circuit Court U. S., 5th circuit, east. dist. of La.

GEORGE H. DUNBAR et al. } Bill in Equity.
vs.
T. T. WHITE et al. } No. —.

Personally appeared before me, the undersigned authority, J. Chauvet, who, being duly sworn, deposes and says that his residence is New Orleans, his age 57 years. That he is an employee of complainants, and was in the employment of Messrs. G. W. Dunbar & Sons. That some time in the year 1876 Messrs. G. W. Dunbar & Sons commenced preserving shrimps in metal cans and sell-
61 ing same; preserving shrimps by providing cans by them used with a lining to prevent direct contact of the shrimps with the metal, placing the shrimps in the lined cans while in a dry or moist condition, devoid of free liquor or gravy, sealing the cans without adding any liquid to their contents and cooking the contents of the cans after sealing. That for the lining of said cans the Messrs. G. W. Dunbar & Sons used a bag of cotton or muslin. That by these means the Messrs. Dunbar successfully preserved shrimps in metal cans, and prevented discoloration of the shrimps. That from time they so commenced such business, the said Messrs. G. W. Dunbar & Sons continued the same up to death of G. W. Dunbar; since then it has been continued by the complainants in said bill under name and style of G. W. Dunbar's Sons up to present time. That prior to the year 1876 no one had successfully
62 preserved shrimps in metal cans, and that Messrs. G. W. Dunbar & Sons and the Messrs. G. W. Dunbar's Sons exclusively used and possessed the right to put up and preserve shrimps in the manner hereinbefore stated, letters patent therefor having been issued to them, of which affiant has knowledge, until their rights were recently infringed by defendants in said bill; that said defendants are putting up and selling on market shrimps preserved in metal cans by methods substantially the same with those of the Messrs. Dunbar, substituting as an enveloping material paper for the muslin or cotton bag used by the Messrs. Dunbar, and thereby preventing discoloration. That the shrimps placed on the market by the Messrs. Dunbar were preserved by the means set forth in specifications annexed to and forming part of letters patent issued to them, and reissue of same, both of which are filed with affidavit of George H.
63 Dunbar filed in said cause.

(Signed) J. CHAUVET.

Subscribed and sworn before me March 29, 1882.

(Signed) T. V. COUPLAND,
Comm'r U. S. Circuit Court, Eastern District of Louisiana.

Affidavit of F. B. Dunbar.—Filed March 29, 1882.

Circuit Court, 5th circuit, eastern district of Louisiana.

GEORGE H. DUNBAR et al.
vs.
T. T. WHITE et al. } No. 9858.

Francis B. Dunbar, being duly sworn, deposes and says he is a resident of New Orleans, aged 36 years. That for several years prior to the year 1876 his father, George W. Dunbar, now deceased, his brother, George H. Dunbar, and himself, made frequent efforts to preserve shrimps so as to make of same an article of commerce, which they were not then and had not theretofore been. That the chief difficulty preventing success in such efforts arose from
64 the discoloration of the shrimps, which were thereby rendered unsightly and unmerchantable. That finally, after many experiments, about the 14th of January, 1876, said parties discovered that such discoloration could be prevented by putting the shrimps in metal cans provided with a lining to prevent direct contact of the shrimps with the metal, placing the shrimps while in a dry or moist condition, and devoid of free liquor and gravy, in the lined cans, sealing the can without adding any liquid to its contents, and cooking the contents of the can after sealing, and that by such means shrimps could be successfully preserved in metal cans, which no one before had ever succeeded in doing; that therefore said parties applied for and obtained letters patent for said invention or discovery, which are annexed to affidavit of George H. Dunbar filed in said cause, marked "A."

65 That immediately after issuance of said letters patent said parties put said invention or discovery into use; preserved large quantities of shrimps in metal cans by means of said invention or discovery, and by processes as set forth in specifications annexed to said letters patent, using for lining a bag or sack of cotton or muslin, and put the same on the market and derived large profits from sale thereof; that their use of said invention or discovery was continuous and exclusive and undisturbed during life of said George W. Dunbar, and after his death has been continually used by his heirs and legal representatives through George H. and Francis B. Dunbar, and under name and style of George W. Dunbar's Sons, up to present time, and exclusively used by them up to a quite recent date, when infringements thereupon commenced by defendants in said cause by substituting paper as a lining for the cloth.

66 That on the 1st of Dec'r, A. D. 1881, George H. Dunbar, affiant, and the representative of the estate of George W. Dunbar, deceased, obtained a reissue of said letters patent, which are annexed to affidavit of George H. Dunbar filed in said cause and marked "B."

That affiant herewith files two of the metal cans containing shrimps preserved by complainants in said cause by means of the

invention aforesaid and by processes set forth in said reissued letters patent and specifications thereto annexed.

That affiant has examined shrimps recently put up by defendants in metal cans and placed on the market; that said shrimps have evidently been preserved by means of the invention aforesaid; that they are free from liquid or gravy and from discoloration, which has been prevented by interposing between the metal and shrimps
67 a lining of paper instead of the muslin or cotton bag used by complainants, a device which is substantially an equivalent and effects the same purpose as that used by complainants, and all of which is an infringement of the letters patent held by complainants.

And further, that affiant believes said George W. Dunbar, George H. Dunbar and Francis B. Dunbar are, as stated in said bill, the true and original inventors of the improved manner of preserving shrimps as set out and described in said letters patent.

(Signed) F. B. DUNBAR.

Subscribed and sworn before me March 29th, 1882.

(Signed) T. V. COUPLAND,
Comm'r U. S. Circuit Court, eastern district of Louisiana.

Testimony taken by consent, on behalf of defendants, at the office of Joseph P. Hornor and Francis W. Baker.—Filed March 30th, 1882.

68 United States Circuit Court, fifth judicial circuit, eastern district of Louisiana.

GEORGE H. DUNBAR et als.
vs.
T. T. WHITE et als. } No. 9858. In Chancery.

Appearances: Leonard, for complainants; Joseph P. Hornor and F. W. Baker, for defendants.

Testimony taken by consent, on behalf of defendants, at the office of Joseph P. Hornor and F. W. Baker, New Orleans, La., Nov. 30, 1882.

T. T. WHITE, sworn by Mark Breeden, jr., notary public. Examined in chief on behalf of defendants, by Joseph P. Hornor, esq., as follows:

By the NOTARY:

It is agreed by counsel that the affidavit of T. T. White, this witness, filed in this case on the 30th of March, 1882, be taken and used as a part of his direct examination in this case.

69 By Mr. HORNOR:

Question. Mr. White, have you ever compared the condition of the shrimps put up by you according to your process as you have detailed

in your affidavit, with those put up by the complainants, the Messrs. Dunbar, after the same have remained for any length of time in the can?

Answer. Yes, sir.

Q. Will you state for how long they had remained in the cans when you examined them, and what the result was?

A. I cannot say anything about Mr. Dunbar's; ours had been in the cans about from the 1st of March—the 1st of ————; I don't know whether it was in April or May; about six weeks, I should think.

Q. Well, what was the comparison?

A. Well, in what respect;

Q. In any respect?

A. Well, I found—now I cannot say how long Mr. Dunbar's had been in the can, ours had been in the can some weeks—I found a deposit on the outside of the bag which showed a deposit that

70 I considered had considerable silver in it.

Q. What was the color of the deposit?

A. Dark.

Q. Black?

A. No, sir; not exactly black; in spots it was black.

Q. What was between the bag and the can?

A. Between the bag and the can?

Q. Well, was it in your own?

A. I found a few dark places on the outside of the paper of mine.

Q. On the outside of the paper?

A. Yes, and penetrated through the paper also.

Q. Did it penetrate through?

A. Yes, sir.

Q. Which was the most? Which had the most?

A. Mine was not a deposit; there was not a deposit in mine.

Q. What was yours?

A. Ours was just simply a discoloration of the paper.

Q. But in Dunbar's it was a deposit on the outside of the bag?

71 A. Yes, sir.

Q. How did you say yours were when you examined them?

A. I cannot say positively; I think about six weeks.

Q. In what parts of this paper of your own cans were the discolorations that you observed?

A. They were under the soldering.

Q. Wherever the soldering was put?

A. Yes, sir; wherever the heat of the soldering-irons went.

Q. Was the discoloration observed caused in your cans by the same cause as the deposit in the cans of Dunbar that you examined?

A. No, sir; I don't think it was; I think that Mr. Dunbar's bag being porous that the liquid came in contact with the tin and that made the deposit.

Cross-examination by Mr. LEONARD, counsel for complainants:

Q. Mr. White, you have in this affidavit set forth the mode in

which the complainants packed shrimps; do you know of your own knowledge how they packed shrimps?

72 A. Well, yes, sir; I have seen them pack shrimps.

Q. This statement then is derived from your personal knowledge?

A. As far as the packing is concerned it is.

Q. All you have set forth in detail?

A. Well, yes, sir; everything that I have in there—that I have said; yes, I have seen done; I have been in Mr. Dunbar's factory; he and I were personal friends; I have been through his factory.

Q. You have described and set forth the patent issued to George H. Chinnock; do you know anything of that patent otherwise than you derive the knowledge you derived from an examination of the patent?

A. Yes, sir; I have seen it worked.

Q. Where?

A. Well, I have seen—I have seen the same principle worked.

Q. I asked you about the Chinnock?

A. No, sir.

Q. Your knowledge of that is derived from the patent itself?

A. Yes, sir.

73 Q. You have stated that the "Mexican Gulf Packing Co."

A. I was going to take that back; I was going to recall my words there. The Mexican Gulf Packing Co. packed under that Chinnock patent; I have seen their packing.

Q. Where did you see them packing?

A. I never saw them packing; I saw it after it was packed.

Q. You have seen the goods?

A. I have been in their packing-house, but not when they were packing shrimps.

Q. How long have you known the complainants in this case?

A. I have known them ——

Q. A number of years?

A. I don't know how long it is.

Q. A number of years?

A. I have known them since —— well, I have known the father since 1869, and I think I knew the sons. I think I have known them since 1870, I think—in 1871 I think it was; 1870 or 1871, somewhere along there.

Q. Do you not know that about the year 1876 the Messrs.

74 Dunbar and their father claimed to have invented an improvement in the art of preserving shrimp?

A. I do know that they claimed to have a patent for canning shrimp. Yes, sir.

Q. And that they engaged in the business of preparing shrimp?

A. Yes, sir.

Q. Under that patent?

A. Yes, sir.

Q. And did the same extensively?

A. Yes, sir.

WM. WALLACE, sworn by Mark Breeden, jr., notary public. Examined in chief, on behalf of defendants, by Joseph P. Hornor, esq.

By the NOTARY:

It is agreed by counsel that the affidavit made by this witness, and filed in this case on the 30th of March, 1882, be taken as a part of his direct examination.

By Mr. HORNOR:

Question. Mr. Wallace, have you ever compared the contents of the cans of shrimp put up by Dunbar's Sons with those prepared by T. T. White & Co.?

75 Answer. I never had an opportunity of comparing them together, sir; I have opened the cans of Mr. Dunbar; I saw some of them before I went to Mr. White's, and I have opened some of Mr. White's since I have been there; I never opened any of Mr. Dunbar's since I have been with Mr. White, to my knowledge.

Q. But you have opened the cans of Messrs. Dunbar after they were packed?

A. Yes, sir.

Q. How long after they had been packed?

A. I cannot say, sir.

Q. Can you approximate?

A. Probably two or three months; I cannot say positively.

Q. What was the condition of the shrimps when you opened those cans?

A. There was some discoloration in some; some without discoloration.

Q. What was the majority?

A. The great proportion was discolored—the bagging that
76 was around the shrimps; in some cases the shrimps; but it don't necessarily follow that in every one of the bags that was discolored the shrimps themselves were discolored.

Q. The bags would be discolored without the shrimps?

A. Yes, sir.

Q. That was the generality of cases?

A. Frequently.

Q. How were they discolored?

A. I should say it was done through the muslin.

Q. I mean what kind of discoloration?

A. A dark discoloration; sometimes approaching very near black.

Q. A stain or a deposit?

A. Generally a stain; but sometimes a deposit with a stain; but generally only a stain.

Q. Have you opened these shrimps of Mr. White that had been packed for some period of time?

A. Frequently.

Q. What was their appearance?

A. Sometimes there was a discoloration of the paper only; I do not know what the cause of it was, further than what might
77 have been by the damp. There was no sediment deposit at all in the cans of any that I have seen, unless it be a bad can which had a leak in it. In the good cans, I don't know that I have ever noticed any deposit in them.

Q. Did you ever notice any deposit in the Dunbar cans?

A. I have seen some, sir; but not all so, sir, by any means.

Q. What proportion of them would have this deposit?

A. That I cannot say; I was not interested to notice how many there were?

Q. You have worked at both processes?

A. Yes, sir.

Q. Which do you consider the best?

A. Well, sir, as far as my experience goes in the business I prefer the mode that is pursued by T. T. White.

Q. Can you state why?

A. Yes, sir. I do not know—I suppose I should state why I think so.

Q. Yes; that is what I asked you.

A. Well, sir, the reason I think his is the better, the reason
78 I think they are better is because the shrimps in Mr. Dunbar's are boiled—immediately boiled in salt water after being rinsed in clear water. Mr. White's is entirely different; they are allowed to remain a considerable length of time before boiled in fresh water —allowed to remain in salt water before being boiled; then boiled in fresh water.

Q. Do you think there is any difference in the quality of the goods arising from the difference between the lining used by Dunbar and the lining used by White?

A. Well, I don't know, sir. As I said, I think Mr. White's shrimps are better flavor; whether that is owing to the mode they are prepared before they are canned, or whether it is caused by the lining that is in the can, I cannot say positively; I think they turned out better in my estimation; the condition I am satisfied of.

Q. Have you ever observed in the cans of Mr. White's
79 shrimps that have been packed for some time any blanching in the color of the shrimps?

A. No, sir.

Q. If there had been any such, would you have observed it?

A. I think so; I have opened cans enough; I saw any number of people open cans.

Q. Where they would be selling?

A. Yes, sir; I think I would have seen one, because we frequently opened cans.

Q. Did you ever see one?

A. No, sir; not of Mr. White's; none that had lost their color; I don't remember to have seen one.

Cross-examination by Mr. LEONARD, counsel for complainants:

Q. You speak in your affidavit of a patent issued to George H. Chinnock; do you know George H. Chinnock?

A. No, sir.

Q. Did you have any knowledge of his patent other than that derived from an examination of the patent itself?

A. None whatever.

80 Q. How long have you been in the employment of Messrs. White & Co.?

A. I don't remember when I went there; I think some time—some time in January, I believe, sir.

Q. What year?

A. 1882, sir; when they first started, whatever the time that was.

Q. Was that January, 1882?

A. I think so; but I did not have any occasion to set down the date; I never taxed my memory with it, but I went with him when they first commenced putting up shrimps.

Q. I think they commenced in March, 1881, was it not?

A. No, sir.

Q. When they commenced packing shrimps you went to work with them?

A. Yes, sir.

Q. Did they ever pack shrimp before you went to work there?

A. Not as T. T. White & Co.; I went there when he first put up shrimps in that factory, on Tchoupitoulas street; what they done before I don't know; I went with them when they went in that building.

Q. Did any one else ever have a factory here?

81 A. So I understood; not to my own positive knowledge; I have been told so.

Q. Do you know of Mr. Pecor's?

A. Not in New Orleans; in Galveston.

Q. Of Mr. Bartlett's?

A. Not that I know of.

Q. So when they commenced packing shrimps in New Orleans you commenced working for them?

A. Yes, sir.

Q. How long have you been in New Orleans?

A. I have been in New Orleans since the early part of August last year; that is, last August a year.

Q. August, 1881?

A. Yes, sir.

Q. Been engaged in any business or occupation?

A. Working in the canning business.

Q. Whereabouts?

A. I worked for Mr. Dunbar; also for Mr. White; there are two

firms here, and they are the only places I worked in New Orleans.

82 Q. When you first came here you went in the employment of Mr. Dunbar?

A. Yes, sir; the first place I was employed in New Orleans.

Q. What was your employment while with Messrs. Dunbar?

A. Well, sir, I went in there, I suppose, as—in the position of kind of foreman, assistant superintendent, or something of that kind, as you might term it—down stairs in the packing room or the dressing room.

Q. Your employment there was packing shrimp, assisting in packing shrimp?

A. Yes, sir.

Q. While you were in that employment you derived knowledge of their manner of packing?

A. Yes, sir; of course.

Q. I say that is where you derived that knowledge?

A. I say I got some knowledge there.

Q. I say you there derived your knowledge as to the mode and manner of packing?

83 A. Yes, sir.

Q. Did you apply to Messrs. White & Co. for employment, or did they send for you?

A. I went to see them, sir, after being, after having received a message from another party independent of T. T. White & Co.; I was told by one or two parties that were going to start business here, and I went to see them, sir, and I went to see Mr. Pecor.

Q. Did you resign your employment under the Messrs. Dunbar, or were you discharged?

A. I resigned it, sir.

Q. Was Mr. Pecor aware of the fact that you had been in the employment of Mr. Dunbar?

A. I told them; in fact he knew it before.

Q. He knew it before you told him?

A. Yes, sir; after I left Mr. Dunbar, I then made application for the position.

Q. Did Mr. Pecor employ you, or by whom were you employed?

A. I was employed by Mr. Pecor in the name of T. T. White & Co.

84 Q. Did Mr. Pecor ever explain to you the mode and manner and process by which he had been accustomed to pack shrimps in Galveston under the claim of his patent?

A. I don't know; I don't remember whether he explained it all to me or not.

Q. Did you have any conversation with him about it?

A. My impression is we had some conversation about it; in fact I am satisfied we had some conversation, I think.

Q. You knew then from him what his mode and manner and process of packing shrimps in Galveston was?

A. Yes, sir.

Q. Is the mode and manner and process now used by the defendants the same that was used by Mr. Pecor in Galveston?

A. I should suppose so it is; some way I don't know that there is a great difference in them from what I think they did in Galveston; I presume it is the same way here; that is my impression; I
85 always supposed it was the same—never asked him the question.

Q. Did you make any suggestions to Mr. Pecor and these other gentlemen as to the best mode and manner and process of packing shrimps?

A. No, sir; I went to work according to their way.

Q. I asked you if you made any suggestions to him?

A. No, sir; I do not know of having made any suggestions to them, only about the work in regard to putting up shrimps; I never made any suggestions to them.

Q. What do you mean?

A. I mean about the work, whenever there was anything concerning the work to be done; I don't mean in regard to the manner of putting up shrimps, but in the management of the work always such things to attend to; I always had a portion of that to attend to.

Q. Is it not a fact that you explained to Mr. Pecor and these other gentlemen in full the mode and manner and process
86 by which Dunbar packed and preserved shrimps; is that not a fact? Did not you tell him the mode and manner and process by which they packed shrimps?

A. I do not think I told them; I have said some things in regard to it; I think the only time—when my affidavit was taken—I stated then about it; I think that was the only time I entered into details about it.

Q. I ask you if you ever had any conversation with Mr. Pecor or either of these other gentlemen in relation to the mode and manner and process by which Dunbar & Co. packed and preserved shrimps?

A. We had some conversation.

Q. About that?

A. Not entering into general particulars about the business.

Q. I am not talking about the business.

A. About putting up shrimps; is that what you mean?

Q. I will ask you again. Now, I ask you if you ever had
87 any conversation with either of these defendants, or any one of these defendants, about the mode and manner and process of Dunbar's packing of shrimps?

A. I have had some conversation, yes, sir, in regard to it.

Q. How long did you remain in the employment of Messrs. Dunbar?

A. I cannot tell exactly. I remained in their employment up to within three days of the time that I went with Mr. White. I think it was Tuesday or Wednesday I left them, and I went with Mr. White on the following Saturday; his books will show.

Q. Within two or three days after you left Dunbar you went to the defendants?

A. Yes, sir.

Q. You say you resigned?

A. Yes, sir.

Q. Your employment with the Messrs. Dunbar?

A. Yes, sir.

Q. And, I suppose, immediately left there?

88 A. I left there as soon as—I went and saw Mr. Dunbar and walked right out of the factory.

Q. And went immediately to the defendants?

A. I went instead to see Mr. Pecor, or probably to the defendants; I don't remember, sir. This was in the morning that I went into Mr. Dunbar's office.

Q. Did he immediately employ you?

A. He employed me on the following Saturday, sir; I think it was two or three days after I saw him first.

Q. He employed you before they commenced business?

A. They were just fitting up the place—hadn't gotten any shrimp in yet.

Q. Was there any difference between the salary you received at Dunbar's and that you received from the defendants?

A. When I first went with Mr. White I went with him on a graded salary; I went with him for less than I was getting from Mr. Dunbar.

Q. What were you getting from Mr. Dunbar?

89 A. I got a hundred dollars—let me see for a moment.

Q. You got a hundred dollars from Dunbar?

A. No, sir; seventy-five dollars. I think seventy-five dollars. I got, let me see—I very seldom tax my memory. I am satisfied it was $75, and that is what I got from Mr. White.

Q. What were you to receive from the defendants?

A. I got $75. I was under the impression I was getting $100 from Mr. Dunbar. I got $75 from Mr. White on a graded salary.

Q. You got $75 from Mr. Dunbar?

A. Yes, sir.

Q. When you first commenced working for the defendants you got also $75?

A. Yes, sir.

Q. Was that all you was to have?

A. That was all for the time being. I was to get more at the end of three months.

Q. I understand you to say you were to have more at the end of three months?

90 A. Yes, sir; $100 at the end of three months, and $125 for the balance of the year—the last six months of the year; nothing was said after one year.

Q. The last six months of the year you were to get $125; nothing was said after the year?

A. Yes, sir.
Q. Your term has not expired?
A. No, sir.
Q. You are now under $125?
A. Since the 24th of last month, sir.

E. C. PECOR, sworn by Mark Breeden, jr., notary public. Examined in chief on behalf of defendants by Mr. Hornor.

By the NOTARY:

It is agreed by counsel that the affidavit of this witness, filed in this case on the 30th of March, 1882, be taken as a part of his direct examination.

By Mr. HORNOR:

Q. You are the same man of that name to whom was issued these letters patent that have been filed in this case, No. 226,347?

A. Yes, sir.

91 Q. Your application for that patent was filed on the 13th of August, 1879?

A. Yes, sir.
Q. How long before your application was filed, that is, how long before that date, did you make the discovery which that patent covers?
A. I cannot tell you, but some time before that. It may have been a year; it was about a year.
Q. A year before you made the application?
A. Yes, sir.
Q. Have you ever used that patent?
A. Yes, sir.
Q. Where?
A. In Galveston and in New Orleans.
Q. In Galveston first, was it?
A. Yes, sir.
Q. When did you use it, before or after the granting of the patent?
A. I only experimented with it before the granting of the patent. I used it afterwards.
Q. To any extent?
A. Not very largely.

Q. You have used it in New Orleans you say?

92 A. Yes, sir.

Q. Before disposing of this patent to White and Co.?

A. No; not before I made business arrangements with them.

Cross-examination by Mr. LEONARD:

Q. How long did you live in Galveston, Mr. Pecor?
A. Ten or eleven years.
Q. From what dates, about?
A. Well, June, 1869.

Q. When did you leave there?
A. I left there last fall.
Q. Something over a year ago?
A. About a year ago.
Q. From June, 1869, until about a year ago?
A. Yes, sir.
Q. What was your general occupation in Galveston? What business were you generally engaged in?
A. Wholesale grocery and cotton factorage business for most of the time; then in canning business.
Q. Well, in what connection were you engaged in the canning business? You mean canning shrimps?
93 A. Canning shrimps.
Q. When was your attention first directed to the packing of shrimps, the canning of shrimps, about what time?
A. I suppose about two years before the date of that patent.
Q. At that time you were engaged in—
A. At that time I was in the cotton factorage business. Of course my memory is not at all accurate as to these things.
Q. How was your attention attracted to that business?
A. By seeing the cans of Mr. Dunbar, and seeing what I thought was defects in them.
Q. How did you come to see the cans of Mr. Dunbar, do you remember?
A. Well, being in the grocery business it came to my notice.
Q. Was your special attention called to it by anybody?
A. That I cannot say.
Q. Did anybody suggest to you the idea of going into the business of packing shrimps?
A. That I cannot say either; any way, I afterwards met
94 a man named Bartlett, with whom I first applied for the patent. Bartlett was only connected with that a few months, however.
Q. When did you first know him?
A. I have known him ever since I have been living there, nearly.
Q. Bartlett was engaged in packing shrimps before this did occur to you?
A. No, sir, he never did anything until he came to me.
Q. Did he suggest to you or your, or you to him; how did it happen?
A. This I am not clear about; of course we talked the matter over; we were acquaintances; we frequently met; talked about the matter just as one acquaintance would talk to another. That was no new thing—other persons—I talked with other persons about the same thing just as I have done with Bartlett.
Q. Was your business in the cotton business profitable; was your cotton business profitable?
95 A. That is neither here nor there, whether it is profitable or unprofitable.

By Mr. HORNOR:

Q. You might as well answer it.
A. Oh, yes, it was profitable.

By Mr. LEONARD:

Q. What business was Bartlett engaged in at that time?
A. In the photograph business.
Q. You cannot remember whether he suggested the idea to you or you to him, or whether it came accidentally?
A. No, sir; I don't remember that; I do remember that he, myself, and other parties have talked about it.
Q. Did you and he engage together in the business of packing shrimp?
A. Yes, sir; for a few months we made some experiments together.
Q. Before you went into the business together?
A. Yes, sir; we started together.
Q. What are the facilities for obtaining shrimps at Galveston—pretty good?
96 A. Yes, sir; and I have had good facilities for canning them there. There is a small supply.
Q. Is it not a fact that shrimps can be obtained there in considerable quantities?
A. My experience was just the reverse—that they are very scarce. Occasionally they would be plentiful for a few days, but not for months at a time.
Q. Is it not a fact that shrimps can be had there by taking the same means as is used here as readily as in New Orleans?
A. I suppose so, if the same means were used; if parties went far enough after them.
Q. And if there were enough parties engaged in the business?
A. Yes, sir; all these things.
Q. How long did you continue in the business of packing shrimps in Galveston?
A. From the date of that patent.
Q. For how long?
A. Until last fall.
Q. Continuously?
A. Yes, sir; continuously.
97 Q. Did the business pay?
A. No, it did not, because of the supply.
Q. Is it not a fact that the articles—that the goods which you packed there—were not generally acceptable to the public?
A. No; that is not my experience.
Q. Have you got now any of the shrimps you packed then?
A. I have two cans.
Q. Are you willing to present them?
A. Yes, sir.

Q. Well, I would like to have them.
A. Well, they are up at the factory.
Q. I would like to have them offered in evidence.
A. I will get them.
Q. Did you ever compare these shrimps which you have packed there with the shrimps that you are now engaged in packing in New Orleans?
A. Well, I had three or four of them. I opened one of them last winter; that is, three of them I opened last winter; that is all.
Q. You have never compared, then, the shrimps you packed in Galveston with those that you are now packing in New Orleans?
98 A. I have never thought about it; never thought about the comparison; never thought about comparing them. I was satisfied in my own mind just what they were.
Q. Is it not a fact that you put on the market now a better article of goods than you did in Galveston?
A. No, sir; I cannot say that I do.
Q. You don't think that you do?
A. They may be better. I don't know that they are.
Q. What is your opinion?
A. The cans speak for themselves. I don't think I set up any better goods than the sample I can show you.
Q. I ask you whether it is not your opinion that they are better?
A. My opinion is that they are no better.

By Mr. HORNOR:

Q. That is, the ones you are now packing?
A. Yes, sir.

By Mr. LEONARD:

99 Q. Is there any apparent difference between the shrimps you packed at Galveston and those you packed at New Orleans?
A. No, sir; I don't think there is.
Q. The process and mode and manner in which you pack shrimps now is, in detail, set forth in this affidavit?
A. Yes, sir.
Q. Is that identical with the mode and manner and process used by you at Galveston?
A. Just the same thing.
Q. Is it the same thing?
A. Just the same thing.
Q. No difference in one way or another?
A. No difference in what I did at Galveston than what is set forth in that affidavit.
Q. Identically one with the other?
A. Yes, sir.
Q. Of course then the result ought to be the same?

A. The result ought to be the same.
Q. When did you first commence packing shrimps in New Orleans?
A. On the fourth of February.
Q. Of this year?
A. Of this year.
Q. Then you have continued all along in that business?
100 A. Yes, sir; during the spring, and packing during the fall.
Q. Have you any knowledge of the Chinnock patent other than derived from an examination of the patent itself?
A. No, sir.
Q. Do you know the mode and manner and process by which the Mexican Gulf Co. put up the packed shrimps?
A. No, sir; I do not.
Q. You say the patent was issued to Emmett C. Pecor and Frederick W. Bartlett?
A. No, sir; it was to me individually.
Q. Who claimed to invent that invention, Pecor or Bartlett?
A. Pecor; it was mine.
Q. It was?
A. It was really mine.
Q. You simply associated him with you?
A. Yes, sir; we did some experimenting together.
Q. Now the idea occurred to you after an examination of
101 one of the cans of Messrs. Dunbar?
A. Yes, sir.

By Mr. HORNOR:

Q. You stated that you did some packing last spring; do you remember when you stopped last spring, or did you stop at any time last spring?
A. Early in March.
Q. What caused you to stop?
A. Well, because of an injunction that was taken out against them.
Q. In this suit?
A. Yes, sir.
Q. Do you remember when you commenced working again?
A. About the 26th or 27th of August.
Q. Of this year?
A. Of this year.

By Mr. LEONARD:

Q. You employed Mr. Wallace?
A. Yes, sir.
Q. Do you remember when?
A. I think it strikes me that Mr. Wallace just a few days before I started to work started to packing.

Q. Here?

A. Yes, sir.

Q. Previously I believe, though he had been in the employ-
102 ment of Messrs. Dunbar?

A. Yes, sir; but he was not in the employment of Messrs. Dunbar at that time.

Q. Mr. Wallace stated that somebody had told him that you were going into the business of packing shrimps; did you have any knowledge of that, that some one was going to convey to him that information?

A. No, I cannot remember anything on that point.

Q. You don't say positively that you did not have at one time some knowledge of it; you cannot remember whether you did or not?

A. No, sir; I cannot.

Q. Did Mr. Wallace ever have any conversation with you, or with some of your firm, in which he gave information as to the mode and manner and process used by Messrs. Dunbar in packing shrimps?

A. I cannot recall an instance. Do not recollect that he
103 ever did. I would not have followed it myself if he did, because I was satisfied the way we were doing it for all purposes was the most desirable.

Q. Have you ever been in the packing establishment of the Messrs. Dunbar?

A. Only once, with Mr. Dunbar.

Q. When was that?

A. Just about this time a year ago.

Q. Your knowledge of his process is derived from that visit?

A. I have no knowledge of it whatever; he rushed me through so quick I did not get a chance to see a thing.

Q. Now, then, you have sworn in detail, Mr. Pecor, what the process is; how came you to swear to it?

A. I don't remember how I did get the information that is set forth there.

Q. Then you do not really know what his process is in detail?

A. I doubtless did know; I forgot now what it is.

Q. How did you derive your knowledge? You say you have no personal knowledge of it; you must have derived it from
104 somebody. From whom did you derive it?

A. I remember reading his patent; it is the most definite information; it is really about the knowledge I have.

Q. Then you did not pretend to be accurate in the statement made in detail of the process in this affidavit?

A. I never seen his process.

Q. Then you cannot be accurate as to what it is, can you?

A. No, sir; I cannot now; when I gave that I doubtless could.

Q. You could, however, at the time of that affidavit?

A. My memory was perhaps fresh at the time of that affidavit.

Q. Now, then, I want to know from whom you derived this

knowledge that you testified to in this affidavit; didn't you get it from Mr. Wallace?

A. That I do not remember whom I got it from.

Q. You must have got it from some one?

105 A. However, there other persons whom I knew well in his employ.

Q. You derived it from some one?

A. Doubtless from some one.

Q. You cannot remember whether from Mr. Wallace or not?

A. No, sir.

By Mr. HORNOR:

Q. Did not you get it from Mr. Wallace's affidavit made in this case?

A. It may have been; I do not remember where I got it.

Q. Did you have anything to do with inducing Mr. Wallace to quit Dunbar & Sons?

A. Nothing whatever.

Q. Did you know before he quit that he was going to do it?

A. No, sir; I did not. Mr. Wallace came to see me, and told me of his own accord.

WILLIAM A. GORDON, sworn by Mark Bredent, jr., notary public. Examined in chief on behalf of defendants.

By Mr. HORNOR:

Question. You are a member of the firm of T. T. White & Co., and one of the defendants in this case?

106 Answer. Yes, sir.

Q. Before that?

A. Clerking for Mr. White—clerking for Mr. White for nine years.

Q. What was Mr. White's principal business since you have been with him?

A. Manufacturing agent.

Q. What kind of goods principally?

A. Canned goods of all descriptions.

Q. What have been your duties there since you were in the firm of T. T. White & Co., both as a member of the firm and as a clerk? What branch of the business have you paid your particular attention to?

A. I was as clerk, book-keeper, and cashier, and sort of assistant salesman, and all that kind of thing. Since I have been a member of the firm I have done almost exclusively the selling of the goods, and when Mr. White was away I would attend to writing letters and things of that kind.

Q. You are acquainted with the goods "White & Co." have

107 been manufacturing in the shrimp line?

A. Yes, sir.

Q. Are you acquainted with the goods manufactured by Dunbar & Sons?

A. Yes, sir; I have seen the goods they have put on the market—some of their cans.

Q. What knowledge have you of their goods? Have you dealt in their goods?

A. No, sir. On one occasion we may have bought some on an order from a party outside.

Q. Not regularly?

A. No, sir.

Q. Have you ever had an opportunity for comparing their goods with yours?

A. Yes, sir.

Q. In regard to the merits of each article?

A. Yes, sir; I have had the best opportunity in the world for that in selling the goods. It has been my plan in selling the goods to open a can of Messrs. Dunbar's goods and a can of ours,
108 and to put them alongside of each other, then explain the difference between the two patents, and sell our goods invariably.

Q. Well, what is the difference; how do the goods compare with each other?

A. I invariably, when I have opened the cans, succeeded in making a sale of ours as being the better article.

Q. What is the difference between them?

A. Dunbar's goods are packed in a bag; his goods had their black looking deposit on the outside of the bag. I have seen it on the outside of the bag, sir. In the cans I have opened, when the bag is imperfect, I have seen the shrimp—a black deposit on the shrimps themselves when the bag had not been properly sealed up.

Q. You have seen this black deposit on every can that you opened?

A. Not in every can, but out of 9-10 of the cans I have seen, I have seen the black deposit in them. I will make that ex-
109 ception.

Q. Well, is there any black deposit on the outside of the envelope of White & Co.'s shrimps?

A. A black deposit? No, sir.

Q. Well, how did they compare?

A. Those goods; how they compared? If the goods have not been properly packed, I have seen cans of our goods that have been opened where the paper at times had slipped, or something in that way, when the shrimp had come in direct contact with the can, I have seen a deposit, a black deposit. I have seen the paper, when the paper was imperfect, in some way not perfectly parafined, those goods were spoilt you may say.

Q. Well, what was the proportion of those you have seen?

A. In the proportion? I have seen one or two cans in that way; it is caused by the paper not being perfectly parafined.

Q. You have only seen one or two in that way?

A. Yes, sir; and I have seen goods where the heads were carried in, where the soldering-irons have burned the paper.

110 Q. How many of them have you seen? What proportion have you seen where they were burned by the soldering-irons?

A. Well, pretty much all of them?

Q. Burned by the soldering-irons?

A. Yes, sir.

Q. That don't affect the shrimps?

A. No, sir; it don't affect the shrimps in any way.

Q. Do you know Mr. Wallace?

A. Yes, sir.

Q. Did you have anything to do with inducing Mr. Wallace to leave the employ of Dunbar & Sons?

A. No, sir; Mr. Wallace came and, I think, saw Mr. Pecor and told him, told Mr. Pecor, that he would like to go to work, and Mr. Pecor told us of it. Wallace then represented to us that he was out of the employ of G. W. Dunbar & Sons. We employed him, knowing that he had left that place on his own statement, not having *not having* previously seen us about the matter. Never saw us until he applied to us for the work.

No cross-examination.

111 *Affidavit of T. T. White, referred to in and made part of the foregoing testimony.—Filed by def'ts March* 30, 1882.

U. S. Circuit Court, east'n dist. of La.

GEO. H. DUNBAR et al.
vs.
T. T. WHITE et al. } No. 9858. In Chancery.

Theodore T. White, deing duly sworn, deposes and says that he is one of the defendants in this suit; that it is true that affiant is engaged in this city in putting up shrimps in cans for sale, but affiant is not in any way violating any patent right that the complainants herein allege that have or that has been granted them, or in any manner infringing upon the same; that the processes used by affiant in canning shrimps are altogether different from those used by complainants, and in no manner infringe upon the patent right claimed by the complainants; that the process used by this affiant is as follows: the cans being ready for packing, three pieces

112 of paper, previously boiled in parafine wax, are coated with the same; are cut and placed in the can so that one piece covers the bottom, another piece the sides, and a third piece the contents when the can is filled; the shrimps are picked raw, then washed and thoroughly cooked for about twenty minutes and until fit to eat; they are then placed in the cans, which are soldered and then put into a steam retort, without water, which is heated to two hundred

and forty degrees Fahrenheit, where they remain from 2½ to 3 hours, which process has the effect of condensing the air and liquids in the can, and exterminating any animal or vegetable life that may remain in the contents of the can; after which the shrimps are ready to be labeled and sold.

Now, affiant shows that the process employed by the complainants in putting up their shrimps in can, under their pretended patent, is very different from that use by this affiants. The complainants pro-
113 ceed as follows: The cans are furnished with linen or muslin bags, or bags made of some other textile material, sewed up on the sides, and with bottoms sewed in about the same diameter as cans, and enough longer to enable the top to fold over and make a coating over the top of the contents of the can when filled. The shrimps are picked raw and washed, then put into wire baskets and subjected to boiling heat for five minutes only in a receptacle containing water three degrees salt by the saltometer. After boiling five minutes exactly, and before they are thoroughly cooked, they are then removed to tables and allowed to cool. After cooling, the cans are filled, being prepared as before stated, and soldered, and are then subjected to a process in the Schreiver patent kettle, which is a wrought-iron kettle with cast-iron top, containing one-third water, in which live steam is admitted, the top being steam-tight; and after being brought to a heat of 245° Fahrenheit, they are boiled
114 for ninety minutes, and then taken out of said Schreiver kettle. The said cans are submerged in cold water for about ten minutes, and they are then ready for labelling, and after that for sale.

And affiant further says that the placing of the shrimps in the can while they are in a moist or dry condition and devoid of free liquor or gravy, sealing the cans without adding any liquid to their contents, and cooking the contents of the cans after sealing, are not means and processes invented or discovered by complainants or their father, and which they now pretend were patented by them under original patent No. 178,916, and reissued patent No. 9,957, but such means and processes were used long before the dates of said patents in putting up can goods of all kinds, meat, fish, shell-fish, game, poultry, vegetables, fruit, &c., and complainants have no right to the
115 exclusive use of such means and processes, and such is not given to them by said patents, and is not claimed in their application for said patent; and, if it were given to them by said patents, would be null and void by reason of said means and processes having been publicly in use long before the date of said patents, or of the application therefor.

That the providing of the cans with bags to hold the contents thereof, and to prevent direct contact of said contents with the metal of the can, is not a means or process invented by complainants or their father, and which they pretend was patented by them under the patents above named; but said means and process was discovered and used long before the date of said patents, or of the application therefor, and is described exactly in a patent No. 156,693,

issued to George H. Chinnock, under date of November 10th, 1874, application filed May 15th, 1874, more than two years prior to the issuance of complainant's first patent. A copy of the patent
116 issued as aforesaid to said Chinnock is hereto annexed as part of this affidavit.

And affiant further says that it is not true that complainants have been the only persons packing shrimps since the issuance of their said patents until affiants commenced the business; because more than a year ago, and until very lately, the Mexican Gulf Packing Co. have been packing shrimps in cans, using the very same processes as those used by complainants, except that they used a paper bag instead of the textile bag as used by complainants, and in place thereof; and complainants well knew of the said proceedings of said Mexican Gulf Packing Co., and have taken no steps to stop or prohibit the same.

Now, affiant further says that on the 13th of August, 1879, Emmett C. Pecor and Frederick W. Bartlett, of Galveston, Texas,
117 having previously made the invention hereafter described, and tested and proved its merits by various and continued previous experiments, filed an application for a patent in the Patent Office for a new and useful invention in canning shrimps and other fish; and said Bartlett having assigned all of his right, title, and interest in said invention to said Pecor on the 6th of April, 1880, letters patent issued to said Pecor for said invention under the number 226,347. In the specifications of said patent the following declaration is made, showing that the attention of the proper officers of the Patent Office was primarily called to the patent of the complainants when the patent of said Pecor was applied for: therefore it has been the practice in canning shrimps and like shell-fish to inclose the fish in a bag made of some textile fabric, to place the bag containing the fish within an ordinary tin can, and then to subject the can and its contents to the ordinary boiling and mode of treatment such as are ordinarily used in canning vegetable and animal substances;
118 and it is further declared therein that said invention consists, instead of the ordinary bag of textile material which has heretofore been used to inclose the shrimps, we have found that a cheaper and better substitute may be made from paper, which we prepare and apply in the following manner, and then follows a description of the use of the paper just as this affiant uses it, and as hereinbefore set forth; that said specifications go on to say that "the subsequent treatment is in accordance with the well-known practice in canning vegetable and animal substances. This paper lining is much more cheaply and expeditiously applied than the cloth bags heretofore used, as no sewing is required;" whereupon said inventors made the following claim, which was allowed by said patent: "An interior paper lining prepared with parafine as and for the purpose set forth;" all of which will more fully appear by reference
119 to said patent, which is hereto annexed and made a part of this affidavit.

That on the 4th day of January, 1882, this affiant bought and pur-

chased the said patent No. 226,347 from said Pecor for a valuable consideration, and said Pecor transferred said patent to this affiant, and said transfer was duly recorded in the Patent Office on the 7th day of January, 1882; all of which will more fully appear by reference to said transfer and the certificate of record, which are also hereto annexed and made part of this affidavit, and this affiant has ever since been the owner of said patent, and all the business of canning shrimps that this affiant has ever done has been by authority of said patent.

And affiant further saith that the original patent under which complainants claim their original invention, No. 178,916, was issued on the 20th of June, 1876, on an application filed the 1st February, 1876, and under the specification filed by complainants
120 and their ancestor for said patent. The only thing which they claimed as new and which they desired to secure by letters patent was "the herein described method of preserving shrimps and preventing their discoloration, *which consists* in placing *textile fabric* between the can and its contents, and then sealing the can and subjecting the same to a boiling process," and the said complainants rested satisfied with said claim and their said letters patent until long after the issuance of aforesaid patent to the said Pecor, to wit, until the 9th of April, 1881, when complainants made and filed an application for reissued letters patent, which were issued to them under the number No. 9957 on 6th of December, 1881, and in their specifications for said reissue they made the following claim as new: "As an improvement in the art of preserving shrimps in metal cans, the mode of preventing the discoloration of the shrimps,
121 which consists in interposing between the metal can and the shrimps an enveloping material for the shrimps, which is not itself capable of discoloring the shrimps, and then sealing the can and subjecting the same and its contents to a boiling process, substantially as described;" that said reissue was contrary to law and void, inasmuch as the delay for the application of said reissue was unreasonable, and said reissued patent could not lawfully be reissued, as it was not for the purpose of enlarging the claim and extending the scope of the patent after the discoveries had been made by another inventor and duly patented by him; and said reissued patent is void as covering new matter, and more than the complainants had a right to claim.

(Signed) T. T. WHITE.

Sworn to and subscribed before me, notary, this 25th March, A. D. 1882.

[SEAL.] (Signed) CHAS. T. SONIAT,
Not. Pub.

122 Emmett C. Pecor, being duly sworn, deposes and says that he has carefully read the above affidavit of T. T. White, and corroborates and confirms the same in every particular.

(Signed) E. C. PECOR.

Sworn to and subscribed before me, notary, this 25th of March, A. D. 1882.

[SEAL.] (Signed) CHAS. T. SONIAT,
Not. Pub.

Affidavit of William Wallace, referred to in and made part of the foregoing testimony.—Filed by defendants March 30, 1882.

U. S. Circuit Court, eastern dist. of La.

GEO. H. DUNBAR et al.
vs.
T. T. WHITE et al. } In chancery.

William Wallace, being duly sworn, deposes and says that he is at present employed as foreman for T. T. White & Co., and is familiar with the manner of preserving and packing shrimps in that establishment; that the cans being ready for packing three pieces of
123 paper, previously boiled in parafine wax, are cut and placed in the can, so that one piece covers the bottom and another piece the sides, and a third piece the contents when can is filled; the shrimps are picked raw, then washed and thoroughly cooked for about twenty minutes, and until fit to eat; they are then placed in the cans, which are soldered, and the cans are then put into a steam retort, without water, which is heated to 240° Fahrenheit, where they remain from two and a half to three hours, which process has the effect of condensing the air and liquid in the can, and exterminating any animal or vegetable life that may remain in the contents of the can, after which the shrimps are ready to be labelled and then sold.

That affiant was formerly in the employment of the complainants, and was foreman for them from August, 1881, to February, 1882; that the process of preserving and packing shrimps used by complainants was entirely different from that used by defendants;
124 in complainants' establishment the cans are furnished with linen or muslin bags, or bags made of some textile materials sewed on the sides and with bottom sewed in about the same diameter as cans, and enough longer to enable the top to fold over and make a coating over the top of the contents of the can when filled; the shrimps are picked raw and washed, then put into wire baskets and subjected to a boiling heat for five minutes only in a receptacle containing water three degrees salt by the saltometer; after boiling five minutes exactly, and before they are thoroughly cooked, they are then removed onto the tables and allowed to cool; after cooling, the cans are filled, being prepared as before stated, and soldered, and are then subjected to a process in the Schreiver patent kettle, which is a wrought-iron kettle with cast-iron top, containing one-third water, in which live steam is admitted, the top being steam-tight; and
125 after being brought to a heat of 245° Fahrenheit, they are boiled for ninety minutes, and then taken out of said Schreiver

kettle; the said cans are submerged in cold water for about ten minutes, and they are then ready for labelling, and after for sale.

That the placing of the shrimps in the can while they are in a moist or dry condition, and devoid of free liquor or gravy, sealing the cans without adding any liquid to their contents, and cooking the contents of the can after sealing, are not means and processes invented and discovered by complainants or their father, and which they now pretend were patented by them under original patent No. 178,916 and reissued patent No. 9957, but such means and processes were used long before the date of such patents. Affiant has been engaged since 1848 in putting up canned goods; has put up in cans lobster, shad, oysters, and other kinds of fish; all kinds of
126 meat, both fresh and corned, and poultry and game, and all kinds of vegetables, and has used for all of them, since said year 1848, and prior to the year 1876, the same process as used by complainants, with the exception of the lining of the can; except that in place of the Schreiver kettle affiant has used for the same purpose, and to produce the same effect, chloride of calcium, which is a product of salt, and used in an opened kettle by which the same degree of heat can be obtained as by the use of the Schreiver kettle; that all of the above named articles so canned by affiant in said years prior to the year 1876 were partially cooked before going into the can, and the process used by complainants, and as above described, were used before 1876 in factories in which I was employed, in New York, in Baltimore, in Burlington, New Jersey, in Norfolk, Virginia, and in Fulton, Texas.

127 Providing the cans with a lining to prevent direct contact of the contents with the metal, is not a means or process invented by complainants or their father, and which they pretend was patented by them under the patents above named, but such means and process was used long before the date of said patent, and is described exactly in a patent, No. 156,693, issued to one George H. Chinnock under date of November 10th, 1874, application filed May 16th, 1874, more than two years prior to the issuance of complainants' patent; a copy of the patent issued, as aforesaid, to said Chinnock, is hereto annexed as part of this affidavit; and further this deponent saith not.

(Signed) WM. WALLACE.

Sworn to and subscribed before me on this 22d day of March, A. D. 1882.

[SEAL.] (Signed) MARK BREEDEN, JR.,
Notary Public.

Document marked "P," referred to in and made part of the foregoing affidavit of T. T. White.—Filed by def'ts March 30, 1882.

128 G. H. Chinnock.

Packages for jellies, jams, etc. No. 156,693; patented Nov. 10, 1874.

No. 924.
Page 128.

Fig. 1.

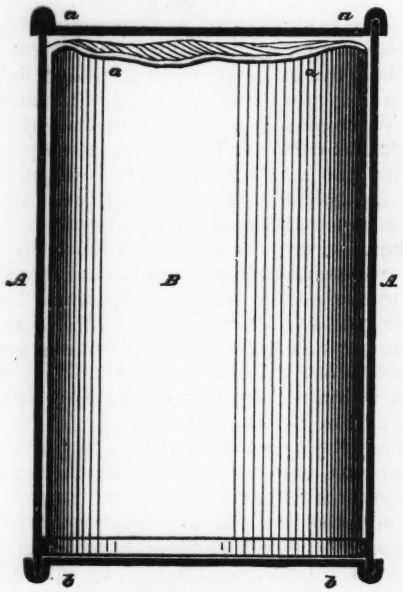
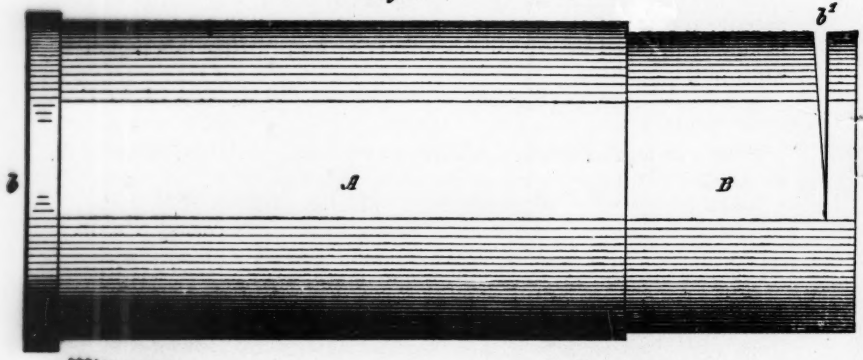


Fig. 2.



Witnesses:
WM. EDWARDS.
WM. B. PHAIR.

Inventor:
GEO. H. CHINNOCK.

129 UNITED STATES PATENT OFFICE.

George H. Chinnock, of Brooklyn, New York.

Improvement in packages for jellies, jams, &c.

Specifications forming part of letters patent No. 156,693, dated November 10, 1874; application filed May 16, 1874.

To all whom it may concern:

Be it known that I, George H. Chinnock, of Brooklyn, in the county of Kings and State of New York, have invented certain improvements in closed packages of jelly, jams, marmalades, &c., of which the following is a specification:

This invention comprises a sealed paper package of jelly, jam, marmalade, mince-meat or similar sweetmeat, made and constituted as an article of manufacture and trade, hitherto unknown, and embracing the combination with an external shell of stiff paper or paper board of an internal paper bag provided for the immediate reception of the jelly, jam, or marmalade, as the case may be.

Figure 1 is a vertical sectional view of a package made
130 according to my invention, as closed for storage or transportation. Figure 2 is a side view of the same as opened and in use during the removal of a portion of its contents.

A is a cylindrical shell or case made of stiff paper or paper board, and fitted with a permanent bottom "a" and a removable head "b." This shell or case should be made of inodorous paper, and is preferably water-proofed on its external surface by any suitable means. B is a bag made of cylindrical form, and of somewhat less diameter than the internal diameter of the shell or case "A," so that when filled it may pass readily into the same. The bag B should furthermore be of such length that when filled to the requisite degree and placed within the shell its upper part may be folded over its contents as indicated in Fig. 1. This bag should be made of paper, water and air proofed by treatment with paraffine, or equivalent mate-
131 rial which will not impart objectionable taste or odor to the contents of the bag; the bag should be placed within the shell with its upper end opened and projecting above the top of the said shell; the jelly, jam, marmalade or like substance then poured in a hot or melted condition into the bag, when by cooling it resumes its viscous or comparatively firm condition; the upper end of the bag is then closed down over the contents as indicated in Fig. 1, and the cover *b* is placed upon the shell to tightly close the same. When desired a strip of paper may be placed over the joint at "a," between the cover and the shell, to retain the cover more securely in place and increase the air and water proof character of the shell.

It will be seen that by inclosing the jelly, jam, marmalade or the like within paper, inodorous and tasteless, the deleterious effects that sometimes arise from the absorption of salts of tin when sweetmeats

are inclosed in tin cases are wholly avoided at the same time
132 that there is also avoided that injury to the taste and flavor of sweetmeats which occurs when they are packed in wood having, as is commonly the case, an objectionable taste or odor. As thus put the sweetmeats may be kept intact for any length of time, and carried and transported from place to place without injury.

When it is desired to remove or use a portion of the contents of the package, the cover *b* is taken off, the shell is partially inverted, and the bag B and its contents allowed to slide outward a portion of its length, as indicated in Fig. 2. This done, the desired portion may be cut off by the use of a knife as indicated at *b* in Fig. 2, after which the remaining part may be returned within the shell by bringing the latter to its upright or normal condition, and be kept for future use by simply replacing the cover upon the shell.

133 It will be understood that when desired the package may be used without the internal bag, and made of round, square, or oval form, as may be preferred.

What I claim as my invention is—

As a new article of manufacture, the air and water tight package of jelly, jam, marmalade, or mince-meat used with the internal bag, substantially as and for the purpose set forth.

GEO. H. CHINNOCK.

Witnesses:
JAMES A. WHITNEY.
WM. B. PHAIR.

Patent A, referred to in and made part of the foregoing affidavit of T. T. White.—Filed by defendants March 30, 1882.

THE UNITED STATES OF AMERICA.

No. 226,347.

To all to whom these presents shall come:

134 Whereas Emmett C. Pecor and Frederick W. Bartlett, of Galveston, Texas, have presented to the Commissioner of Patents a petition praying for the grant of letters patent for an alleged new and useful improvement in canning shrimps and other fish, said Bartlett having assigned his right, title, and interest in said improvement to said Pecor, a description of which invention is contained in the specifications of which a copy is hereunto annexed and made a part hereof, and have complied with the various requirements of law in such cases made and provided; and

Whereas, upon due examination made, the said claimants are adjudged to be justly entitled to a patent under the law:

Now, therefore, these letters patent are to grant unto the said Emmett C. Pecor, his heirs or assigns, for the term of seventeen years from the sixth day of April, one thousand eight hun-
135 dred and eighty, the exclusive right to make, use, and vend the said invention throughout the United States and the territories thereof.

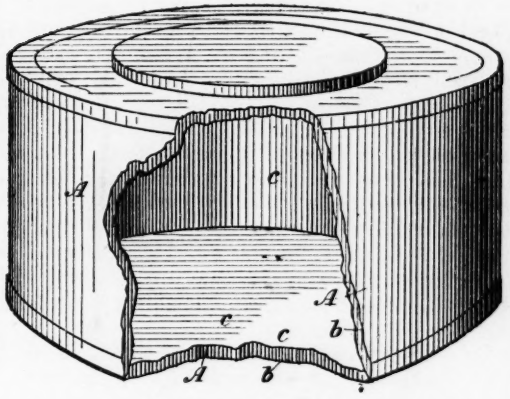
In testimony whereof I have hereunto set my hand and caused the seal of the Patent Office to be affixed, at the city of Washington, this 6th day of April, in the year of our Lord one thousand eight hundred and eighty, and of the Independence of the United States of America the 104th.

[SEAL.] (Signed) A. BELL,
Acting Secretary of the Interior.

Countersigned—
(Signed) H. E. PAINE,
Comm'r of Patents.

E. C. Pecor and F. W. Bartlett.—Canning shrimps and other fish.—No. 226,347.—*Patented April 6*, 1880.

No. 924; page 135.



136 Inventors:
EMMETT C. PECOR.
FREDERICK W. BARTLETT.
By ELLIS SPEAR, *Atty.*

Witnesses:
R. F. BARNES.
F. L. MIDDLETON.

UNITED STATES PATENT OFFICE.

Emmett C. Pecor and Frederick W. Bartlett, of Galveston, Texas, said Bartlett assignor to said Pecor.

Canning shrimps and other fish.

Specification forming part of letters patent No. 226,347, dated April 6th, 1880; application filed August 13, 1879.

To all whom it may concern:

Be it known that we, Emmett C. Pecor and Frederick W. Bartlett,

of Galveston, Texas, have invented an improvement in [5] preserving shrimps and other fish, of which the following is a specification.

Our invention relates to the canning of shrimps and other like shell-fish, and has for its object the better preservation of [10] the fish and greater expedition and cheapness in canning.

Heretofore it has been the practice in canning shrimps and
137 like shell-fish to inclose the fish in a bag made of some textile fabric, to place the bag containing the fish [15] within an ordinary tin can, and then to subject the can and its contents to the ordinary boiling and mode of treatment such as are ordinarily used in canning vegetables and animal substances.

This mode of treatment, when applied to the preservation [20] of shrimps, is, to a certain extent, defective, for the reason that certain acids, or acidulous substances, existing in or generated from the fish attack the tin can, and thereby impart to the contents [25] an unpleasant taste greatly affecting the quality of the food thus preserved.

The first part of our invention has for its object to obviate this difficulty, and it consists in lining the can with a coating of asphaltum [30] cement. This coating we form of any good quality of asphaltum dissolved in any solvent suitable for the purpose. When the solution is of proper consistency for convenient application we coat in any convenient way [35] the whole interior of the can
138 therewith, and also apply a coating to the inside of the cover which has been previously fitted to the can; the coating within the can and upon the cover is then thoroughly dried, and the can [40] is then ready to receive its contents. This coating effectually protects the metal of the can from the action of any acids or acidulous substances, and we have found by careful and thorough experiments that it serves to preserve the shrimps perfectly [45] fresh and sweet.

Besides its quality of resistance to the action of acid, it is tough and flexible, and does not break when the can, as often happens, is indented or bent.

[50] In carrying out the second part of our invention, instead of the ordinary bag of textile material which has heretofore been used to enclose the shrimps we have found that a cheaper and better substitute may be made from paper, which we prepare and apply
139 in the [55] following manner: The paper being first coated with a hot solution of paraffine, or kindred substance, paraffine being the best, we cut from any suitable kind of paper two disks just large enough to fit into [60] the can; we then cut another strip of paper in width just equal to the interior depth of the can, and long enough, when placed within the can, to cover the interior surface; we then place one disk of paper upon the [65] bottom of the can, the interior surface having been previously coated as heretofore described; we next place the strip of paper which is to cover the walls of the can in proper position, then fill the can with the shrimps, [70] put in place the paper cover, then solder upon the can the tin covering; the subsequent treatment is in accordance with the

well known practice in canning vegetables and animal substances; this paper [75] lining is much more cheaply and expeditiously
140 applied than the cloth bags heretofore used, as no sewing is required.

We have found also that the large intestine of animals may be utilized for this purpose by thoroughly cleansing and [80] cutting them of proper length; they may be closed at the lower end by tying in the ordinary manner.

Referring to the accompanying drawing, which represents a can with the cover in place and one side partly broken away, [85] A is the outer shell of metal, the bituminous coating is represented at *b*, and paper at *c*.

Manifestly the proportions of the can may be changed without departing from the [90] spirit of our invention.

We are aware that wooden cans and boxes have heretofore been known with a lining of asphalt or paratine, and we are also aware that tin cans have been heretofore lined with copal varnish; we do not therefore [95] broadly claim the lining of cans with asphaltum without regard to the material of which the can is made, and dis-
141 tinctly limit our claim to the flexible lining described, which, as heretofore stated, with tin [100] metal cans has sufficient toughness and flexibility to bend with the metal of the can without cracking and consequent exposure to the action of acids contained in or generated by the contents [5] of the can.

Having thus described our invention, what we claim is—

1. In a flexible metallic can for shrimps and like fish, a coating of asphaltum cement covering the inner surface of [10] the can and adhering to the metal, as and for the purposes set forth.

2. In combination with the metallic can lined with asphaltum cement in the manner described, an interior paper [15] lining, prepared with paraffine, as and for the purposes set forth.

In testimony whereof, we have signed our names to this specification in the presence of two subscribing witnesses.

142 EMMETT C. PICOR.
FREDERICK W. BARTLETT.

Witnesses:
A. J. WALKER.
CHARLES EVANS.

Affidavit of George Brown.—Filed by def'ts March 30, 1882.

U. S. Circuit Court, east'n dis't of La.

GEORGE H. DUNBAR et als. *vs.* T. T. WHITE et als. } No. 9858. In Chancery.

George Brown, superintendent of the packing establishment of T. T. White & Co., being duly sworn, deposes and says that he is familiar with the manner of preserving and packing shrimps in that

establishment; that the cans being ready for packing, three pieces of paper previously boiled in paraffine wax are cut and placed in the cans so that one piece covers the bottom and another piece the side and a third piece the contents of the can when filled; the
143 shrimps are picked raw, then washed and thoroughly cooked for about twenty minutes, and until fit to eat; they are then placed in the cans, which are soldered, and the cans are then put into a steam retort without water, which is heated to 240° Fahrenheit, where they remain from 2½ to 3 hours, which process has the effect of burning out the air from the cans, after which they are ready to be labelled and then sold.

That the claim of the complainants in their bill herein filed, that the placing of shrimps in cans while they are in a moist or dry condition and devoid of free liquor or gravy, sealing cans without adding liquid to their contents, and cooking the contents of the cans after sealing, are means and processes invented by complainants or their father, and which they now pretend were patented by them under original patent No. 178,916 and reissued patent No. 9,957, is not correct, or good or valid, because such means and pro-
144 cesses were used long before the date of said patents; that affiant was employed in Montreal, Canada, in 1874, by the North American Packing Co., in putting up canned goods of all kinds—meats, fish, game, poultry, and vegetables—where the same process was used as is used to-day in the establishment of defendants, (with the exception of the lining of the can,) and where retorts similar to those used by defendant were used for the same purpose and in the same way, and where water baths and calcium baths were used to cook the con'ts of the cans after the same had been filled with meats or other edibles, while in a moist or dry condition and devoid of free liquor or gravy, said cans being sealed without adding any liquid to their contents, just as the shrimps are treated by the complainants, as affiant is informed.

That providing the cans with a lining to prevent direct con-
145 tact of the contents with the metal is not a means or process invented or discovered by complainants or their father, and which they pretend was patented by them under the patents above named, but such means and process was used long before the date of said patents, and is described exactly in a patent No. 156,693, issued to one George H. Chinnock under date of November the 10th, 1874; application filed May 10th, 1874, more than two years prior to the issuance of complainants' patent; a copy of said patent issued as aforesaid to said Chinnock is hereto annexed as part of this affidavit. And further deponent saith not.

(Signed) GEO. BROWN.

Sworn to and subscribed before me this 22d day of March, A. D. 1882.

[SEAL.] (Signed) MARK BREEDEN, JR.,
Not. Pub.

Transfer "B," referred to in and made part of the foregoing affi-
146 *davit of T. T. White.—Filed by def'ts March* 30, 1882.

Whereas Emmett C. Pecor and Frederick W. Bartlett, of Galveston, Texas, have invented a certain new, useful improvement in canning shrimps and other fish, and for which letters patent have been issued to said Emmett C. Pecor in his own right and as assignee of said Frederick W. Bartlett, under the number 226,347, under date of April 6th, 1880; and whereas T. T. White, of New Orleans, Louisiana, is desirous of acquiring the entire interest in the same—

Now, therefore, to all whom it may concern, that for and in consideration of the sum of one thousand dollars to me in hand paid by said T. T. White, the receipt whereof is hereby acknowledged, I, said Emmett C. Pecor, have sold, assigned, and transferred, and by these presents do sell, transfer, and assign unto said T. T. White, the
147 whole right, title, and interest in and to said improvement in canning shrimps and other fish, and in and by the letters patent therefor, as aforesaid; the same to be held and enjoyed by said T. White for his own use and behoof, and to the use and behoof of his legal representatives, to the full and of the term for which said letters patent are or may be granted, including any extensions, as fully and entirely as the same would have been held and enjoyed by me if this assignment had not been made.

In faith whereof I have hereunto set my hand and seal this fourth day of January, A. D. eighteen hundred and eighty-two.

[SEAL.] (Signed) E. C. PECOR.

Attest:
Signed: P. A. ORY.
JNO. J. WARD.

STATE OF LOUISIANA, }
City of New Orleans. }

On this fourth day of January, A. D. 1882, before the undersigned, a qualified notary public in and for the parish of Orleans,
148 State of Louisiana, appeared the above named Emmett C. Pecor, to me to be personally known to be the individual described in and who acknowledged that he executed to same as his act and deed for the uses and purposes therein mentioned.

As witness my hand and seal.

[SEAL.] (Signed) ANDREW HERO, JR.,
Not. Pub.

Exct. F. C. Y.

Received for record Jan'y 7th, 1882, and recorded in Liber H 27, page 470 of transfers of patents.

In testimony whereof I have caused the seal of the Patent Office to hereto affixed.

(Signed) V. D. STOCKBRIDGE,
Acting Commissioner.

Hearing and submission of application for Injunction pendente lite.

Extract from the Minutes of March 30, 1882.

GEORGE H. DUNBAR et al.
vs.
T. T. WHITE et al. } No. 9858.

This cause came on to be heard on the complainants' ap-
149 plication for an injunction *pendente lite*, and was argued by the counsel for the parties respectively and submitted, when the court took time to consider.

Order allowing Injunction pendente lite.

Extract from the Minutes, April Term, 1882.

NEW ORLEANS, *Monday, April* 24, 1882.

Court met pursuant to adjournment. Present: Hon. E. C. Billings, district judge.

GEORGE H. DUNBAR et al.
vs.
T. T. WHITE et als. } No. 9858.

This cause came on to be heard on the application of the complainants for an injunction *pendente lite*, and was argued by counsel. On consideration whereof, it is ordered that an injunction *pendente lite* issue herein, enjoining and inhibiting the defendants herein
150 in manner and form and to the extent prayed for in complainants' bill of complaint.

Motion for Bond, and order fixing same for hearing.

Extract from the Minutes of April 25th, 1882.

GEO. H. DUNBAR et als.
vs.
T. T. WHITE et als. } No. 9858.

And now come the defendants herein by their counsel, Joseph P. Hornor and Francis W. Baker, and move the court to so modify the order for injunction herein *pendente lite* as to require the complainants to give bond, with good and solvent surety conditioned as the law directs, in the sum of $50,000, to pay said movers all costs and damages they may suffer in the event the writ of injunction herein is wrongfully issued and allowed.

Whereupon, upon consideration thereof, it is ordered that
151 said motion be filed and be heard on 29th instant at 11 A. M. And the counsel for complainants, here present in open court, accepts notice thereof.

Continuance of Motion for Bond.

Extract for the Minutes of April 29, 1882.

GEO. H. DUNBAR et al.
vs.
T. T. WHITE et als. } No. 9858.

Ordered that the motion for bond herein, returnable this day, go over till Saturday, 6th May, 1882, at 11 o'clock a. m.

Entry at Rules.

Extract from Chancery Order Book, May Rules, 1882.

GEO. H. DUNBAR et als.
vs.
T. T. WHITE et als. } No. 9858.

MONDAY, 1ST.

The defendants herein, by J. P. Hornor and F. W. Baker, their solicitors, have this day entered their appearance to complainants' bill of complaint.

152 *Submission of Motion for Bond.*

Extract from the Minutes of May 27, 1882.

GEO. H. DUNBAR et als.
vs.
T. T. WHITE et als. } No. 9858.

This cause came on to be heard on the motion of the defendants for bond, and was argued by the counsel for the parties respectively and submitted; when the court took time to consider.

Answer and 3 Exhibits.—Filed June 5th, 1882.

U. S. Circuit Court, eastern dist. of La.

GEO. H. DUNBAR et als.
vs.
T. T. WHITE et als. } No. 9858. In Chancery.

To the Honorable the Judges of the Circuit Court of the United States for the eastern district of Louisiana:

153 The answer of Theodore T. White, William A. Gordon, and Emmett C. Pecor to the bill of complaint of George H. Dunbar, Francis B. Dunbar, and Charlotte Z. Dunbar, complainants.

These defendants, now and at all times hereafter saving and reserving to themselves any and all manner of benefit and advantage of exception to the many errors and insufficiencies in the complain-

ants' said bill of complaint contained, for answer thereunto, or unto so much or such parts thereof as this defendant is advised is material for him to make answer unto, answers and says:

1st. That it is not true that as set forth in the first paragraph of said bill of complaint, that on or about the 14th day of January, 1876, or at any other time, Geo. W. Dunbar, Geo. H. Dunbar, and Francis B. Dunbar were the true, original, and first inventors or discoverers of a certain new and useful invention, to wit, a new and useful improvement in preserving shrimps in metal cans, not known or used by others before their invention or discovery thereof,
154 &c., as set forth in said paragraph, but that the truth and facts are and were as hereinafter set forth in this answer; that the same had long been known to the public, and for more than two years had been previously claimed to have been invented and discovered by one George H. Chinnock, of Brooklin, New York, who filed an application for a patent therefor on 16th May, 1874, and to whom letters patent therefor were granted, under the No. 156,693, on the 10th of November, 1874, more than two years prior to the issuance to the complainants' original patent. A copy of the drawings, specifications, and claim of said Chinnock letters patent No. 156,693 are hereto annexed and prayed to be taken as a part of this answer and marked "Exhibit P."

2d. That it is true that application was made for a patent, as set forth in the second paragraph of said bill of complainants.

155 3d. That it is true that James T. Emerson was duly appointed and qualified as the administrator of the estate of George W. Dunbar, as set forth in the third paragraph of said bill complaint.

4th. That is true that letters patent issued as set forth in the fourth paragraph of said bill of complaint.

5th. That is true that letters patent under the number 178,916 issued as set forth in the fifth paragraph of said bill of complaint.

6th. That it is true that after issuance of said letters patent the said Geo. W. Dunbar, Geo. H. Dunbar, and Francis B. Dunbar did pack and preserve shrimps according to the process described in the specifications and claim annexed to said letters patent No. 178,916, but they were not the inventors of said process, and were not in the exclusive use and possession of the same, but the same and similar processes were used by others, and were in general use more than two years before and since the issuance of said letters patent.

156 7th. And as to the matters contained in the seventh paragraph of said bill of complaint, these defendants are advised that they need not further answer the same.

8th. That it is not true that on or about the 6th day of December, 1881, that the said James T. Emerson, George H. Dunbar, and Francis B. Dunbar found that said letters patent No. 178,916 were inoperative by reason of a defective or insufficient specification, and it is not true that there was any error having arisen by any inadvertence or mistake, but that the application for a reissue thereafter

alluded to was made with fraudulent and deceptive intention on the part of said Emerson and said George H. and Francis B. Dunbar, and was so made without the knowledge of defendants after the issuance to Emmett C. Pecor, one of these defendants, of the letters patent No. 226,347, hereinafter fully described and set forth, with the fraudulent intention of thereby annulling and rendering invaluable the said letters patent No. 226,347 by claiming and
157 procuring to be issued reissued letters patent for a different invention from that which said letters patent No. 178,916 were issued by the introduction of new matter into the claim and specifications; and that it is true that thereupon said letters patent No. 178,916 were surrendered, and that fraudulently and wrongfully new letters patent, ostensibly but not really for the same invention, a reissue as pretended, were on the 6th of December, 1881, issued and delivered under the No. 9957, as set forth in the eighth paragraph of said bill of complaint, but the same was not put into use by the complainants in any manner, and the process described in said reissued patent has not been put into use by said complainants in any other manner than that in which they used a part of the same as described in the specifications of the original letters patent, No. 178,916, of which they were not the inventors. They have never been in the exclusive use and possession of any of the processes
158 set forth in either their original or their reissued patents; that said reissued letters patent are absolutely null and void for the following reasons:

1st. That the original letters patent No. 178,916 issued to complainants were in no manner inoperative or invalid by reason of a defective or insufficient specification, or by reason of any error by inadvertence, accident, or mistake, and any allegation of such was a me pretense.

2d. That new matter was introduced into the claim and specification of the reissued letters patent, whereby the same was made broader and comprehended a different invention than that provided for and covered by the original letters patent No. 178,916, to wit: it was provided in the specification of said original patent No. 178,916 that primarily the improvement of the complainants consisted in placing a suitable textile fabric between the fish or other article of food to be preserved, as to cause it to so intervene as to prevent, under all circumstances, any direct contact between
159 the metallic surface of the can and its contents; and it is the employment of such textile fabric, in connection with the process hereinafter described of treating the fish or other article, both before and after the same is placed in the can and sealed, which constitutes the nature or subject-matter of our present invention; and what complainants claim as new consisted in placing textile fabric between the can and its contents, while in the complainants' reissued patent No. 9957 their pretended invention is set forth in the specification as consisting in "first providing the can with a lining to prevent direct contact of the shrimps with the metal;" and what they

claim as new consisted "in interposing between the metal can and the shrimps an enveloping material for the shrimps which is not itself capable of discolor the shrimps," &c., an entirely different invention, if there was any invention at all by complainants, which is denied. 3d. That the delay in the application for the re-
160 issued letters patent was unreasonable, and during which complainants slept upon their rights, if any they ever had, and this led the public to rely on the implied disclaimer as to every other enveloping material except textile fabric involved in the terms of the original patent. 4th. That the reissued letters patent of complainants, after so long and unreasonable delay, and after the issuance of the letters patent of Pecor, one of these defendants, as hereinbefore and hereinafter set forth, was an abuse of the power to grant reissues.

9th. That as to the matters set forth in the ninth paragraph of said bill of complaint, these defendants are advised that they have already fully answered the same.

10th. That as to the matters set forth in the tenth paragraph of said bill of complaint, these defendants say that they believe the same to be true and admit the same.

161 11th. That as to the matters set forth in the eleventh paragraph of said bill of complaint, these defendants say that they believe the same to be true, and admit the same, except that they deny that there was ever any invention or discovery made for which the aforesaid letters patent issued.

12th. That as to the matters set forth in the twelfth paragraph of said bill of complaint, these defendants deny that there was ever any invention or discovery made for which complainants' patents issued, and that complainants and their ancestor did not have any exclusive use of any of the processes described and set forth in their said patents.

13th. That as to the matters set forth in the thirteenth paragraph of said bill of complaint these defendants reiterate that there was no invention or discovery, and they deny that the public have generally acquiesced in any exclusive right of the complainants, who have none.

162 14th. That as to the matters set forth in the fourteenth paragraph of said bill of complaint, these defendants say that the same are untrue; that these defendants have not since the 1st day of March, 1882, used any improvement patent by complainants, or preserved shrimps in metal cans by the means and processes set forth in aforesaid patents of the complainants, and do not contemplate doing so.

15th. That as to the matters set forth in the fifteenth paragraph of said bill of complaint, these defendants say that the same are true, so far as they state that these defendants have, since 1st March, 1882, been preserving shrimps in metal cans by providing the cans with a lining to prevent direct contact of the shrimps with the metal, and cooking them as is hereinafter set forth; but they deny that they

have in any way infringed upon any pretended invention of complainants, as set forth in their patents, and they aver that the
163 pretended invention of the complainants were known long before the issuance of the original patent of complainants; that these defendants have been engaged in putting shrimps in cans for sale since the 1st March, 1882, up to the institution of this suit, but that these processes used by these defendants in canning shrimps are altogether different from those used by complainants; that the process used by these defendants is as follows: The common tin cans being ready for packing, three pieces of paces, previously boiled in paraffine wax, or coated with same, are cut and placed in the can, so that one piece covers the bottom, another piece the sides, and a third piece the top of the contents when the can is filled; the shrimps are then picked raw, then washed and thoroughty cooked for about twenty minutes, until fit to eat; they are then placed in the cans, which are soldered, and then put into a steam retort, without water, which is heated to 240° Fahrenheit, where they remain from 2½ to
3 hours, which process has the effect of condensing the air
164 and liquids in the can and exterminating any animal or vegetable life that may remain in the contents of the can, after which they are ready to be labelled and sold. That process used by complainants in canning shrimps is as follows: The cans are furnished with linen or muslin bags, or bags made of some textile material, sewed up on the sides, and with bottoms sewed in, about the same diameter as the cans, and enough longer than the cans to enable the top to fold over and made a coating over the top of the contents of the can when filled; the shrimps are picked raw and washed, then put into wire baskets and subjected to a boiling heat, for five minutes only, in a receptacle containing water three degrees salt by the saltometer; after boiling five minutes exactly, and before they are thoroughly cooked, they are then removed on to tables and allowed to cool; after cooling, the cans are filling, being pre-
165 pared as before stated, and soldered, and are then subjected to a process in the Schriver patent kettle, which is a wrought-iron kettle with a cast-iron top, containing one-third water, in which live steam is admitted, the top being air-tight, and after being brought to heat of 245° Fahrenheit they are boiled for ninety minutes and then taken out of said Schriver kettle; the cans are then submerged in cold water for about ten minutes, and they are then ready for labelling, and after that for sale.

That the placing of the shrimps in the cans while the former are in a moist or dry condition and devoid of free liquor or gravy, sealing the cans without adding any liquid to their contents, and cooking the contents of the cans after sealing, are not means and processes invented or discovered by *by* complainants or their father, and which they now pretend were patented by them under the original
and reissued patents hereinabove set forth; but such means
166 and processes were used and known to the public, and had been in public use in this country for more than two years be-

fore the filing of the application for complainants' said patents, in putting up canned goods of all kinds, meat, fish, shell-fish, game, poultry, vegetables, fruits, &c., and were so used more than two years before the date of said application for said patents by R. M. Hunt & Co. and J. Waltemeyer, of Baltimore; by Louden & Kirby, Kirby & Co., and John P. Allen, of Burlington, N. J.; by the Boston Beef Co., of Fulton, Texas; by Kemp, Day & Co., of New York; and by the North American Packing Co., of Montreal, Canada; and such means and processes were claimed to have been discovered and invented by Isaac Winslow, of Philadelphia, Penn., and a patent issued to him therefor from the U. S. Patent Office on 8th April, 1862, under the No. 34,928, and another patent issued to him therefor on the 13th May, 1862, under the No. 35,274, both of which
167 patents were declared to be invalid, and null and void, for the want of novelty, by the Supreme Court of the United States in the decision of the case of Sewell *v.* Jones, reported in 91st United States Reports at pages 171 to 187, inclusive, which is prayed to be taken as a part of this answer; and said claim of said Winslow was also anticipated by a patent granted by the English government to one Peter Durand, dated 30th August, 1810, a copy of which will be found in said decision reported in 91st United States Reports at pages 177 and 178, which is also made part hereof. That on the 13th August, 1879, Emmett C. Pecor, one of these defendants, and Frederick W. Bartlett, of Galveston, Texas, having previously made the invention hereafter described and tested and proved its merits by various and continued previous experiments, filed an application for a patent in the Patent Office of the United States at Washington for a new and useful improvement in canning shrimps and
168 other fish, and said Bartlett having assigned all his right, title, and interest in said invention to said Pecor on 6th April, 1880, letters patent of the United States, bearing date on that day, were issued to Emmett C. Pecor, whereby was granted to him, his successors or assigns, for the term of seventeen years from said 6th April, 1880, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the invention or discovery for an improvement in canning shrimps and other fish, a description whereof was given in the words of said Pecor and said Bartlett in the schedule annexed to and made part of said letters patent, the same being issued under the number 226,347, as will more full appear by reference to said letters patent, which are hereunto annexed, and prayed to be taken as part of this answer and are marked as an exhibit "Patent A;" that in the schedule
169 of specification annexed to the application for said patent, and which is made part of said letters patent, the following declaration is made, showing that the attention of the proper officers of the Patent Office was primarily called to the patent of the complainants when the patent of the said Pecor was applied for: "Heretofore it has been the practice in canning shrimps and like shell-fish to inclose the fish in a bag of some textile fabric, to place the bag

containing the fish within an ordinary tin can, and then to subject the can and its contents to the ordinary boiling and mode of treatment such as are ordinarily used in canning vegetable and animal substances;" and the invention of Pecor and Bartlett is therein then described to be, "instead of the ordinary bag of textile material which has heretofore been used to inclose the shrimps we have found
that a cheaper and better substitute may be made from paper,
170 which we prepare and apply in the following manner," and then follows a description of the use of the paper just as these defendants use it, and as hereinbefore set forth, and said specification goes on to say "that the subsequent treatment is in accordance with the well-known practice in canning vegetable and animal substances, this paper lining being much more cheaply and expeditiously applied than the cloth bags heretofore used, as no sewing is required;" whereupon said inventors, Pecor and Bartlett, made the following claim, which was allowed by said letters patent: "An interior paper lining prepared with paraffine as and for the purposes set forth;" that on the 4th January, 1882, Theodore T. White bought said letters patent, No. 226,347, from said Emmett C. Pecor for the sum of one thousand dollars, and said Pecor transferred the same to said White,
and said transfer was duly recorded in the Patent Office of the
171 United States at Washington on the 7th day of January, 1882; all of which will at large appear by reference to said transfer and the certificate of the recordation thereof, which are hereto annexed and prayed to be taken as a part of this answer as exhibit marked "Transfer B," and all the business of canning shrimps or other fish that these defendants have ever done has been under the authority of the said patent.

16th. That as to the matters set forth in the sixteenth paragraph of said bill of complaint, these defendants say that they have inflicted no injury upon complainants, and that the matters therein set forth are not true.

17th. And for further answer these defendants aver and allege that by the means used by the complainants in canning shrimps as above set forth with a lining or bag of a *textile fabric*, the "profuse precipitation of a black substance, generally believed to be sulphur,"
is not avoided, but goes on in the sealed cans just as if the
172 bag or lining was not used, but remains deposited between the bag or lining and the sides of the can, and stains the lining a black color, which is disagreeable and unsightly, whereas by used of the means adopted by these defendants there is no pecipitation of the "black substance supposed to be sulphur" whatever in the cans, but when the cans are opened the contents, both shrimps and paper lining, are found in the same condition in color as well as in taste and substance as they were before canning, and therefore the shrimps canned by these defendants were in much greater demand and stood much higher in the market, and were greatly preferred by consumers over the shrimps canned by complainants herein, and all this will more fully appear by opening and comparing the samples

of both kinds filed herein by the complainants, or by opening and comparing the samples of both kinds filed herein by these defendants as exhibits annexed to and made part of this answer.

173 All of which matters and things the said defendants are ready to aver, maintain, and prove as this honorable court shall direct, and they hereby pray to be hence dismissed with their reasonable costs and charges in that behalf sustained.

(Signed) JOSEPH P. HORNOR and
FRANCIS W. BAKER,
Solicitors.

Theodore T. White, William A. Gordon, and Emmett C. Pecor, the defendants herein, who, being duly sworn, depose and say that they have read the foregoing answer and know the contents thereof, and that the same is true of their own knowledge, except as to matters therein stated on information and belief, and as to those matters they believe they are true.

(Signed) T. T. WHITE.
(") W. A. GORDON.
(") E. C. PECOR.

Sworn to and subscribed before me at New Orleans, La., this 5th day of June, A. D. 1882.

[SEAL.] (Signed) MARK BREEDEN, JR.,
174 *Notary Public.*

The exhibits referred to and made part of the foregoing answer have already been transcribed, as follows, to wit: "Exhibit P," at page 127; patent marked "A," at page 133, and transfer B, at page 145 of this transcript.

Extract from Chancery Order Book.

GEORGE H. DUNBAR et al.
vs.
T. T. WHITE et als. } No. 9858.

JUNE 5TH, 1882.

Theodore T. White, William A. Gordon, and Emmett C. Pecor, defendants herein, by Joseph P. Hornor and F. W. Baker, their solicitors, have this day filed their answer to the complainants' bill of complaint.

Order vacating order allowing Preliminary Injunction.

Extract from the Minutes of June 9th, 1882.

GEORGE H. DUNBAR et al.
vs.
T. T. WHITE et als. } No. 9858.

175 This cause came on to be heard on the motion of the defendants to so modify the order allowing preliminary injunc-

tion herein as to require the complainants to give bond in the sum of $50,000, and was argued by counsel. On consideration whereof it is ordered that the order herein made on 24th April, 1882, allowing an injunction *pendente lite*, be, and the same is hereby, vacated, and the following order substituted therefor, viz.:

In this case it is ordered that the defendants keep and file monthly accounts of the articles manufactured or dealt in by them, described in complainants' bill of complaint, and of all sales of same, pending this suit.

Account under order of June 9th, 1882.—Filed July 1st, 1882.

U. S. Circuit Court.

GEORGE H. DUNBAR et als.
vs.
T. T. WHITE et als. } No. 9858.

176 Now come the defendants, and under the order of court herein entered on the 9th day of June, 1882, requiring them to render monthly accounts of such business as may be done by them under the allegations of plaintiffs' bill of complaint herein, and declare that they have not done any such business.

(Signed) JOSEPH P. HORNOR and
F. W. BAKER,
Def'ts' Solicitors.

William A. Gordon, being duly sworn, deposes and says that he is one of the defendants herein, and that the above allegations are true.

(Signed) W. A. GORDON.

Sworn to and subscribed before me this 30th day of June, 1882.

(Signed) MARK BREEDEN, JR.,
Notary Public.

Extract from Chancery Order Book.

GEORGE H. DUNBAR et als.
vs.
T. T. WHITE et als.

JULY 1ST, 1882.

177 The defendants herein, by Joseph P. Hornor and F. W. Baker, their solicitors, have this day, in compliance with the order of court of June 9th, 1882, filed their account.

Replication.—Filed July 6th, 1882.

Circuit Court of the United States for the 5th circuit and eastern district of Louisiana.

GEORGE H. DUNBAR et al.
vs.
T. T. WHITE et als. } No. 9858.

The replication of George H. Dunbar, Francis B. Dunbar, and Charlotte Z. Dunbar to the answer of Theodore T. White, Wm. A. Gordon, and Emmett C. Pecor.

These repliants, saving and reserving to themselves all and all manner of advantage of exception to the manifold insufficiencies of the said answer, for replication thereunto saith: That they will aver and prove their said bill to be true, certain, and sufficient in
178 law to be answered unto, and that the said answer of the said defendants is uncertain, untrue, and insufficient to be replied unto by these repliants; without this, that any other matter or thing whatsoever in the said answer contained material or effectual in law, to be replied unto, confessed and avoided, traversed or denied, is true.

All which matters and things these repliants are and will be ready to aver and prove as this hon. court shall direct; and they pray as in and by their said bill they have already prayed.

(Signed) A. H. LEONARD,
J. W. GURLEY,
Sols. for Complainants.

Extract from Chancery Order Book.

GEO. H. DUNBAR et als.
vs.
T. T. WHITE et al. } 9858.

JULY 6TH, 1882.

George H. Dunbar, Francis B. Dunbar, and Charlotte Z.
179 Dunbar, complainants herein, by A. H. Leonard and J. W. Gurley, their solicitors, have this day filed their replication to the answer of the defendants herein.

Monthly Statement, July, 1882.—*Filed July* 31, 1882.

U. S. Circuit Court.

GEORGE H. DUNBAR et als.
vs.
T. T. WHITE et al. } No. 9858.

Now into court come the defendants, under the order herein entered on the 9th of June, 1882, requiring them to render monthly

accounts of such business as may be done by them under the allegations of plaintiffs' bill of complaint herein, and declare that they have not done any such business.

(Signed) JOSEPH P. HORNOR and
FRANCIS W. BAKER,
Def'ts' Solicitor.

William A. Gordon, being duly sworn, deposes and says that he is one of the defendants herein, and that the above allegations are true.

(Signed) W. A. GORDON.

180 Sworn to and subscribed before me this 31st day of July, 1882.

[SEAL.] (Signed) ANDREW HERO, JR.,
Not. Pub.

Extract from Chancery Order Book.

GEO. H. DUNBAR et als.
vs.
T. T. WHITE et al.

JULY 31ST, 1882.

The defendants herein, by Joseph P. Hornor and F. W. Baker, their solicitors, have this day filed their monthly statement as per order of court.

Monthly Return, Aug., 1882.—*Filed Sept.* 2, 1882.

U. S. Circuit Court.

GEO. H. DUNBAR et als.
vs.
T. T. WHITE et al.
No. 9858.

Now come the defendants, and under the order of court herein entered on the 9th day of June, 1882, requiring them to render monthly accounts of such business as may be done by them
181 under the allegations of complainants' bill of complaint herein, and declare that they have packed 8,130 cans of shrimps during the month of August, 1882, but same are not labelled or cased.

(Signed) JOSEPH P. HORNOR,
FRANCIS W. BAKER,
Def'ts' Solicitors.

T. T. White, being duly sworn, says that he is one of the defendants herein, and that the above allegations are true.

(Signed) T. T. WHITE.

Sworn to and subscribed before me this 2d September, 1882.

[SEAL.] (Signed) MARK BREEDEN, JR.,
Notary Public.

Extract from Chancery Order Book.

GEO. H. DUNBAR et als.
vs.
T. T. WHITE et al.

SEPT. 2D, 1882.

The defendants herein, by Joseph P. Hornor and F. W. Baker, their solicitors, have this day filed their monthly return, as per order of court herein.

182 *Agreement as to the taking of Testimony, &c.—Filed Sept. 9th, 1882.*

UNITED STATES ATTORNEY'S OFFICE,
EASTERN DISTRICT OF LOUISIANA,
NEW ORLEANS, 31*st Aug.*, 1882.

JOS. P. HORNOR, ESQ.:

DEAR SIR: I called at your office to ascertain when it would suit your convenience to commence taking testimony in the case of Geo. H. Dunbar and als. *vs.* T. T. White and al., 9858, U. S. Circuit Court. Mr. Baker informed me that you will be absent for some weeks, and that you would probably assent to an extension of time.

I submit the following proposition, which, if it meets your approval, please sign:

In the above case of Dunbar and als. *vs.* White and al. it is agreed that the time for taking testimony be extended sixty days, dating from the time that either party, after due notice to the other, shall commence taking testimony.

183 (Signed) J. W. GURLEY,
Of Counsel for Compl'ts.

(Signed) JOSEPH P. HORNOR and
F. W. BAKER,
Of Counsel for Def'ts.

Monthly Statement, Sept., 1882.—*Filed October 3d*, 1882.

U. S. Circuit Court, dist. of La.

GEO. H. DUNBAR et als.
vs.
T. T. WHITE et al.
No. 9858.

Now come the defendants, and under the order of court herein entered on the 9th June, 1882, requiring them to render monthly statements of such business as may be done by them under the alleged patent of complainants herein, and declare that they have packed 21,208 cans of shrimp during the month of September, 1882.

(Signed) JOSEPH P. HORNOR,
FRANCIS W. BAKER,
Solicitors for Defendants.

W. A. Gordon, being duly sworn, deposes and says that he is one of the defendants herein, and that the above allegations are
184 true.

(Signed) W. A. GORDON.

Sworn to and subscribed before me this 2d day of October, A. D. 1882.

[SEAL.] (Signed) GEO. C. PREOT,
Not. Pub.

Extract from Chancery Order Book.

GEO. H. DUNBAR et als.
vs.
T. T. WHITE et al.

OCT. 3D, 1882.

The defendants herein, by Joseph P. Hornor and F. W. Baker, their solicitors, have this day filed their monthly statement.

Monthly Report of T. T. White & Co.—Filed Oct. 31st, 1882.

U. S. Circuit Court.

GEO. H. DUNBAR et als.
vs.
T. T. WHITE et al.

Now come T. T. White and W. A. Gordon, defendants herein, composing the firm of T. T. White & Co., and in compliance
185 with the order of court herein rendered report that they have packed during the month of October, 1882, twenty-eight thousand nine hundred and seventy-six cans (28,976) of shrimps under their patent, and during the same month have sold twenty-three thousand four hundred and twelve cans (23,412); and they further report that during the month of September, 1882, they sold eighteen thousand and twenty-four (18,024) cans, this last item being inadvertently omitted from their report of September.

(Signed) JOSEPH P. HORNOR and
F. W. BAKER,
Solicitors.

(Signed) T. T. WHITE.

Sworn to and subscribed before me this 31st of October, 1882.

[SEAL.] (Signed) MARK BREEDEN, JR.,
Notary Public.

Extract from Chancery Order Book.

GEORGE H. DUNBAR et als.
vs.
T. T. WHITE et al.

OCT. 31, 1882.

186 The defendants herein, by Joseph P. Hornor and F. W. Baker, their solicitors, have this day filed their monthly report, as per order of court.

Monthly Statement of Def'ts.—Filed Dec. 1st, 1882.

U. S. Circuit Court.

GEORGE H. DUNBAR et als.
vs.
T. T. WHITE et al.
No. 9858.

The respondents, under the order of the court herein entered to that effect, respectfully report that during the month of November, 1882, they have packed 10,020 cans of shrimp, and have sold during the same period 8,880 cans.

(Signed) W. A. GORDON.

Sworn to and subscribed before me this 30th November, 1882.

[SEAL.] (Signed) MARK BREEDEN, JR.,
Notary Public.

Extract from Chancery Order Book.

GEORGE H. DUNBAR et als.
vs.
T. T. WHITE et al.
No. 9858.

DEC'R 1st, 1882.

187 The parties in interest are hereby notified that the defendants, by Joseph P. Hornor and F. W. Baker, have this day filed their monthly statement, as per order of court.

Monthly Report, Dec'r, 1882.—Filed January 2d, 1883.

U. S. Circuit Court.

GEORGE W. DUNBAR et als.
vs.
T. T. WHITE et al.

The defendants, in obedience to the order of court, respectfully report that during the month of December, 1882, they packed 4,932 cans of shrimps and sold 9,360 cans.

(Signed) T. T. WHITE.

Sworn to and subscribed before me this 2d day of January, 1883.
[SEAL.] (Signed) MARK BREEDEN, JR.,
Notary Public.

Extract from Chancery Order Book.

GEORGE H. DUNBAR et als.
vs.
T. T. WHITE et als.

JANUARY 2d, 1883.

188 The defendants herein, by Joseph P. Hornor and F. W. Baker, their solicitors, have this day filed their monthly statement, as per order of court.

Monthly Statement of Def'ts.—Filed February 3d, 1883.

U. S. Circuit Court.

GEORGE H. DUNBAR et als.
vs.
T. T. WHITE et al.

The defendants, in obedience to the order of court, hereby report that they have put up no shrimps during the month of January, 1883, but during said month have sold 4,224 cans.

(Signed) T. T. WHITE.

Sworn to and subscribed to before me this 2d day of Feb'y, 1883.
[SEAL.] (Signed) CHAS. G. ANDRY,
Notary Public.

Extract from Chancery Order Book.

GEORGE H. DUNBAR et als.
vs.
T. T. WHITE et al.

FEBRUARY 3d, 1883.

189 The defendants herein, by Joseph P. Hornor and F. W. Baker, their solicitors, have this day filed their monthly statement, as per order of court herein.

Motion and order cause assigned for hearing.—Entered and filed February 5th, 1883.

Circuit Court United States, eastern district of Louisiana.

NEW ORLEANS, *Feb'ry 5th*, 1883.

On motion of A. H. Leonard, solicitor for complainants, it is ordered that cause No. 9858, Geo. H. Dunbar et al. *vs.* T. T. White et al., be set for trial on Wednesday, Feb'y 21st, 1883, at 11 A. M., and that due notice be given.

Order for Publication of Testimony.

Extract from the Minutes, November Term, 1882.

NEW ORLEANS, *Wednesday, February* 21, 1883.

Court met pursuant to adjournment. Present: Hon. E. C. Billings, district judge.

GEO. H. DUNBAR et al.
vs.
T. T. WHITE et al. } No. 9858.

190 Upon the joint motion of A. H. Leonard, solicitor for the complainants, and of Joseph P. Hornor, solicitor for the defendants, it is ordered that *that* there be publication of proofs and depositions in this case.

Complainants' List of Evidence.—Filed February 21st, 1883.

Circuit Court U. S., eastern dis't Louisiana.

GEO. H. DUNBAR et al.
vs.
T. T. WHITE et al. } No. 9858.

Complainants' note of evidence:

1. Patent Exhibit A.
2. " " B.
3. Testimony Geo. H. Dunbar.
4. " J. Chauvet.
5. " F. B. Dunbar.
6. " A. L. Gaudin.
7. " Herman Meader.
8. " Paul Gelpi.
9. " A. N. Tourné.
10. " Geo. H. Dunbar.
11. " Herman Meader.
12. " A. N. Tourné.
13. " Paul Gelpi.

191 14. " A. M. Solari.

15. " Geo. H. Dunbar.
16. Cans of shrimp filed with affidavits.
17. Package of guava paste.

The documents numbered 1, 2, 3, 4, 5, 6, 7, 8, 9, and 12 in the foregoing note of evidence, offered by complainants, have already been transcribed in this transcript, and will be found as follows: No. 1, at page 16; No. 2, at page 26; No. 3, at page 43; No. 4, at page 60; No. 5, at page 63; No. 6, at page 48; No. 7, at page 55; No. 8, at page 53; No. 9, at page 50; and No. 12, at page 58.

Testimony of George H. Dunbar, Herman Meader, and Paul Gelpi, mentioned in the foregoing note of evidence as Nos. 10, 11, *and* 13.—*Offered by compl'ts Feb'y* 21, 1883.

United States Circuit Court, eastern district of Louisiana.

GEORGE H. DUNBAR et al.
vs.
T. T. WHITE et al. } No. 9858.

192 Testimony taken by consent, November 21st, 1882, subject to all legal objections to be urged to the court, except as to manner, form, or time of taking.

Present: A. H. Leonard and J. Ward Gurley, esq'rs, solicitors for compl'ts; Joseph P. Hornor, esq., solicitor for defendants.

By consent, the affidavit of George H. Dunbar, filed March 15th, 1882, is now taken as his direct examination.

Direct examination continued by Mr. LEONARD:

Q. You are familiar with the specifications which went with and formed part of your claim for a patent, are you not?

A. Certainly, sir; perfectly so.

Q. Will you state whether or not those specifications are stated in such terms and in such words as would enable any person skilled in the art of preserving shrimps and other fish to use the patent?

(Counsel for defendants objects on the ground that this a question for the court and not for the witness.)

193 A. Yes, sir.

Q. The patents under which you claim, the original patent under which you claim, provides for the use of textile fabric between the can and contents, to prevent discoloration of the shrimp?

A. Yes, sir.

Q. I wish you would state whether or not the means used by the defendants prevents the discoloration of the shrimp?

A. Yes, sir; almost anything put in between the can and the shrimp, of a spongy nature, would prevent discoloration.

Q. Just answer my question; the question was, do the means used by the defendants prevent the discoloration of the shrimp?

A. Yes, sir; they do.

Q. What means are used by the defendants to prevent discoloration?

A. By placing paper lining between the shrimps and the metal of the cans.

Q. I wish you would state whether or not the paper used by the defendants answers the same purpose as the textile fabric which you use in preventing discoloration?

194 A. It does to a certain degree and for a certain length of time.

By Mr. GURLEY:

Q. Prior to your invention, did you ever hear of any shrimp put up in metal cans that was free from discoloration?

A. No, sir; never.

Q. You believe yourselves to be the first inventors in putting up goods of that character in that manner?

A. Yes, sir.

Q. And the mode used by the defendants in this case in putting up shrimps accomplishes the same purpose?

A. Yes; same purpose exactly.

Q. You have large sales for your articles in the market?

A. Yes, sir; quite an extended sale.

Cross-examination by Mr. HORNOR:

Q. Will you describe the process used by the defendant in putting up his shrimp?

A. As well as I can describe it the process now ——

Q. You are talking about the process used by the defendant?

A. Yes; but the process used by Mr. Pecor is not the pro-
195 cess that is used by the firm now. In the first place the shrimps used by the patentee, Mr. Pecor, were first boiled before being picked; that I can prove by a can that I have packed in Galveston. The shrimps packed now by the firm of T. T. White are picked raw, which is a great secret in our process.

Q. What I want you to do, if you please, I want described to me the entire process that is now used by the defendants, T. T. White & Co., in packing shrimps, from beginning to end.

A. I have never been in the factory to know the process that they use, but it is a very simple one.

Q. So you don't know? I don't want you to say anything you don't know of your own knowledge. Do you know the process used by the firm of T. T. White & Co.?

A. I know they pick the shrimp raw.

Q. How do you know that?

A. I can tell it by the way the goods are put up.

Q. Have you any patent for that process of picking the shrimps raw?

A. No; no patent for that.

196 Q. Well, go on; what do they do next?

A. The shrimps are then boiled.

Q. How do you know that?

A. Because they are cooked already in the cans.

Q. You know that by inspecting the cans?

A. Yes, sir.

Q. After they are boiled—what then?

A. I don't know what process they are subjected to then, unless they are put up immediately into the cans.

Q. Then I understand that the only point of infringement of your

patent that you claim T. T. White & Co. are guilty of, is the substitution of paper for your textile fabric?

A. Yes; that is the mode they use in preventing the discoloration of the shrimps.

Q. Is there any other way in which T. T. White & Co. violate your claim?

A. Not my claim; no, sir.

Q. Your patent—is there any other way in which T. T. White & Co. violate your patent?

A. I can call it violating the patent; I don't know if I can
197 call it violating the patent in putting shrimps in moist condition in cans.

Q. You call that violating your patent?

A. My process.

Q. Is your process patented?

A. No, sir; and that is the reason I don't say violating my patent.

Q. I understand you to say that the placing of paper by the defendants between the shrimps and the can accomplishes the same result as the placing by you of a textile fabric according to your patent, as you stated in your examination, to a certain degree. What do you mean by "certain degree"?

A. I mean that our goods will keep prettier for a longer time than yours put up with paper; that is what I mean.

Q. Then I understand that the goods will look better for a longer time after the cans are opened?

A. No; they will keep better sealed for a longer time in a can, that is to say, hold their color better.

Q. You mean after the expiration of a longer time they will hold their color better?

198 A. I mean to say the whole shrimp will look better after a year.

Q. T. T. White's will do what?

A. They fade; they turn whitish.

Q. Are you certain of that?

A. Yes, sir.

Q. What makes you certain?

A. I have cans seven years old, and his that ain't one. I have cans 6 and 7 years old.

Q. You have some of T. T. White's a year old?

A. I have some of Pecor's, who is the patentee.

Q. Have you compared any that were put up by T. T. White with yours?

A. Yes, sir; I have.

Q. Does the same story hold good that yours hold better packed a year than his will?

A. Yes, sir; that is the way they two come together.

Q. You swear to that from experiment?

A. From what I have seen—compared myself. I looked at a can

put up 15 days—some we bought two months ago; we supposed it was fresh shrimps, and we compared them with ours.

199 Q. Have you ever compared shrimps of yours and of White or of Pecor that had been put up two years with each other?

A. No, sir; Mr. White hasn't packed that long.

Q. I said Pecor?

A. Pecor packed in Galveston. I don't know how old those of Pecor are that I have there, but I suppose they are very near a year and a half or two years old.

Q. When did you first commence packing shrimp under your original letters patent that were issued to you in the year 1876?

A. The first can of shrimp I ever put up with the lining in it was was on the 14th January, 1876.

Q. That was under that patent?

A. Well, I hadn't the patent yet.

Q. But since then you have been constantly manufacturing them, I understand you to say?

A. Yes, sir. We began packing shrimps in 1869; but then, we were not successful until 1876, on account of discoloration. We kept on working up and working up, until we found what was necessary to preserve the shrimp.

200 Q. Did you ever try anything else except textile fabrics in packing them?

A. No, sir; I have books and books written up in experiments.

Q. You never tried any lining of any kind—I mean until 1876?

A. No, sir.

Q. Have you ever made complaint in a court of justice, before this suit was instituted, of any infringement on your patent?

A. Against anybody?

Q. Yes?

A. No, sir.

Q. When did you first learn that Pecor was packing shrimps?

A. I don't exactly remember. May be two years ago. I can't exactly say.

Q. It is important. I wish you would try and recollect.

A. I could let you know. I haven't got it in my mind.

Q. It is some time before the institution of this suit?

A. Yes, sir.

Q. More than a year?

A. Yes, sir.

201 Q. Can you give me the exact date by investigating your books or memorandum that you have at your office?

A. I believe have a copy of his patent; that is how I learned it.

Q. About the time Pecor got his patent is about the time you learnt it?

A. Yes, sir, within about that time I learnt there was a factory going up at Galveston.

Q. Was it in April, 1880?

A. That is about the time—probably three months before that; may be three months, may be at the same time; I can't exactly say.

Q. Now, Mr. Dunbar, will you please tell us in detail what your process is in packing shrimps from the beginning to the end, from the time you buy the shrimps till the cans are sealed?

A. My process is specified in the patent.

Q. Do you do it exactly as it is there—you can't describe it any more fully than it is described in the patent; is that what your answer is?

A. Yes, sir; my process is described in the patent.

Q. Your shrimps are put up in linen or muslin bags; which is it, muslin or linen?

A. Linen or cotton.

Q. You have a bottom sewed in those bags?

202. A. Yes, sir.

Q. They are large enough in the can to enable them when the shrimps are put in to fold the top of the bag over?

A. Yes, sir; we do that or we put a disk on it.

(Counsel for complainants agree that the process described in defendant's answer as the process of the complainant is correctly there set forth.)

Q. I understand you to say in your specifications of your patent, to allege that a profuse precipitation of a black substance generally believed to be sulphur is prevented by the use of your bag?

A. Yes, sir.

Q. Is that entirely avoided, or does such precipitation go on between the bag and the side of the can, when your bag is used?

A. It goes on to a certain extent.

Q. Not to such extent as if the bag wasn't used?

A. Not to such an extent there was gravy in bag.

Q. Suppose you put up two cans of shrimp, one using your process exactly as you do, but without a textile bag, and you put up

203 another one with your textile bag, is the precipitation of that black substance generally believed to be sulphur as great in one as in the other?

A. I should think the precipitate would be more in the one without the sack or lining than in the one with the lining.

Q. Have you ever experimented to see what the difference in the precipitation would be?

A. I have not.

Q. But there is, I understand you to say, there is always a precipitation to a certain extent, at least even when you use the textile bag?

A. There is.

Q. But that precipitation is between the bag and the can?

A. Yes, sir; sometimes there is a little of it on the bag, sometimes a little of it on the outside of the sack.

Q. Therefore it stains the bag when it does that, of course?

A. Yes, sir, but not enough to get to the shrimp.

204 Q. I understand—now in the shrimps put up by the defendants with a paper lining between the shrimps and the can is there any precipitation of this black lining at all?

A. I never noticed.

Re-direct examination by Mr. LEONARD:

Q. When did you get a caveat before you got your patent?

A. I believe it was about the date, or two or three days, may be three weeks, after I packed those twelve or fifteen cans of shrimp, and I saw I was successful in the packing of them.

Q. That was in January, 1876?

A. Yes, sir, some time about there; you have the caveat.

Q. Do the shrimps put up in conformity with your patent or process—are they ever stained by this black precipitate of which you speak?

A. Probably shrimps put up three or four years ago there might be now and then one in a can, and especially if had been laying on the side, or may be two or three that would touch the bot-

205 tom; but spots only, may be two or three shrimps in a can, as I say, after two or three years' time.

Q. In the manner you originally put up your shrimps without any bag, did the black precipitate injure the shrimps?

A. It didn't because we had some cans of shrimp before the Commissioner of Patents in Washington, and when he opened the cans he immediately saw what they were. It was from him we found out what this precipitate was.

Q. I ask you whether that precipitate injured the flavor?

A. No, sir; we would preserve them, but they were not a merchantable article.

Q. You say the shrimps put up by White, after some length of time, became pale?

A. Yes, sir.

Q. That does not affect the flavor?

A. No, sir.

Q. You consider the two processes the same, under the Pecor patent and yours?

(Counsel for defendants objects on the ground that this is a question to be answered by the court and not by the witness.)

A. I consider that the way they preserve shrimps they

206 make a merchantable article of it.

Q. Do you consider the use of any other material than textile fabric which will prevent the contact of the shrimps with the metal of the can substantially the same or equivalent to the other?

(Objected to on the same grounds.)

A. Yes, sir; I say that will keep off discoloration.

JENTIL. CHAUVET. It is agreed that the affidavit of this witness, filed in this case 29th March, 1882, shall be taken as his direct examination in this case.

No cross-examination.

It is admitted by counsel for defendants, counsel for complainants assenting to the admission, that if Mr. F. B. Dunbar were present he would testify on direct examination what is set forth in his affidavit filed in this case on the 29th March, 1882, and that he would also further testify to the same effect as has been testified
207 here to-day by his brother, G. H. Dunbar, both upon his direct and cross-examination, subject to the same exceptions already reserved.

It is agreed by counsel for defendants that if A. L. Gaudien were present, he would testify to the same effect as is contained in his affidavit filed in this case on the 15th March, 1882.

Adjourned to Friday, 24th Nov., 1882.

Pursuant to adjournment: Friday, November 24th, 1882.

All parties present.

HERMAN MEADER. His affidavit filed in this case on the 24th March, 1882, having been taken as his direct examination.

Cross-examination by Mr. HORNOR:

Q. You say in this affidavit of yours that for eighteen years you have been engaged in New Orleans dealing in canned goods; what has been your general business during those eighteen years?

A. General family grocery business.

Q. You say here that you have been dealing in that time
208 in canned shrimps put up by G. W. Dunbar & Sons, and you say those shrimps are put up by a certain process and by means of a new and useful invention for which letters patent were issued to those gentlemen; how do you know that?

A. That is an explanation of mine.

Q. That was a presumption?

A. I leave that for Mr. Dunbar to prove.

Q. You only know that from having heard so?

A. Yes, sir; that part of it.

Q. Now, then, you say further, that prior to the year 1876 canned shrimps were not successfully preserved and did not constitute, to any extent, an article of commerce?

A. Not to my knowledge. They were not so in New Orleans.

Q. Your knowledge is limited to New Orleans?

A. I haven't heard of them elsewhere.

Q. Had you heard of canned shrimps put up by anybody else except the Dunbars?

A. Not canned shrimps, I only heard of them being dried in a small way; by the by, I may add to that that I had heard of
209 an effort being made and being unsuccessful in an attempt to put them up on the Atlantic coast somewhere. I know it was some time ago, and I heard it was a failure.

Q. You say further than this that the Messrs. Dunbar continuously and exclusively used their said invention and discovery—that is, the discovery mentioned in the letters patent—from the date of the letters patent up to the present time?

A. Yes, sir; so far as I know.

Q. Didn't you know at the time you made this affidavit, on the 23d of March, 1882, that Messrs. T. T. White & Co. were putting up shrimps and had been putting up shrimps?

A. I knew about that time that they were putting up shrimps.

Q. Didn't you hear some time previous to that, a year or more, than canned shrimps had been put up in Galveston by a man named Pecor?

A. I heard of some being put up there on the Atlantic
210 coast, and they were a failure; I hadn't seen any of them.

Q. Have you ever seen any of those put up by T. T. White & Co.?

A. No, sir.

Q. You never have examined any of them at all?

A. No, sir; I have seen the cases.

Q. Did you ever see the cans and examined their contents?

A. No, sir.

Q. You are unable to say what comparison there is between T. T. White's shrimps and Dunbar's?

A. No, sir.

Q. Have you observed any difference in the condition of the shrimps in a box of Dunbar's shrimps that were comparatively new, being put up within a month or two of your examination, and those put up in a year or two past?

A. I never made any examination of shrimps packed at different dates—that is, comparative examination.

Q. Have you ever observed in opening Dunbar's shrimps a
211 deposit of some black substance upon the interior bag?

A. Yes, sir; once or twice we have had a can returned, for instance; that was very seldom; about three years ago we had a can or two returned, and the bag seemed to be stained in spots.

Q. Was that outside or inside of the bag?

A. I wouldn't like to say positively about that.

Q. Did you ever open a can of Dunbar's shrimps in which that black substance wasn't deposited on the outside of the interior bag?

A. Yes, sir; and the bag was in good condition, you mean?

Q. Yes, sir.

A. Yes, sir; I ate them occasionally at the store for lunch.

Q. It isn't always that the black deposit is there?

A. No, sir.

Q. Is it not always there?

A. I have known it to be so in one or two instances when a can or two was returned; that was the only time my attention was drawn to that.

Q. And in those instances the shrimps were not damaged at all?

212 A. In cases where these cans were returned opened, I thought they were.

Q. That the shrimps were damaged?

A. In those cases, yes, sir.

Q. Those are the only cases where you know this black deposit was there?

A. Yes, sir.

Q. I understand you to say you never inspected Mr. White's shrimps at all?

A. No, sir.

Q. You don't know how they are put up?

A. No, sir; I never seen the interior of a can.

Q. Explain to us, as you understand it, how Dunbar's shrimps are put up?

A. I never been there.

Q. As you find them, how do you find them put up?

A. The shell is taken off the shrimps, and seems to be pressed down by hand inside of the bag; I don't remember exactly.

Q. Inside of what bag?

213 A. Inside of the bag in the can; I suppose the bag is put in the can first and the shrimps put in the bag afterwards, and the top drawn together and tied.

Q. Or folded over?

A. Yes, sir.

Q. The effect of all that is that the bag—the linen bag—prevents the shrimps from coming in direct contact with the sides, top, and bottom of the can?

A. Yes, sir; that is the object.

Q. You have had occasion, since you have been in the grocery business, to deal in guava jelly, such as comes sometimes put up in little round boxes?

A. Yes, sir.

Q. How long have you dealt in that guava jelly?

A. For myself, eighteen years; 27 years handling it.

Q. Little boxes put up like this one?

A. Yes, sir.

Q. Look at the inside of that box of guava jelly; was the jelly which you have been handling for 27 years put up like that?

A. Yes, sir.

(Mr. Hornor offers in evidence box marked "X.")

214 Q. We find in that jelly box that that box is made of wood; that there is a paper bag in there which holds the jelly, and a paper cover on top of the jelly; what is the effect of the paper bag and that paper cover; what does it accomplish in that box?

A. It keeps it from sticking to the wood.

Q. Keeps it from coming in contact with the wood?

A. Yes, sir.

Q. Keeps it from absorbing any piny smell of the wood?

A. Yes, sir; but the intention is simply to keep it from sticking, so as to take it out clean.

(Mr. G. H. Dunbar produces a can of complainants' shrimps, taken promiscuously from his store, he not being able to state how old put up, but not over two months.)

Q. Mr. Meader, I have been asking you about a deposit of some black substance upon the outside of the interior bag of Dunbar's shrimps. We have a can of Dunbar's shrimps here, [can shown to witness;] do you find a deposit of the same black substance?

A. Yes, sir; there it is—small spots.

215 Q. What did that—see if you don't find some more.

A. Nothing more on this one.

Q. I call your attention to this black deposit here and here; is that caused by the burning of the soldering—this part here?

A. I suppose that was the charcoal dirt.

Q. As your experience goes, is there more dirt on this can, or black substance, or whatever it is, than there is on the cans of Dunbar's shrimps?

A. No, sir.

Q. There is usually as much as there is here?

A. Yes, sir; I should suppose so.

Q. That is, every can you have opened?

A. We have not opened a great many.

Q. What causes these stains on the side?

A. The moisture from the shrimps going through the bag and touching the tin.

Q. Is this bag on the side more discolored than Dunbar's shrimps usually are?

A. I think they run about like that.

Re-direct examination by Mr. LEONARD:

Q. Is it not a fact that about the year 1876 you learned that
216 Messrs. Dunbar were engaged in preserving shrimps extensively?

A. I don't remember when, but I know for many years past they have been doing it extensively.

Q. If canned shrimps, as an article of commerce, had been used extensively by other firms, would you have known the fact of their being engaged in business?

A. Yes, sir; they generally *limit* us up—that is, in our line.

Q. You try to keep up with the trade?

A. Yes, sir.

Q. You are a member of the firm of Clark & Meader?

A. Yes, sir.

Q. Engaged in the general grocery business—family groceries—in this city?

A. Yes, sir.

Q. You have spoken of this guava jelly; this jelly is a sticky substance?

A. Yes, sir.

Q. Isn't it a fact that it couldn't be preserved without its being protected from sticking to the box?

A. If it was not for the paper it would stick to the box;
217 the best evidence of that is, it sticks even to the paper.

Q. This box of shrimps that has been opened and presented to you for examination contains merchantable shrimps, does it not?

A. Yes, sir.

PAUL GELPI. It is agreed that the affidavit of this witness, filed March 24th, 1882, in this case, shall be taken as his direct examination.

Cross-examination by Mr. HORNOR:

Q. Have you any other business besides dealing in canned goods?

A. General importer—groceries.

Q. You deal in domestic goods as well as foreign?

A. Some; yes, sir.

Q. And their style, what are called fancy groceries?

A. Yes, sir; fancy groceries and wines.

Q. These canned shrimps would be classed among fancy groceries?

A. Yes, sir.

Q. You say here these shrimps were put up under letters patent; do you know anything about that except what you heard?

A. That is all, sir.

218 Q. Do you know that prior to 1876 that canned shrimps were not successfully preserved?

A. I don't know of any before that time.

Q. That is so far as your individual knowledge goes?

A. Yes, sir.

Q. You say here you have been engaged in this business for nine years; what was your business before that time?

A. I was employed in the same business since 1861.

Q. That is twenty-one years ago?

A. Yes, sir.

Q. You deal in guava jelly?

A. Yes, sir.

Q. Jelly coming into this port put up in round boxes such as this one here? (Box previously offered and marked "X" shown to witness.)

A. Yes, sir.

Q. All this time you have dealt in guava jelly?

A. Yes, sir.

Q. You see the interior of this box how it is covered around with paper, and the sides?

A. Yes, sir.

219 Q. All during that time boxes of jelly were put up like this?
A. Yes, sir.
Q. Have you ever opened cans of Dunbar's shrimps?
A. Yes, sir.
Q. Have you ever noticed a black substance deposited on the interior bag inside of the can?
A. Yes, sir.
Q. In how many boxes?
A. Almost all.
Q. Sometimes very little?
A. Yes, sir.
Q. Sometimes a good deal?
A. Not often—about as much as I saw in the can here to-day.
Q. Not enough to spoil the shrimps?
A. No, sir.
Q. Have you ever had to return any shrimps to Dunbar & Sons, or their predecessors, for that fault?
A. Not for that fault; I have had some returned to them on account of their being bloated or swollen.
Q. That didn't arise from that black substance?
A. No, sir, swollen shrimps; that is liable to happen in any canned goods.
Q. You saw this one Mr. Meader examined?
220 A. Yes, sir.
Q. This discoloration?
A. That is about what is seen generally.
Q. Do you know what causes that?
A. I do not.
Q. Have you ever seen Mr. White's shrimps?
A. I have.
Q. Have you examined them?
A. Yes, sir; two or three cans.
Q. Have you ever compared them with Dunbar's?
A. Never.
Q. Have you observed the black substance that we spoke about in White's shrimps?
A. I can't say, because they are not put up in the same way.
Q. One is put up in paper, the other in linen?
A. Yes, sir.
Q. You couldn't say which one was best?
A. I think both are very good.
Q. Can you mention any difference?
A. Not much.
Q. Any?
A. No, sir.

Re-direct examination by Mr. LEONARD:

221 Q. I understand you to say that this discoloration which you observed in the shrimps prepared by Messrs. Dunbar didn't affect the shrimps—that slight deposit on the bags?

A. I never seen any shrimps that was affected by that.

Q. Is it not a fact, Mr. Gelpi, if shrimps had been preserved and had been in general commercial use prior to 1876, you would have known it?

A. I believe so.

Q. You knew nothing about it prior to that time?

A. I never heard of any.

It is agreed that A. N. Tourné's affidavit filed on the 15th and 29th of March shall stand as his testimony, and cross-examination waived by Mr. Hornor, subject to the objections that the legal opinion stated by the said witness in his said affidavit is not testimony and is objected to.

222 *Testimony of A. M. Solari and George H. Dunbar, mentioned in the foregoing note of evidence as Nos.* 14 *and* 15.—*Offered by compl'ts Feb'y* 21, 1883.

United States Circuit Court, eastern district of Louisiana.

GEORGE H. DUNBAR et als.
vs.
T. T. WHITE et al. } No. 9858.

Testimony taken by consent January 5, 1883, subject to all legal exceptions, except as to form, manner, and time of taking.

Present: A. H. Leonard, esq., attorney for complainants; Joseph P. Hornor, esq., attorney for defendants.

ANGELO M. SOLARI, being first duly sworn for complainants, deposes and says:

Direct examination by Mr. LEONARD:

Question. Just examine that little box marked "T W C X."

Answer. I have seen those before.

Q. You see that there is a paper lining; what is the object of that lining?

A. To keep the jelly clean, all I know; and possibly to keep it from taking the taste of the wood; as to that I never gave it a second thought.

223 Q. It also prevents the jelly from sticking to the box?

A. Yes, sir.

Q. Isn't there a substance similar to this known as guava paste?

A. Yes, sir.

Q. How does that come, prepared with or without lining?

A. I believe without lining.

Q. Examine that box marked "X 2 T W C," and see if that is the usual way it comes.

A. Yes, sir; that is it. It may come some time with lining, but I believe it usually comes that way.

Cross-examination by Mr. HORNOR:

Q. How long have you been dealing in this guava jelly and goods put up in boxes like that "X" and "X 2"?

A. About twenty years.

GEORGE H. DUNBAR recalled. Examined by Mr. LEONARD:

Q. You were present when the testimony was given for the defense in this case; a good deal was said about a black deposit on the bag in the cans containing your goods as you put them up;
224 I wish you would explain whether or not that deposit injures the shrimps themselves.

A. Not in the least; but then the bag is put in to keep that deposit off the shrimps—to retain the deposit between the can and the bag.

Q. And thereby prevents the discoloration of the shrimps?

A. Yes, sir.

Q. Have you ever examined any of the shrimps put up by Mr. Pecor at Galveston?

A. I have bought a box, not directly from them, but I have received a whole case of their shrimps. I have brought a can with me.

Q. Have you investigated them with a view to ascertain whether or not there was any difference between the Pecor shrimps and those put up by the defendants?

A. Yes, sir; at the first beginning—that is, in the picking—they are boiled, I should say before they are picked; they are taken from the gulf from the seine and boiled.

Q. Which do you mean were boiled before they are picked?

A. The Pecor shrimps.

Q. There is a difference between the goods?
225 A. There is a difference; yes, sir.

Q. In whose favor is the difference; which are the best?

A. Ours are the best.

Q. I asked you if you had examined the difference between those put up by Pecor and those put up by White; you said you had; now I ask you which are the best?

A. Those of T. T. White are better than those put at Galveston.

Q. Have you any of the cans here?

A. Yes, sir; I have a can here to show, (can marked "X 3 T W C.") That is one of Mr. Pecor's, from Galveston, an original package. We bought those shrimps on the 8th of September; I have opened others.

Q. Is there any difference in the color?

A. Yes, sir; these are very pale. (Witness referring to can "X 3.")

Q. Did you notice whether there is any difference in flavor?

A. I never tasted these.

Q. State whether or not the shrimps put up by Pecor are merchantable shrimps?

A. I don't think so—otherwise we would have seen more of them.

Q. Now, you have examined Mr. White's goods of course,
226 the defendants goods and your own—have you ever instituted a comparison between the two?

A. Yes, sir

Q. Which do you consider the best?

A. I consider that our packing is the best.

Q. Examine those boxes of guava jelly and paste marked "X" and "X 2." One is known as guava jelly and the other as guava paste.

A. Yes, sir. This "X" is guava jelly, and this "X 2" is guava paste, and both of them are made from the same fruit. I can explain to you the process of making these two articles.

Q. The guava jelly seems to have a paper lining between the jelly and the box?

A. Yes, sir.

Q. What is the object of that lining?

A. To keep it from adhering to the wood, simply. I should say that is the only thing, and even this paper here has to be dipped in alcohol to keep the jelly from adhering to it—I see that the alcohol has evaporated and it sticks.

Q. The paste will not stick, and therefore there is no lining used here?

A. No, sir.

Q. There would be no discoloration if there was no paper?
227 A. No, not at all—not any more than in this.

Cross-examination by Mr. HORNOR:

Q. You say those shrimps put up by Pecor in Galveston are not merchantable?

A. They might have been for a certain time after they were packed, but in my opinion I don't think they last.

Q. Is that the only reason why you think they are not merchantable?

A. Yes, sir; well, of course that has to do with the process all the way through.

Q. You have no other way of explaining why you think they are not merchantable?

A. No, sir.

Q. You say you have opened them?

A. Yes, sir—I will give you a little proof that these goods are not packed by the same process that the White shrimps are—by this double vent hole. (Witness points to can marked "X 3.")

Q. That double vent hole shows you they were put up by a different process than those put up by White?

A. Yes, sir.

228 Q. Is that the reason why they are not merchantable?

A. No, sir.

Q. Why are the shrimps not merchantable?
A. Because they don't open up nicely.
Q. Why?
A. They have a strong smell to them which you don't find in the White shrimps or in ours.
Q. Anything else?
A. They may be softer—no, I can't say anything more about it.
Q. I want you to say all about it.
A. I say all I know about it.
Q. Ain't they good to eat?
A. No, sir; not now—nobody could eat the shrimps in that can now.
Q. Because they are too strong?
A. Yes, sir; there is a terrible smell of ammonia about them.
Q. That is the only reason you couldn't eat them?
A. Yes, sir.
Q. You say that you consider that your shrimps are better than Mr. White's?
A. Yes, sir.
Q. Tell me why?
229 A. Well, the principle reason why is because I think that cotton lining is much superior and much cleaner than paper.
Q. Is that all?
A. That is all.
Q. Did you ever deal in guava jelly?
A. No, sir.
Q. Or guava paste?
A. No, sir; I never dealt in it.
Q. Never bought any except for your own consumption?
A. No, sir, except for the children to eat for lunch.

By Mr. LEONARD:

Q. You have stated that the goods of Pecor were pale in color?
A. Yes, sir, and soft.
Q. Is it not a fact that the goods you opened put up by Pecor at Galveston were unfit to eat?
A. Yes, sir, those are—(can "X 3.")

Defendants' list of evidence.—Filed February 21st, 1883.

U. S. Circuit Court.

GEO. H. DUNBAR et als. vs. T. T. WHITE et al. } No. 9858.

230 *Defendants' note of evidence.*

1. Answer.
2. Patent No. 156,693.—Exhibit P.
3. " " 34,928 } In 91 U. S. Reports, pp. 171 to 187.
4. " " 35,274 }

5. Pecor's patent, Exhibit A.
6. Transfer Pecor to White, Exhibit B.
7. The cans of shrimps filed with answer.
8. The two boxes of guava jelly filed with testimony of witnesses.
9. Testimony of Charles Ballejo.
10. " " W. C. Raymond.
11. " " T. T. White.
12. " " Wm. Wallace.
13. " " E. C. Pecor.
14. " " Wm. A. Gordon.

The documents mentioned in the foregoing note of evidence as 1, 2, 5, 6, 11, 12, 13, and 14 in the foregoing note of evidence, offered in evidence by defendants, have already been transcribed in this transcript, and will be found and follows: 1 at page 152; 2 at page 127; 5 at page 133; 6 at page 145; 11 at page 68; 12 at page 74; 13 at page 90; and 14 at page 105.

Testimony of Chas. Ballejo and W. C. Raymond, mentioned in
231 *the foregoing note of evidence as 10 and 11.—Offered by deft's Feb'y 21st, 1883.*

United States Circuit Court, fifth judicial circuit, eastern district of Louisiana.

GEORGE H. DUNBAR et als.
vs.
T. T. WHITE et al. } No. 9858.—In chancery.

Appearances: Leonard, for complainants; Joseph P. Hornor, for defendants.

Testimony taken by consent on behalf of defendants at the office of Joseph P. Hornor and F. W. Baker, New Orleans, La., Dec. 12th, 1882.

CHARLES BALLEJO, sworn by Mark Breeden, jr., notary public. Examined in chief on behalf of defendants.

By Mr. HORNOR:

Question. What is your age, Mr. Ballejo?
Answer. Fifty-two.
Q. And you reside in New Orleans?
A. Yes, sir.
Q. And your business?
A. Retail grocer.
232 Q. How long have you been in this business in New Orleans?
A. Well, about 30 odd years; 32 I swear to.
Q. You are acquainted with the Messrs. Dunbar?
A. Yes, sir.
Q. And with Mr. White and Mr. Gordon?

A. Yes, sir.
Q. Do you know Mr. Pecor?
A. To speak to him, yes, sir; both of them.
Q. I ask you if you know Mr. Pecor?
A. No, I don't; I don't know Mr. Pecor.
Q. Mr. Ballejo, are you acquainted with the canned shrimps that are put up for sale by the Messrs. Dunbar, and with those put up by the Messrs. T. T. White & Co.?
A. Yes, sir; and can I answer that I am better acquainted with one than with the other?
Q. Yes.
A. I am better acquainted with Mr. Dunbar's than with Mr. White's, having sold them.
Q. Have you ever dealt in Mr. Dunbar's?
A. Always.
Q. How long have you dealt in shrimps?
A. Well, I presume since they began to put them up.
Q. Mr. White's, have you ever dealt in them?
233 A. No, sir, only a little; I have not bought any of Mr. White's, though; I have not dealt in them, but I had them as a sample.
Q. Have you had occasion to open the Dunbar shrimps—open the cans and examine the contents?
A. Yes, sir.
Q. Have you ever had occasion to examine the contents of White's shrimps?
A. Yes, sir.
Q. How do they compare?
A. Very favorably, both of them, except at one time I thought those of Mr. White's didn't smell as strong as those of Mr. Dunbar.
Q. That was only at one time?
A. That is only at one time.
Q. When was that?
A. Well, about—I should say when they first gave me a sample of Mr. White's; it was only one time I had that sample given to me; I cannot remember about the time now.
Q. Can you testify of the way in which they are put up?
A. Well, one, Mr. Dunbar's, is put up in a small sack, a cloth bag.
Q. A cloth bag inside of the can?
A. Yes, sir.
Q. And Mr. White's, how are they put up?
234 A. To the best of my knowledge it is with a paper lining.
Q. Now, what is the appearance of this bag in which Mr. Dunbar's shrimps are put up when it is taken out of the can?
A. The appearance of the bag?
Q. Yes, of the bag.
A. Well, I would like you ——
Q. Is it perfectly clean, or are there spots on it?

A. No; there is some; I have seen some with black spots, some without spots; I have opened some this year in my own store.

Q. Some of Dunbar's?

A. Yes, sir, in my own store, and I found them black spots; that some of the shrimp had a black mark on them; I cannot tell the cause of that.

Q. What is the appearance of the paper lining of White's shrimps when you opened the boxes?

A. Well, as I told you, I think it was only one time that I made that comparison between the two.

Q. You never opened but one box of White's shrimps?

235 A. None others.

Q. What was the appearance of the paper of those boxes of White's shrimps that you opened?

A. I think the paper was perfect, sir, to the best of my recollection now.

Q. Do not remember seeing any stains on it?

A. No, sir; I do not.

Q. Now, have you ever observed any difference between White's and Dunbar's shrimps in regard to the color of the shrimps?

A. I do not know that I have, sir; only about the smell of them.

Q. Mr. Ballejo, did you ever deal in guava jelly?

A. I have, for 30 odd years.

Q. This guava jelly that is put up in small round boxes?

A. Round and square boxes both.

Q. Little boxes like this [showing a small round box of guava jelly, which is marked and filed in this case in connection with this witness's testimony]?

A. Yes, sir; also square.

Q. Like this one [shows the box]?

A. Always dealt in them; yes, sir.

Q. Always have that paper lining in them?

236 A. Yes, sir.

Q. Around the sides, bottom, and top?

A. Yes, sir; some of it is put up in Havana and some put up in New Orleans, under the name of guava jelly.

Q. For how long have you dealt in guava jelly put up in that way?

A. Ever since I have been in the business; about—over 30 years, sir.

Q. Did you ever deal in another goods put up in boxes with a lining inside of the box?

A. I don't remember that I have.

Q. Don't remember of another goods?

A. No, sir; I don't.

Cross-examination by Mr. LEONARD, counsel for complainants:

Q. You have been dealing in Mr. Dunbar's goods ever since they came out and are still dealing in them?

A. Yes, sir; I had a stock of them when Mr. White went into the business.

By Mr. HORNOR:

Q. He asked you if you are still dealing in Dunbar's shrimps?

A. As I said, I had a stock when Mr. White first went into
237 business; I had a stock on hand; I meant to try both of them, but I had a stock of Mr. Dunbar's, so I never bought any of White's shrimps.

Q. You did not deal in White's shrimps?

A. Only on account of having a stock of Dunbar's shrimps.

Q. You have not sold all his out?

A. No, sir.

Q. Have you ever bought any shrimps from "Dunbar's Sons," since White went into the business?

A. I do not think so; I never bought any from Mr. Dunbar because I did not want the quantity that he requires me to buy to get them at certain prices; so, bought from others, but they are his shrimps.

W. C. RAYMOND, sworn by Mark Breeden, jr., notary public. Examined in chief, on behalf of defendants, by Mr. Hornor, as follows:

Q. Will you give your age and residence, Mr. Raymond? You reside in New Orleans?

A. Yes, sir; 64 years of age.

Q. Have you ever been in the grocery business in New Orleans?

A. Yes, sir.

Q. For how long?

238 A. 25 years.

Q. You are not in it now?

A. No, sir.

Q. How long since you have been out of it?

A. It is about 20 years since I left the retail grocery business.

Q. You have been in the wholesale grocery business since that time?

A. Yes, sir.

Q. Dealing in all kinds of groceries?

A. Yes, sir.

Q. Since when did you leave that business?

A. Five years ago.

Q. While you were in the grocery business, did you ever deal in guava jelly?

A. Yes, sir.

Q. Was it put up in boxes like this one shown to you now? [Witness shown a little round box of guava jelly marked and filed in this case in connection with his testimony.]

A. Yes, sir.

Q. Will you look at this, please, and say if it had that paper lining at the top, bottom and sides? [Shows witness the box.]

A. Yes, sir, always that way.

Q. How long have you dealt in them put up in that manner?

239 A. About 20 years, handled this kind of goods.

By Mr. LEONARD:

No questions.

It is admitted by the counsel for complainants that if Mr. J. B. Solari and Mr. Wilson, of the firm of Skardon & Wilson, grocers, on Jackson street, were present, that they would corroborate the evidence of Mr. Raymond which has just been given.

Affidavits of T. T. White and William A. Gordon.—Offered by def'ts Feb'y 1st, 1883.

U. S. Circuit Court, eastern dist. of Louisiana.

GEO. H. DUNBAR et als.
vs.
T. T. WHITE et al. } No. 9858.

Theodore T. White, being duly sworn, deposes and says that he is a member of the firm of T. T. White & Co., of New Orleans, La., which firm is composed of himself and William A. Gordon; that affiant is one of the defendants in this case; that affiant purchased, in January, 1882, the patent of E. C. Pecor for canning shrimps and shell-fish, and which is on file in this case,
240 as also the transfer thereof to this affiant on the 2d of January, 1882; that affiant's said firm rented the building No. 948 New Levee street, in the city of New Orleans, for the purpose of using the said building for canning shrimps under the said Pecor's patent, and entered into a lease of the said building for the sum of six hundred dollars per annum, payable monthly, with the privilege of extending the said lease at the expiration thereof; that affiant's said firm placed in the said building machinery to be used for canning shrimps to the full value of twenty-five thousand dollars, and expended for fitting up the said building for the said purpose and in new flooring, and in arranging the sewerage from the said building to the Mississippi river, the sum of two hundred dollars; that on the 2d of February, 1882, affiant's said firm commenced the business of packing shrimps, under the said patent, on a large scale, and
241 continued uninterruptedly in the said business until the institution of this suit, when the said business was stopped; that at the time the injunction issued in this case your affiant's said firm had on hand the said building and all the machinery and fixtures thereof, all of which is of no use whatever to them while the injunction issued herein shall remain in full force and effect; and that they also had on hand, at the time of the issuing of the injunction herein, stock and materials for packing shrimps of the full value of twenty-five hundred dollars, all of which is of no use to your affiant's said firm, and of no value whatever to them unless the said injunction, herein issued should be removed; that affiant's said firm have not realized from the sales of these shrimps, so packed by them as aforesaid, a sufficient sum of money to pay the expenses that they have

incurred in the packing thereof, and for the disbursements made in preparing the said building for the said business; that the en-
242 terprise now remains a loss upon the hands of affiant's said firm; that the said business of canning shrimps is very profitable, and if permitted to carry on the same affiant's said firm could have realized profits on the said business to the amount of at least fifteen thousand dollars per annum; that affiant is informed by his counsel, and verily believes, that upon the final hearing of this case he will be able to obtain a final judgment, at the end of this litigation, in his favor, and that it is possible, and very probable, owing to the crowded state of the docket of the Supreme Court of the United States, and owing to the delays incident to a suit in chancery in this court, and to the approaching annual vacation of this court, that it will be to from three to four years before this case is finally decided, and that in order to protect affiant's rights in the premises, and to insure affiant's full compensation for the damages that affiant's
243 said firm will suffer should it be finally decided that the injunction herein has wrongfully issued, complainants should be obliged and required to give a bond in favor of affiant's said firm for the full sum of fifty thousand dollars to answer to affiant's said firm for the illegal issuance of the said injunction.

And affiant further deposes that after affiant's said firm had been for some little time engaged in canning shrimps, as aforesaid, George H. Dunbar and Francis B. Dunbar, complainants herein, waited upon affiant with a view of agreeing with affiant upon what price should be paid by both firms for shrimp from the fishermen, so that neither affiant's firm nor complainant's firm should take advantage of each other by bidding against each other with the said fishermen for the said shrimps, and an agreement was thereupon entered into to that effect between the affiant's said firm and complainant's said firm.

244 (Signed) T. T. WHITE.

Sworn to and subscribed before me, at New Orleans, La., on this 29th day of April, A. D. 1882.

[SEAL.] (Signed) MARK BREEDEN, JR.,
Notary Public.

William A. Gordon, being duly sworn, deposes and says that he resides in New Orleans, La.; that he is a member of the firm of T. T. White & Co., and is one of the defendants in this cause; that he has carefully read and considered the foregoing affidavit of Theodore T. White, and confirms the same in all particulars; and in addition thereto affiant declares that in the early part of January, 1882, he waited upon Francis B. Dunbar, one of the complainants herein, and a member of the firm of George W. Dunbar's Sons, and informed him that affiant's said firm intended to go into the business of packing shrimps, and asked him to let affiant's firm know what their wholesale prices for preserving shrimps were, explaining
245 at the same time to the said Francis B. Dunbar that he desired this knowledge in order that affiant's said firm might

not interfere with the business of the said Dunbar Sons by selling at a less price than was charged by that firm; that the interview was sought by affiant for amicable reasons, and because the said firm of Dunbar Sons were known to be engaged in that business, and that the prices of the two firms might not conflict with each other; that the said Francis B. Dunbar complied with the request of affiant, naming the prices of the said Dunbar Sons to affiant, and at the same time remarking that affiant's said firm might be interfering with the patent held by the said Dunbar Sons, and that he would have to look into that matter and defend his rights if need be; that affiant, once after that, saw the said Francis B. Dunbar on the said business, but that the complainants in this case took no steps whatever to interfere with the business of affiant's said firm until
246 the institution of this suit.

And affiant further deposes and says that on the 15th day of March, 1882, and before any of the papers had been served in this case, and before affiant or his partner had any knowledge of the institution of this suit, that affiant left the city of New Orleans on a business expedition to solicit orders for shrimps packed by affiant's said firm, and proceeded to Chicago, Illinois, Milwaukee, Kansas City, and St. Louis, at which places affiant absolutely obtained orders for upwards of six hundred cases of shrimps, of two dozen cans each, and refused orders for many more, the said refusal being on account of the proceedings taken in this case; that affiant verily believes that from the business done by him, and the reception accorded to him by the merchants whom he visited, that he could have easily obtained orders for twenty-five hundred more cases; that during his said trip that affiant had occasion of conversing
247 with many merchants who had opportunities of comparing the shrimps put up by affiant's said firm and those packed by the complainants, and that in all instances the said merchants gave the preference to the shrimps packed by affiant's said firm, on the ground that they were better goods, and on account of the superior flavor and general appearance of the shrimps; and affiant further deposes that such also is the opinion, as far as affiant has been able to ascertain, of the merchants of New Orleans.

(Signed) W. A. GORDON.

Sworn to and subscribed before me, at New Orleans, La., on this 29th day of April, A. D. 1882.

[SEAL.] (Signed) MARK BREEDEN, JR.,
Notary Public.

Submission of Cause.

Extract from the Minutes, November Term, 1882.

NEW ORLEANS, Wednesday, February 21st, 1883.

Court met pursuant to adjournment. Present: Hon. E. C. Billings, district judge.

248 GEORGE H. DUNBAR et als. vs. T. T. WHITE et als. } No. 9858.

This cause came on to be heard on the bill, answer, replication and other proceedings in the cause.

Whereupon the complainants offered the following evidence in support of their bill, to wit:

1. Patent—Exhibit A.
2. Patent—Exhibit B.
3. Testimony of Geo. H. Dunbar.
4. " " J. Chauvet.
5. " " F. B. Dunbar.
6. " " A. L. Gaudin.
7. " " Herman Meader.
8. " " Paul Gelpi.
9. " " A. N. Tourné.
10. " " Geo. H. Dunbar.
11. " " Herman Meader.
12. " " A. N. Tourné.
13. " " Paul Gelpi.
14. " " A. M. Solari.
15. " " Geo. H. Dunbar.
16. Cans of shrimps filed with affidavits.
17. Package of guava paste.

And the defendants offered the following evidence, viz:

249 1. Answer.
2. Patent No. 156,693.—Exhibit P.
3. " " 34,928 } in 91 U. S. Reports, pp. 171 to
4. " " 35,274 } 187.
5. Pecor's Patent, Exhibit A.
6. Transfer Pecor to White, Exhibit B.
7. The cans of shrimps filed with answer.
8. The two boxes of guava jelly filed with testimony of witnesses.
9. Testimony of Charles Ballejo.
10. " " W. C. Raymond.
11. " " T. T. White.
12. " " Wm. Wallace.
13. " " E. C. Pecor.
14. " " Wm. A. Gordon.

And the cause was argued by the solicitors for the parties respectively and submitted. And the court took time to consider.

Monthly Report of Def'ts.—Filed March 3d, 1883.

GEO. H. DUNBAR et als. vs. T. T. WHITE et al. } U. S. Circuit Court.

The defendants, under the order of the court to that effect, respectfully report that they have packed no shrimps during the month

of February, 1883, and during said month have sold 303
250 cases of 24 cans each.

(Signed) T. T. WHITE.

Sworn to and subscribed before me this 3d day of March, 1883.

[SEAL.] (Signed) CHAS. G. ANDRY,
Notary Public.

Extract from Chancery Order Book.

GEO. H. DUNBAR et als.
vs.
T. T. WHITE et al. } 9858.

MARCH 3d, 1883.

The defendants herein, by Joseph P. Hornor and F. W. Baker, their solicitors, have this day filed their monthly report as per order of court herein.

Opinion of the Court.—Filed March 14th, 1883.

Circuit Court of the United States, eastern district of Louisiana.

GEO. H. DUNBAR et als.
vs.
T. T. WHITE et als. } No. 9858.

Before Judge Billings.

251 The case has been heard, and is submitted for a final decree upon bill, answer, exhibits, and depositions. The bill is to protect the rights of a patentee, and is for an injunction and account.

Upon the hearing for a preliminary injunction I directed that the defendants should be required to keep an account of all their transactions which should be had, which could be included within the rights granted to complainants. This decree in effect maintained the validity of complainants' claim.

The sole question in this case is this: In a case where the plaintiff's right to recover against the defendant would have been perfect under an original patent, can a surrender and a reissue invalidate that right?

Complainants' original patent was granted June 20th, 1876.

Defendants' patent was issued April 6th, 1880.

Complainants' reissued patent bears date December 6, 1881.

252 The legal propositions which affect this case were, as it seemed to me at the prior hearing, and as it seems to me after the present hearing, the following:

I. Is reissued patent which enlarges an original patent, *i. e.*, which makes makes the invention patent other and more inclusive than

the original letters patent, is void as against intervening rights and the public as well?

II. When a patentee in his original claim and specifications describes his invention in part by specifying a material to be used, but declares that the sole utility or availability of that material, in connection with his device, is that it has two properties, and in his reissued patent, in his claim and specification in the description of his invention, substitutes for his former specification of a material to be used as part of his device a description of materials which may be used by specifying only those which have the two properties in which he had formerly declared the utility or availability of the material which he there named consisted, there is no enlarge-
253 ment of the thing patented, and the reissued patent is therefore valid.

III. Where, as in this case, the original claim and specifications was for a textile fabric as an envelope for the shrimp in connection with other things, and it was declared that the sole object of its use to prevent contact (that is, to secure separation) without discoloration, and in the reissued patent in the claim and specifications it is declared that any enveloping material may be used which will separate and not discolor the shrimp, is only that of substituting the description of a thing by naming it with the addition of its essential quality, the description of the thing by naming its qualities.

IV. The object of the law on the subject of patents is to advance the interest of the public by securing certain exclusive rights to patentees, and among these rights is that of changing by a surrender and reissue the language, when the idea remains the same.

254 V. Let there be an account taken before the master of the sales of the defendants, verbatim of complainants' patent and a report thereon, and let the injunction be made perpetual during the continuance of complainants' patent.

Decree.—Entered and filed March 14th, 1883.

GEORGE H. DUNBAR et al.
vs.
T. T. WHITE et al. } No. 9858.

This cause came on to be heard at this term of the court on bill, answer, exhibits, and proofs, and was argued by counsel.

Whereupon, on consideration thereof, the court this day delivered its opinion in writing, and for the reasons therein assigned adjudges and declares that the complainants, George H. Dunbar, Francis B. Dunbar, and Charlotte Z. Dunbar, are the sole owners and possessors of the reissue No. 9957 of the letters patent No. 178,916 issued to James F. Emerson (administrator of George W. Dunbar,
255 deceased,) and George H. Dunbar and Francis B. Dunbar, for a new and useful improvement in preserving shrimps

in metal cans, for which letters patent were issued to said Geo. W. Dunbar, George H. Dunbar, and Francis B. Dunbar, dated 20th June, 1876, under the No. 178,916, and which letters were surrendered and cancelled and new letters issued as aforesaid to the said James F. Emerson, as administrator aforesaid, and George H. Dunbar and Francis B. Dunbar, on an amended specification, on the 6th day of December, 1881, under the No. 9957, as are fully set forth and described in complainants' bill; that the said patentees were the original and first inventors of the said improvement in preserving shrimp in metal cans; that the said invention is new and useful, and has never been used with their permission or consent by others; that the said reissued letters patent is a good, valid, and subsisting patent, and complainants are entitled to
256 the sole and exclusive use thereof.

And further, the court declares that the mode and processes used by the said defendants as charged in the bill of complaint and as averred in the answer are an infringement of the exclusive rights secured to the complainants by the letters patent aforesaid.

And further, the court doth order, adjudge, and decree that a perpetual injunction issue inhibiting the said defendants, their attorneys, agents, and servants, from directly or indirectly making or causing to be made, or using or causing to be used, in any manner, the improved method aforesaid, of preserving shrimps in metal cans, granted and secured to complainants by said letters patent, and from using, selling, or disposing of shrimp by them preserved as aforesaid in metal cans in violation of complainants' exclusive rights under the letters aforesaid.

And the court further decrees that the said complainants
257 are entitled to an account from the defendants of all such gains and profits as may have accrued or arisen, or as may have been earned or received by them, and of all such damages as complainants may have suffered from defendants' wrongful acts and doings in the premises, and an account of the quantity of shrimp preserved in metal cans by the said defendants in infringement of the patent aforesaid, and now in their possession or within their control. And the court orders that the cause be referred to Wm. Grant, esq., master in chancery, to take the accounts aforesaid; and the court reserves all further orders to the final action on the report.

(Signed) EDWARD C. BILLINGS,
Mch. 14th, 1883. *Judge.*

Injunction to Theodore T. White, William A. Gordon, and William Emmett C. Pecor.—Issued March 17, 1883.

258 UNITED STATES OF AMERICA.

Circuit Court of the United States, fifth circuit and eastern district of Louisiana.

GEORGE H. DUNBAR et als.
vs.
T. T. WHITE et al. } No. 9858.

The President of the United States to Theodore T. White, William A. Gordon, and Emmett C. Pecor, greeting:

Whereas it has been represented to us in our said Circuit Court, on the part of George H. Dunbar and others, in a bill in equity lately exhibited against you, and each of you, touching certain matters and things therein set forth:

Now, therefore, in consideration of the premises and of the allegations in said bill contained, you, the said T. T. White, W. A. Gordon and E. C. Pecor, your attorneys, agents, and servants, and each of you, are hereby commanded and strictly perpetually en-
259 joined, under the penalty of the law, that you absolutely refrain and desist from directly or indirectly making or causing to be made in any manner, or using or causing to be used in any manner, the improved method of preserving shrimp in metal cans, as described in the letters patent issued and reissued to said complainants by the United States, as mentioned in the said complainants' bill of complaint, granted and secured to complainants by letters patent, and from using, selling, or disposing of shrimp by them preserved as aforesaid in metal cans in violation of complainants' exclusive rights under the said letters patent aforesaid.

Witness the Honorable Morrison R. Waite, chief justice of the Supreme Court of the United States, at the city of New Orleans, this 17th day of March, in the year of our Lord 1883.

[SEAL.] (Signed) T. V. COUPLAND,
D'y Clerk.

Marshal's Return.

260 Received March 17th, 1883, by the U. S. marshal, and I served a true copy of the within injunction on each of the persons herein named in the following date and manner, to wit:

Theodore T. White, personally, in city of New Orleans, March 17th, 1883; William A. Gordon, personally, in city of New Orleans, March 17th, 1883; Emmett C. Pecor, personally, in city of New Orleans, March 22d, 1883.

(Signed) J. R. G. PITKIN,
U. S. Marshal, East. Dist. of La.
By E. S. CURRY,
D'y U. S. Marshal.

Master's Report and Account.—Filed March 28, 1883.

U. S. Circuit Court, east. dist. of La.

GEO. H. DUNBAR et als.
vs.
T. T. WHITE et al. } No. 9858.

Report of William Grant, master, on the reference contained in the decree rendered herein on the 14th of March, 1883, directing an account to be taken of the profits derived by defendants
261 from their infringement of the complainants' patent.

The respondents have submitted the account hereto annexed and marked *Exhibit A* and made part hereof, which shows that they have made a profit of $1,205.98 in their business of packing shrimps by the use of complainants' patent process.

Both parties appeared before me on the 27th day of March, 1883, by their respective solicitors, and submitted the matters covered by said reference upon the evidence contained in said account.

I have therefore adopted said account as a true statement of the profits for which respondents are to account in this case. The respondents are therefore found to be indebted to the complainants in the sum of $1,205.98 for profits derived by them from the use of complainants' process secured by the letters patent on file in this cause.

Respectfully submitted.
March 28th, 1883.
(Signed) WILLIAM GRANT, *Master.*

262 *Statement of T. T. White & Co.'s Packing of Shrimp from Jan'y 2, 1882, to March 10, 1883.*

Sales, 4,476 cases shrimp; proceeds.....		$22,005 52
Machinery, etc., on hand.....	$2,083 57	
Less 10 per cent. wear and tear.....	208 35	
		1,875 22
Material on hand.....		1,381 95
64 cases shrimp on hand not labeled or cased, $4.00.....		256 00
55 cases shrimp returned to us damaged....		000 00
		25,518 69

Dr.

P'd for raw shrimp.....	8,506 29	
" labor.....	6,394 79	
" tin, solder, lead, etc.....	2,448 68	
" 1 car-load empty tin cans.....	1,497 86	
" empty boxes.....	461 80	
Carried forward	$19,309 42	

Bond for Appeal.—Filed April 3d, 1883.

UNITED STATES OF AMERICA.

267 Know all men by these presents, that we, Theodore T. White, William A. Gordon, and Emmet C. Pecor, as principals, and B. F. Chambers, as surety, are held and firmly bound, jointly and severally, unto George H. Dunbar, Francis B. Dunbar, and Charlotte Z. Dunbar, in the sum of two thousand dollars, lawful money of the United States of America, to be paid to the said George H. Dunbar, Francis B. Dunbar, and Charlotte Z. Dunbar, their heirs, executors, administrators, and assigns, for which payment, well and truly to be made, we bind ourselves, and each of us by himself, and each of our heirs, executors, and administrators, firmly by these presents.

Sealed with our seals and dated the 3d day of April, in the year of our Lord eighteen hundred and eighty-three.

Whereas the said Theodore T. White, William A. Gordon, and Emmet C. Pecor having heretofore, to wit, on the 3d day of April, 1883, taken an appeal to the Supreme Court of the United
268 States from and to reverse the decree rendered on the 29th day of March, 1883, by the Circuit Court of the United States for the fifth circuit, holding sessions in and for the eastern district of Louisiana, in the suit of George H. Dunbar et als. *v.* T. T. White et als., No. 9858 of the docket thereof:

Now, the condition of the above obligation is, that if the above bounden Theodore T. White, Wm. A. Gordon, and Emmet C. Pecor shall prosecute their said appeal to effect, and shall answer all damages and costs if they shall fail to make good their plea, then this obligation shall be void; otherwise to remain in full force and virtue.

(Signed) T. T. WHITE. [L. S.]
W. A. GORDON. [L. S.]
E. C. PECOR. [L. S.]
B. F. CHAMBERS. [L. S.]

Bond approved.

(Signed) EDWARD C. BILLINGS,
Judge.

269 *Motion to suspend Injunction pending Appeal.—Entered, filed, and submitted April 4th, 1883.*

GEO. H. DUNBAR et als. *v.* T. T. WHITE et al. } U. S. Circuit Court.

And now come the defendants and move the court that it will exercise its discretion under rule 93 of the Rules of Practice for the Courts of Equity of the United States, and make an order suspending the injunction herein issued, during the pendency of the appeal, upon such terms as to bond or otherwise as the court may consider proper for the security of the rights of the complainants.

And A. H. Leonard, esq., counsel of complainants, was present, and objecting:

Whereupon the court took the motion under advisement.

Order—Motion to Suspend Injunction, &c., denied.

Extract from the Minutes of April 12, 1883.

GEORGE H. DUNBAR et als. }
v. } No. 9858.
T. T. WHITE et al. }

270 Upon due consideration of the defendants' motion to modify the decree herein rendered on 29th March, 1883, submitted to the court on the 4th day of April instant, it is ordered that the said motion of the defendants be denied.

271 UNITED STATES OF AMERICA, }
Circuit Court of the United States. }

Fifth circuit and eastern district of Louisiana.

CLERK'S OFFICE:

I, Francis A. Woolfley, clerk of the Circuit Court of the United States for the fifth circuit and eastern district of Louisiana, do hereby certify that the foregoing 270 pages contain and form a full, complete, true, and perfect transcript of the record and proceedings had, together with all the evidence adduced (excepting the cans of shrimps and boxes of guava jelly offered by both parties, the originals whereof are forwarded herewith) on the trial of the case of George H. Dunbar et als. *vs.* T. T. White et al., No. 9858 of the docket of the said court.

Witness my hand and the seal of said court, at the city of New Orleans, this 15th day of May, A. D. 1883.

Twenty-two (22) words interlined.

Approved.

[SEAL.] F. A. WOOLFLEY, *Clerk.*

I, Edward C. Billings, United States judge for the eastern district of Louisiana, do certify that Francis A. Woolfley, whose name is signed to the above certificate as clerk of the Circuit Court of the United States for the fifth circuit and eastern district of Louisiana, was at the time of signing said certificate, and is now, the clerk of said court; that said certificate is in due form of law, and that full faith and credit are due to his official attestations as such clerk.

Given under my hand, at the city of New Orleans, in said district, this 15th day of May, A. D. 1883.

Two (2) words interlined.

Approved.

EDWARD C. BILLINGS, *Judge.*

272 UNITED STATES OF AMERICA, }
Circuit Court of the United States. }

Eastern district of Louisiana.

The President of the United States to George H. Dunbar, Francis B. Dunbar and Charlotte Z. Dunbar, greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States to be holden at the city of Washington on the second Monday of October next, pursuant to a motion and order for an appeal filed in the clerk's office of the Circuit Court of the United States for the fifth circuit and eastern district of Louisiana, wherein Theodore T. White, William A. Gordon and Ernest C. Pecor are appellants, and you are appellees, to show cause, if any there be, why the decree rendered against the said appellants as in said motion and order for an appeal mentioned should not be corrected, and why speedy justice should not be done to the parties in that behalf.

Witness the Honorable Morrison R. Waite, chief justice of the Supreme Court of the United States, this 3d day of April, in the year of our Lord one thousand eight hundred and eighty-three.

EDWARD C. BILLINGS, *Judge.*

273 (Endorsed:) United States Circuit Court, eastern district of Louisiana; No. 9858; Theodore T. White et als., appellants, *vs.* George H. Dunbar et als., appellees; citation to appellees, A. H. Leonard, solicitor.

Marshal's Return.

Received Apr. 6, 1883, by the U. S. marshal, and on April 6th, 1883, I served a true copy of the within citation of appeal on George H. Dunbar, Francis B. Dunbar, and Charlotte Z. Dunbar, appellees herein, by handing the same to A. H. Leonard, esq., the solicitor for said appellees, in person, in the city of New Orleans.

J. R. G. PITKIN,
U. S. Marshal East. Dist. of La.
By E. S. CURRY,
Dep. U. S. Marshal.

Personally appeared before me E. S. Curry, a lawful deputy of J. R. G. Pitkin, U. S. marshal for the eastern district of Louisiana, and makes oath that he served a copy of the within citation of appeal on the appellees herein named, as set forth in his official return herein.

E. S. CURRY,
Dep. U. S. Marshal, East. Dist. of La.

Subscribed and sworn before me April 10th, 1883.

T. V. COUPLAND,
Commissioner United States Circuit Court, East. Dist. of Louisiana.

119-47

IN THE

Supreme Court of the United States.

No. 924.—October Term, 1883.

Theodore T. White et al., Appellants,
vs.
George H. Dunbar et al.

Now come the appellants in the above-entitled case, by their solicitors, and ask the court to so amend the present decree of the Circuit Court of the Eastern District of Louisiana, entered therein, as to empower and permit the applicants, the defendants therein, to proceed and continue in the manufacture and sale of shrimp in cans, which constitute the subject-matter of the complainant's letters-patent at issue, under such restrictions as the court may deem just and equitable, and until such time as final action is had in the case by this court; and your appellants will ever pray.

Joseph P. Hornor and
F. W. Baker,
Solicitors for Appellants.

Joyce & Spear,
Of Counsel.

In the Supreme Court of the United States.

Theo. T. White et al., Appellants,
vs.
Geo. H. Dunbar et al., Appellees.
No. 924.

The appellees will please take notice that an application to modify the injunction issued in this case, a copy of

which is hereto annexed, will be presented to the Supreme Court of the United States on the second Monday (8th) of October, 1883, or as soon thereafter as may be.

JOSEPH P. HORNOR and
F. W. BAKER,
Solicitors for Appellants.

JOYCE & SPEAR,
Of Counsel.

Service accepted 29th Sept., 1883.

J. W. GURLEY,
For A. H. LEONARD,
Solicitor for Compl'ts.

U. S. SUPREME COURT. IN CHANCERY UNDER RULE 30.

T. T. WHITE ET AL., APPELLANTS,
vs.
GEO. H. DUNBAR ET AL., APPELLEES. } No. 924. October Term, 1883.

Statement of facts affecting the motion of appellants to suspend or dissolve the injunction granted by the court below, viz., the United States Circuit Court for the Eastern District of Louisiana.

First. The complainants in this bill set up that they were the owners of letters-patent (original) No. 178,916, issued 20th June, 1876, for method of preserving shrimps and other shell-fish (a copy of which is hereto annexed and made part hereof); that on 6th December, 1881, they surrendered said patent, in accordance with the provisions of law, and obtained reissued letters-patent No. 9,957, dated 6th December, 1881, for preserving shrimp in metal cans (a copy of which is hereto annexed and made part hereof); that since 1st March, 1882, defendants have been unlawfully infringing said patents by preserving shrimps in metal cans, by providing the cans used by them with a lining, to prevent direct contact of the shrimps

with the metal; and they prayed for an injunction and an accounting and a decree accordingly.

Second. The answer admitted the issuance of the original and reissued patents alleged by the complainants, but averred that they were illegal, null and void, 1st, for want of invention; 2d, for want of novelty; 3d, because the reissued patent claimed a different invention from the original patent; 4th, because the reissued patent was illegal, and illegally issued; and 5th, because the invention claimed in the reissued patent was not the same as claimed in the original patent; and admitting that defendants were "preserving shrimps in metal cans by providing the cans used by them with a lining to prevent direct contact of the shrimps with the metal," but denying that their so doing infringed the invention of complainants; and finally, they alleged that they anticipated the expansion of the claim of the original patent of complainant in their reissued patent, by a patent issued to defendants under the No. 226,347, under date 6th April, 1880, for an improvement in canning fish, (a copy of which is hereto annexed and made part hereof).

Third. Upon a preliminary hearing the court ordered the injunction to issue, but subsequently modified its order by allowing defendants to continue their business, but requiring them to file in court a monthly account of their manufacture and sale of preserved or canned shrimp, which was done.

Fourth. It is agreed between counsel on the trial and testified to by the complainants in their evidence taken in the case, that the only invention that complainants claimed, and the only infringement they claimed the defendants had committed was the interposition "between the metal can and the shrimp (of) an enveloping material for the shrimp, which is not itself capable of discoloring the shrimp."

Fifth. The court found against the defendants on all the points presented by them, and in favor of the complain-

ants, and issued the injunction asked for, restraining defendants from further continuing their business in packing shrimp, which, it was admitted, they had been doing since 1st March, 1882, and referred the case to a master to report.

Sixth. The master reported in favor of complainants for $1,205.98, and judgment was entered against defendants for that amount, and they appealed.

New Orleans, Louisiana, 2d October, 1883.

Above statement agreed to except as to fourth item.

A. H. LEONARD,
Solicitor for Complainants.

The above statement agreed to as a whole.

JOYCE & SPEAR,
Solicitors for Defendants.

The above paragraphs, numbered from one to six inclusive, with the exception of paragraph numbered four, having been assented to by the solicitors of the respective parties to the suit as a statement of the facts pertinent to the motion to dissolve the injunction, are adopted by me. Not having opportunity to consult the record in the cause, I can make no additional statement other than to make a reference to a very short opinion which I rendered in the decision of the question as to the injunction, and which I make a part of this statement.

EDWARD C. BILLINGS, *Judge.*

October 12, 1883.

114-9 12 OCT 21 1885

SUPREME COURT OF THE UNITED STATES.

No. 924. OCTOBER TERM, 1885.

T. T. WHITE et als., Appellants,

vs.

GEORGE H. DUNBAR et als., Appellees.

Appeal from the Circuit Court for the Eastern District of Louisiana.

Brief for Appellants.

JOSEPH P. HORNOR,
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Solicitors.

AND

JOYCE & SPEAR,
Of Counsel for Appellants.

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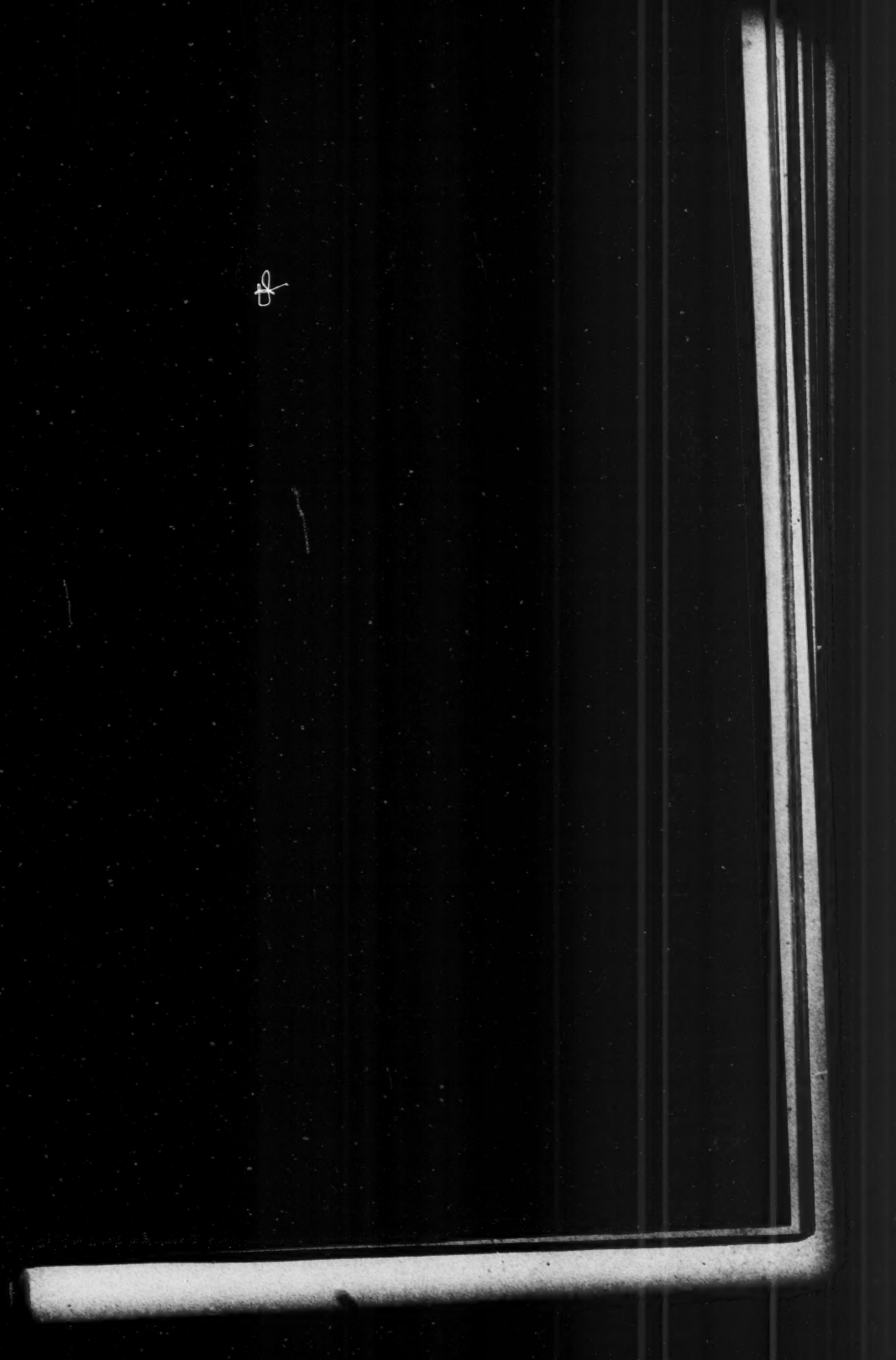

Supreme Court United States.

No. 924.

OCTOBER TERM, 1883

T. T. WHITE ET AL., *Appellants*,

vs.

GEORGE H. DUNBAR ET AL., *Appellees*.

Appeal from the Circuit Court for the Eastern District of Louisiana.

Brief for Appellants.

Statement of the Case.

This suit is for an alleged infringement of complainants reissued letters-patent.

On the 20th of June, 1876, letters-patent No. 178,916, were issued to the complainants for an "Improvement in methods of preserving shrimps and other shell-fish."

Record, p. 6 and following.

From the specification annexed we learn that the object of the invention was to provide an improved method of preserving shrimp and prawns, and indeed all kinds of shell fish, and prevent their discoloration, and insuring the retention of their original freshness and flavor. The applicants say that primarily their improvement consisted in so placing a suitable *textile fabric* between the fish or other article of food to be preserved, as to cause it to intervene as to prevent, under all circumstances, any direct contact between the metallic surface of the can and its contents; and it is the employment of such *textile fabric* in connection with the process hereinafter described, of treating the fish or other article both before and after the same is placed in the can and sealed, which constitutes the nature or subject matter of our present invention. The bag or sack they propose to construct of *cotton*, *muslin*, or any other suitable *textile fabric*. Material of the cheapest and most inferior quality might be used, as the sole object of its use was to prevent the article to be preserved from coming in direct contact with the surface of the can and which contact with the metal, in the case of the shrimp, caused during the process of boiling and thereafter until the can was opened, a precipitation of a black substance which detracted much from the color, freshness, and richness of the flavor of the shrimp. They further say that practical experience had fully demonstrated the fact that by using *textile fabric*, as described, the precipitation of the substance alluded to was prevented, or at least did not appear on the fabric or metal; hence the value and importance of this feature of the invention.

Therefore they claimed as new and desired to secure by letters-patent the following:

"The herein described method of preserving shrimps, &c., preventing their discoloration, which consists in placing textile fabric between the can and its contents, and

then sealing the can and subjecting the same to a boiling process, substantially as and for the purpose specified."

More than three years after the issue of the said patent to the complainants, to wit, on the 13th day of August, 1879, Pecor & Bartlett, the defendants' assignors made application for a patent for "canning shrimps and other fish," upon which a patent was granted April 6th, 1880, numbered 226,347.

Record, p. 50.

In the specification the applicants say that their "invention relates to the canning of shrimps and other like shell-fish, and has for its object the better preservation of the fish and greater expedition and cheapness in canning."

It is also stated that theretofore it had "been the practice in canning shrimps and like shell-fish to enclose the fish in a bag made of some *textile fabric*, 'place the bag in a can and then to boil the can and contents,'" &c. The applicant further says that "this mode of treatment, when applied to the preservation of shrimps is, to a certain extent, defective, for the reason that certain acids, or acidulous substances, existing in or generating from the fish, attack the tin can, and thereby impart to the contents an unpleasant taste greatly affecting the quality of the food thus preserved. The first part of our invention has for its object to obviate this difficulty, and it consists in lining the can with a coating of asphaltum cement. This coating we form of any good quality of asphaltum dissolved

in any solvent suitable for the purpose. When the solution is of proper consistency for convenient application we coat in any convenient way the whole interior of the can therewith, and also apply a coating to the inside of the cover, &c.; the coating within the can and upon the cover is then thoroughly dried and the can is then ready to receive its contents. This coating effectually protects the metal of the can from the action of any acid or acidulous substances, and we have found by careful and thorough experiments that it serves to preserve the shrimps perfectly fresh and sweet.

Besides its quality of resistance to the action of acids it is tough and flexible, and does not break when the can, as often happens, is indented or bent.

In carrying out the second part of our invention, instead of the ordinary bag of *textile material* which has heretofore been used to enclose the shrimps, we have found that a cheaper and better substitute may be made from paper, which we prepare and apply by coating the paper with a hot solution of paraffine or kindred substance.

Having thus described their invention they made the following claims:

"In a flexible metalic can for shrimps and like fish *a coating of asphaltum cement* covering the inner surface of the can and adhering to the metal as and for the purposes set forth.

"In combination with the metalic can lined with asphaltum cement, in the manner described, *an interior paper lining prepared with paraffine*, as and for the purposes set forth."

Under this patent Pecor & Bartlett packed shrimps in Galveston and New Orleans until January, 1882, when defendants bought the patent, and after that date they operated under it.

After obtaining their patent of June 20th, 1876, the complainants proceeded with their business, under said patent, and carried it on until April 9th, 1881, when they surrendered it, and on the 6th of December, 1881, obtained a reissue, No. 9,957, for "preserving shrimps in metal cans."

Record, p. 10.

It appears from the specification in this patent that the only cause or reason for the reissue was that the applicants had found out that "*direct contact of the shrimps with the can and the presence of free liquid or gravy in the shrimps, after they are placed in the cans,* are very objectionable," because the "free liquid or gravy in the shrimps constituted a vehicle or medium to diffuse the coloring matter throughout the entire mass of shrimps in the can."

They state that the "object of the invention or reissue is to obviate the above named objections by first lining the can; and second, placing the shrimps in the lined can while they are in a dry or moist condition and devoid of free liquid or gravy, and sealing the can without adding any liquid to its contents."

They further say that the lining is to be, preferably, of *cotton* or *muslin*, but material of the cheapest and most inferior quality may be used, as the sole object of its use is to prevent the article to be preserved from coming in direct contact with the surface of the can.

In describing the process of canning, they say that after the shrimps have been placed in boiling water they are taken out and placed on drippers and cooled, and rinsed with cold water, and when thoroughly dripped and in a moist condition, and without the addition of any salted or otherwise prepared liquid, they are placed in the sack, &c.

They then claim as new the following:

"What we claim as new, and desire to secure by letters-patent, is: As an improvement in the art of preserving shrimps in metal cans, the mode of preventing the discoloration of the shrimps, which consists in interposing between the metal can and the shrimps *an enveloping material* for the shrimps, which is not itself capable of discoloring the shrimps, and then sealing the can and subjecting the same and its contents to a boiling process, substantially as described."

Upon the testimony set forth in the record and the foregoing patents, the Court below held that the defendants were liable and entered a decree for complainants, from which defendants appealed.

Assignment of Errors.

The defendants contend that the judgment of the Court below is erroneous for the following reasons:

1. Because the subject-matter of the original patent, as also of the reissue, was not *novel* at the time of its pretended invention.

2. Because the complainants do not show that their application for a reissue came within the provisions of section 4916 of the Revised Statutes of the United States relating to reissues, and that the same is therefore null and void.

3. Because *new matter* was introduced into the specification, and the claim was enlarged, generalized, and made broader.

4. Because the Court below held that in a case where complainants' right to recover against defendant would have been perfect under an original patent, a surrender and reissue cannot invalidate that right.

1.

The subject-matter was not novel at the time of the alleged invention.

What is the subject-matter of the complainants' patent which they claim as an invention?

It is simply wrapping an article, such as a shrimp or a fish, up in something, such as a cloth bag, before putting

it in a box, for the purpose of keeping the wrapped up article from coming in contact with the surface of the box.

Can that, under the law, be called a new device or an invention? Is it not as old as boxes, and as old as wrapping things up and putting them into boxes?

If the state of the art shows, as we contend it does, that the enveloping of tea in lead before putting it into wooden boxes to preserve the flavor of the tea; the putting jelly in paper bags before putting it into cans; the enveloping of clothes and furs with paper and other materials before laying them away for the summer, and many other equally familiar illustrations have been done for ages, then there can be no novelty in complainants' device, and therefore they have no legal right to appropriate it to themselves under the protection of a patent.

Record p. 91-92

And if paper or cloth bags were used for years before the complainants' pretended invention, does it make the slightest legal difference what they were used for?

In the very familiar case of the Rubber-Tip Pencil Co. vs. Howard there was a useful combination, which conferred a benefit which the whole commercial world has availed itself of. But this court held that it was no invention to force the end of a wooden pencil into a small hole made in a piece of rubber, and refused to sustain the patent, saying that "though an idea of a person, who afterwards obtains a patent for a device to give his idea effect,

may be a good idea, yet if the device is not new his patent is void, even though it be useful."

20 Wallace, 498.

"The application of an old process to a new subject without any exercise of the inventive faculty and without the development of any idea which can be deemed new or original in the sense of the patent laws, is not the subject of a patent.

"The thing was within the circle of what was well known before, and belonged to the public.

"No one could lawfully appropriate it to himself and exclude others from using it in any usual way for any purpose to which it may be desired to apply it.

"This is fatal to the patent."

91 U. S., 37 and 41.

No citation of authorities is necessary to establish the proposition that an old thing applied to a new use without any other invention, is not a patentable contrivance.

The complainants in this case occupy the same position under their patent that they would if they had used a coffee-mill for the first time to grind corn.

It is the application of an old process to an article to which it had never before been applied.

There is no new process or new machinery used to produce the result, and it is not therefore a patentable invention.

2 Story 194, 411, and 412.

In a case of this kind the Court will take judicial notice

that the thing patented was known and in general use long before the issuing of the patent.

99 U. S., 593. 19 O. G. 1256

It is apparent from the testimony of George H. Dunbar, and the admission of the complainants as to the testimony of F. B. Dunbar, that the complainants disclaim any invention in their re-issued patent except for the *enveloping material.*

Record, pp. 74, 75, and 79.

It is also insisted by the defendants that the complainants' pretended invention was fully anticipated by a patent to George H. Chinnock, No. 156,693, dated November 10, 1874.

Record, p. 48.

2.

The complainants fail to bring their application for a reissue within section 4916 of the Revised Statutes.

The complainants, relying upon the theory of the exclusive jurisdiction and finality of the decision of the Commissioner of Patents, as touching this question of reissue, have failed to show in any manner that their original

patent was inoperative or invalid by reason of a defective or insufficient specification, or that any error had arisen by inadvertence, accident, or mistake.

As to the question whether the decision of the Commissioner is conclusive on the statutory grounds for a reissue, notwithstanding there may have been decisions both ways, and that in some measure it may still be treated as an open question, still we are confident that the rule laid down by Walker, in his valuable work on Patents, Sections 221, 222, 223, 224, and 225 will be adopted whenever this Court shall see fit to pass upon it.

After a careful examination and comparison of all the cases bearing upon the question, he arrives at the conclusion that "the decision of the Commissioner relevant to the existence of a statutory ground for a reissue, is not conclusive in any court, because he has no jurisdiction to grant any reissue in the absence of such a statutory ground; and because the statute does not make him the final judge of his own jurisdiction."

O. G., March 3, 1885.

3.

As to the introduction of *new matter* and the *enlarging of claims* in reissued patents:

It was held by this Court in the case of the Giant Powder Co. vs. California Powder Works et al., 15 O. .G, 289, that—

"A reissue can only be granted for the same invention which formed the subject of the original patent of which it is a reissue. The express words of the statute are, 'a new patent for the same invention;' and 'no new matter shall be introduced into the specification.'

"If a party in a reissue attempts to expand the original invention and cover what was not originally claimed in order that he may appropriate to himself what had since been discovered and used outside of his invention by others, it will be void."

"This privilege of reissue was not given to the patentee in order that the patent may be rendered more elastic or expansive, and therefore more available for the suppression of all other inventions."

1 Wallace, 577; 11 Wallace, 516 and 544.

"Where the evident purpose of the reissue application is to broaden the claims, it must clearly appear that there was a mistake or error in the original preparation of the case, and that the applicant took immediate steps to have it corrected."

23 O. G., 2,029.

The rule laid down by this Court is "that where it is sought merely to enlarge a claim there must be a clear mistake and inadvertence and a speedy application for its correction, with no unreasonable delay; that in such a case a patentee cannot wait until other inventors have pro-

duced new forms of improvement, and then apply for such an enlargement of his claim as to make it embrace these new forms; and that when it is apparent, from a comparison of the two patents, that the reissue is made to enlarge the scope of the patent, the Court may consider whether the delay was unreasonable, and the reissue therefore void."

Wooster vs. Handy, 23 O. G., August 12, 1884. 629

By a failure to take immediate steps towards correcting a patent, the patentee acquiesces in the terms of the grant and dedicates the invention to the public use.

11 Federal Reports, 595.

In the case of Conklin vs. Stafford, Supreme Court of this District, 5 O. G., 235, it was held that "by the terms of the statute, (Revised Statutes United States, sec. 4916,) in order to entitle a party to the reissue of a patent, it is incumbent on him to show that it is inoperative or invalid by reason of a defective or insufficient specification, or that the patentee had claimed more than he had invented, and that the error had arisen by inadvertence, accident, or mistake, and without any fraudulent intention.

"Unless these circumstances exist in an application of this character, there is no authority by which the Commissioner of Patents can reissue a patent.

"Therefore if the original patent is neither inoperative nor invalid, and if no error has been occasioned by accident or mistake, then there must be a presumption of law and fact that the patentee has abandoned to the use of the public everything which he may have invented, but which he did not include in his specification and claims." 2204.87

The statute embraces only the right to a reissue where, from an unintentional error in the description of the in-

vention, the patent is wholly inoperative or invalid.

7 Wallace, 685; 4 Fisher, 117.

And even in a case involving accident or mistake, nothing but what was shown in the original specification, drawings, or model can be introduced into a reissue.

2 Fisher, 499 and 543.

21 O. G. 1443

In the case at bar there were neither drawings nor model showing the new matter embraced in the reissue, and nothing mentioned or described in the specification except a "*textile fabric.*"

The surrender of a valid patent and the granting of a reissue thereon, with expanded or equivocal claims, where the original was clearly neither inoperative nor invalid, and where the specification is neither defective nor insufficient, is a great abuse of the privilege granted by the statute, and productive of great injury to the public.

28 O. G., 629 and 917.

In the case at bar there is no proof and can be no pretense that the original patent was inoperative or invalid, or that there was either accident or mistake in drawing the specification or claims.

The description was not defective or in any way obscure or ambiguous, but was full, clear, concise and exact.

It was not insufficient, as nothing was inserted which ought not to have been, and nothing which was described or shown was left out.

It was capable of being worked, because the complainants canned shrimps under it from 1876 to 1881.

The complainants pretend that the trouble with the original patent was that the idea of the *exclusion of gravy or liquid* from the can was not set forth definite enough.

But if we examine the two patents we shall see at once that this claim has not the least shadow of foundation, and that no necessity for an attempt to make the specification more definite existed.

It was declared in the original patent that the prepared shrimp in a moist condition, without the addition of any salted or otherwise prepared liquid, was to be placed in the can. This was clear, definite, and sufficient, and no one putting up shrimps under that patent would be expected to do what the patent *declared in unequivocal terms must not be done.*

That we are correct in this construction of the terms of that patent is conclusively shown by the conduct of the complainants; for when they came to reissue they entirely *omitted to make any change in the specification as to this matter of the gravy or liquid*, but enlarged and generalized their claim by substituting for "*textile fabric*" [illegible] *enveloping material.*" If they did not desire [illegible] claim, why did they seek a reissue without [illegible] single word in the specification?

In the light of these facts nothing can be clearer than that the reissue was obtained for the sole purpose of covering up the defendant's invention, made long after the granting of the complainants' original patent.

In the case of James vs. Campbell, 21 O. G., 337, it was held that "if letters-patent fully describe and claim a specific invention, *complete in itself*, so as not to be inoperative or invalid by reason of a defective or an insufficient specification, a reissue cannot be had for the purpose of expanding and generalizing the claim in order to embrace an invention not specified in the original."

29 O.G. 693

The complainants' original letters patent fully and clearly described and claimed a specific invention which was complete and operative; that was, a lining composed of a *textile fabric* and nothing more; it was valid and sufficient so that they worked under it for five years, and are still doing so, in the same manner as though no reissue had ever been granted.

See Record, p. 76.

And again, we say that the conclusion is irresistible that the only possible object of the reissue must have been to *enlarge and generalize* the claim.

In the case of Russell vs. Dodge, 93 United States Reports, 464, it was held that "the original patent was not inoperative or invalid from a defective or insufficient specification. The description given of the process claimed was, as stated by the patentee, full, clear, and exact, and *the claim covered the specification*—the one corresponded with the other.

"The change made in the old specification by eliminating the necessity of using the fat liquor in a *heated* condition, and making in the new specification its use in that condition a mere matter of *convenience*, and the insertion of an independent claim for the use of fat liquor in the

treatment of leather *generally*, operated to enlarge the character and scope of the invention.

"The evident object of the patentee in seeking a reissue was not to correct any defects in the specification or claim, but to *change both*, and thus obtain, in fact, a patent for a different invention.

"This result, the law, as we have seen, does not permit."

Now if we substitute in the above paragraph the words "*texible fabrics*" for "*fat liquor in a heated condition*," and "*enveloping material*" for the words "*fat liquor*," the above cited case becomes exactly in point and completely covers the one at bar.

The courts hold that in these reissue cases "the danger to be provided against is the temptation to amend a patent so as to cover improvements which may have come into use, or may have been invented by others, after the granting of the original patent."

Powder Co. vs. Powder Works, 98 U. S., 138.

It has been suggested by the complainants, that in all those cases where the courts have held reissued patents void, there was a wider expansion and greater broadening of the claims than in this case.

A brief glance at a few of the leading cases will show that the complainants' suggestion is not correct.

In Miller vs. Brass Co., the original patent was for a lamp with a *double dome;* the reissue was for a *single dome with a chimney.*

104 U. S., 351.

In James vs. Campbell, the original patent among other things claimed for a post office stamp the cancelling device of which was "wood, cork or *similar* material," while the reissue was for "cork, wood or other *suitable* material."

104 U. S., 361 and 373.

In Russell vs. Dodge, the original patent was for "the use of *heated* fat liquor in treating *bark tanned lamb or sheepskin;* the reissue was for the use of fat *liquor* (the word "heated" being omitted), in the treatment of leather *generally.*

93 U. S., 460. 98 U. S., 126. 104 U. S., 748. 105 U. S., 57 and 160.

In Searls vs. Benton, the original patent was for a *whip-socket having a bell-shaped top;* the reissue was for a whip-socket *generally,* without any limitation as to the form of the top.

12 Federal, 874.

In Giant Powder Co. vs. Cal. Vigori Powder Co., the original patent was for a compound of an *inexplosive* porous substance with nitro-glycerine; the reissue was for a com-

pound of all porous substances, whether *explosive* or *inexplosive*, with nitro-glycerine.

6 Sawyer, 509.

There is, however, a still graver reason why the reissued patent in this case should be declared void, and that is because the rights of the defendants intervened before the reissue was applied for.

The complainants' *never* discovered that any "enveloping material" would answer in the place of their "textile fabric," therefore they obtained the expanded claim in their reissue for something which was the invention of another; because on the 13th of August, 1879, nearly two years before the complainants made application for their reissue, one of the defendants' assignors made application for a patent for "a new and useful improvement in canning shrimps and other fish," and on the 6th of April, 1880, letters patent No. 226,347 was issued to them. In the specifications annexed to the application for said patent the following declaration was made, showing that the attention of the officers of the Patent Office was called to the patent of the complainants, when defendants' patent was applied for:

"Heretofore it has been the practice in canning shrimps and like shell-fish to enclose the fish in a bag made of some textile fabric, to place the bag containing the fish within an ordinary tin can, and then to subject the can and its contents to the ordinary boiling and modes of treatment such as are ordinarily used in canning vegetables and animal substances;" and that is therein then described to be; (p. 52, Record,) "instead of the ordinary bag of *textile material* which has heretofore been used

to enclose the shrimps, *we* have found that a cheaper and better substitute may be made from paper," ——— "this paper lining being much more cheaply and expeditiously applied than the cloth bags heretofore used, as no sewing is required;" and thereupon they claimed and were allowed by their patent, "an interior paper lining prepared with paraffine, as used for the purposes set forth."

P. 53, Record.

This is certainly a good and valid patent.

In 4 Fisher, 379, it is laid down that the substitution of an *India rubber* covering for one of *cloth* may be an invention if it is important and valuable.

In this case the substitution of a paper lining prepared with paraffine and a coating of asphaltum cement for a cloth bag of textile fabric, is important and valuable because if the latter is used the shrimps may become discolored, while the former absolutely prevents it.

This is clearly just such a case as that mentioned by Judge Bradley, where the patentee waited until the defendants had produced a new form of improvement, and then with this newly acquired light applied for such an enlargement of his claim as would embrace and cover up those new forms.

The doctrine laid down by the courts in all the later cases is, that when a patentee claims an actual mistake in his patent, which must have been apparent upon the first inspection of the instrument, if he desires to have it corrected by reissue, it must be applied for immediately.

In the Miller & Brass Co. case the court say that "afterthoughts developed by the subsequent course of improvement, and intended by an expansion of claims to sweep into one net all the appliances necessary to monopolize a profitable manufacture, are obnoxious to grave animadversion.

"Nothing but a clear mistake or inadvertence, and a speedy application for its correction, is admissible when it is sought merely to enlarge the claim.

"A claim cannot be enlarged except when an actual mistake has been made, such as a court of chancery would correct.

"In reference to reissues made for the purpose of enlarging the scope of the patent, the rule of laches should be strictly applied, and no one should be relieved who has slept upon his rights, and thus led the public to rely on the implied disclaimer involved in the terms of the original patent; and when this is a matter apparent on the face of the instrument upon a mere comparison of the original patent with the reissue, it is competent for the courts to decide whether the delay was unreasonable, and whether the reissue was, therefore, contrary to law and void."

Also in James against Campbell, it is said that "the court ought not to be called upon to explore the whole history of art, in order to ascertain what a patentee might have included in his patent had he been so disposed.

"If he was the author of any other invention than that which he specifically describes and claims, though he might have asked to have it patented at the same time and in the same patent, yet if he has not done so, and afterwards desires to secure it, he is bound to make a new

and distinct application for that purpose, and make it the subject of a new and different patent.

"If by accident, mistake, or inadvertence the claim does not fully define the patentees right in the invention, a speedy application for its correction, before adverse rights have accrued, may be granted."

21 O. G., 341. 19 O. G., 62 and 425.
Wollensak v. Reiher, 115 U. S., 96.
Mahn vs. Harwood, 112 U. S., 354.

As covering this whole subject of reissued patents, and abundantly supporting the view we take of this case, we would refer to the following additional cases: 18 O. G., 1,340. 7 Otto, 3 and 563. 3 Otto, 460. 8 Otto, 138. 1 Wallace, 531. 17 Wallace, 463. 21 O. G, 713. 22 O. G., 87. 9 Blatch., 524. 2 B. & A., Patent Cases, 164. 112 U. S., 354. O. G., March 3, 1885.

The record in this case shows that the complanants' patent was clear and complete and that they carried on business under it from 1876 to 1881, a period of five years before they applied for a reissue, while in the mean time a patent had been granted to the assignor of the defendants whereby the rights of third persons had intervened.

It has several times been held that an unexplained delay of much less than five years in applying for a reissue is altogether unreasonable in a case where, as in this, it is for the purpose of enlarging and expanding the scope of the claim.

23 O. G., 342.

If two years public enjoyment of an invention with the consent and allowance of the inventor is evidence of abandonment and a bar to an application for a patent, a public disclaimer in the patent itself should be construed equally favorable to the public.

20 O. G., 201.

In their reissue specification the complainants' say that they have found that free liquid is objectionable, and that the object of the reissue is to obviate this by putting the shrimps in "dry or moist."

This they say is why they desired a reissue, but as we have before said when they came to the claim, instead of covering that idea, they were content with "an enveloping material which will not of itself discolor."

The remedy claimed does not correspond with the evil set forth and described in the specification.

The original patent calls for a *textile fabric* which will prevent the shrimps from touching the can: the reissue calls for *an enveloping material*, which is not capable itself of discoloring the shrimps.

The original would allow the liquid or gravy to come in contact with the can and color the shrimps: the reissue would prevent it: one calls for a *cloth bag*, the other for a *water-proof lining*.

Thus in no sense can one be called the equivalent of the other.

But even if we should concede that the paper bag and the coating of asphaltum cement are the equivalents of the cloth bag, still we cannot escape the fact that the claim has been enlarged, because now it would include any lining which could be put in the inside of the can, such as nickel plate or anything of that kind, which, of course, could not be claimed as an equivalent.

The complainants are secondary inventors, and are only entitled to the specific form of device which they have produced, or its then known equivalents, consequently if we admit that the paper bag and cement are an equivalent it does not help the complainants, because the reissue covers more than an equivalent.

97 U.S. 554

But the defendants claim that in substituting paper water-proof and cement for the textile fabric they do not use an equivalent, and therefore do not infringe.

The defendants also say that the complainants, by limiting their claim to the use of a *textile fabric*, have left open the use of all other *enveloping material* to the whole world

In Aiken vs. Bemis, 3 Woodbury and Minot Reports, 354, Judge Woodbury said:

"That the patent extended on to the form or parts of the saw-set combined as set out, and made of any kind of materials, or saying nothing as to the materials, the right would be violated by a machine of like *form*, as the *form* would be the sole matter patented.

"But when the patentee choses to go further, and cover with his patent the *material* of which a part of his machine is composed, he entirely endangers his right to prosecute when a different and inferior material is employed."

Walker on Patents, Sec. 350.

And in Harris vs. Allen, 15 Federal Reports, 106, Judge Blodgett held that—

"The patent in question—an improvement in spring bed-bottoms—must be construed and held to be limited to a *wooden frame*, and as defendants used an *iron frame*, there was no infringement."

IV.

There is no validity in a surrendered patent after a reissue.

We understand that the complainants' contend in substance and effect that they are not obliged to rely upon their reissued patent, but can ignore that and fall back upon the original, and that under that patent the paper and cement used by the defendants to envelope the shrimps

is an equivalent for their "textile fabric," and therefore an infringement.

The Revised Statutes of the United States, section 4916, provides that the surrender of a patent "shall take effect upon the issue of the amended patent."

Previous to the act of 1870, the surrender of the patent took effect at the time of its surrender, whether it was reissued or not, but since the enactment of that section the law has been as before stated.

This renders the original patent absolutely void from the moment the reissue is granted.

Under the law as it stood previous to 1870, the courts held that—

"The surrender of the patent to the Commissioner, within the sense of the statute, means an act which, in judgment of law, extinguishes the patent.

"It is a *legal cancellation of it*, and hence can no more be the foundation for the assertion of a right after the surrender than could an act of Congress which has been repealed."

1 Fisher, 610. 17 Howard, 84. 4 Fisher, 423.

The court below held that "in a case where the plaintiffs' right to recover against the defendant would have

been perfect under an original patent, a surrender and reissue could not invalidate that right."

If by this his Honor intended to decide that after a party has surrendered his original patent and taken out a reissue, he can then go back and base a claim for infringement upon the surrendered patent, we most respectfully dissent from his opinion.

We insist that when a patentee, as in this case, has endeavored to illegally avail himself of the benefits of a provision in the patent law by obtaining a reissue to which he was not entitled, that reissue becomes a nullity, and his surrendered patent cannot and does not revive in his favor.

Having chosen his course and made his choice he must abide by it.

His original patent has been legally cancelled and he is left in possession of a void reissue, upon which no claim or action can be based.

JOSEPH P. HORNOR,
F. W. BAKER,
Solicitors.

AND

JOYCE & SPEAR,
Of Counsel for Appellants.

119-47

SUPREME COURT U. S.
FILED
OCT 13 1883

Supreme Court United States.

No. 924.—October Term, 1883.

T. T. WHITE et als., Appellants,

vs.

GEO. H. DUNBAR et als., Appellees.

Appeal from the Circuit Court for the E. Dist. of Louisiana.

Upon the Application to modify Injunction under Rule 30.

Brief for Appellants.

JOSEPH P. HORNOR and
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WASHINGTON, D. C.:
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Brief for Appellants.

For the purposes of this application it will not be necessary to call the attention of the Court to any part of the record except to the original and reissued patents set up by complainants, and to the patent claimed by the defendants.

The suit is for the infringement of complainants' reissued patent, for an injunction against the defendants and for an accounting. (Record, p. 1, *et seq.*) Upon the hearing of the rule *nisi* for a preliminary injunction, an order was entered granting the writ (record, p. 56), which order was subsequently modified by suspending the writ and ordering defendants to keep and file monthly accounts of their sales and manufacture (record, p. 64); upon the final hearing the injunction was granted (record, p. 98), and, after a reference to a master and his report, a decree for $1,205.98 was rendered in favor of complainants against the defendants (record, p. 103), and defendants took this appeal (record, p. 103). Defendants moved the lower Court

to allow the injunction to be suspended during the pendency of the appeal upon their giving bonds, &c., (record, p. 104), and it was refused by that Court (p. 105), and the present application is therefore made to your Honors.

On 20th June, 1876, Letters-Patent No. 178,916 issued to the complainants for an "Improvement in methods of preserving Shrimps and other Shell-fish." (See record, p. 6, *et seq.*). From the specifications annexed, we learn that, in attempting to preserve shrimps in cans of metal, it was found that "during the process of boiling, and all along thereafter until the can is opened, a profuse precipitation of a black substance, generally believed to be sulphur," took place, which discolored the shrimp and rendered it unmerchantable, and that patentees had discovered that by enveloping the shrimp in some *textile fabric* before placing them in the can, so as to prevent the shrimp from coming in direct contact with the surface of the can, the precipitation alluded to is prevented, or at least does not appear; therefore, they claimed by their patent: "The herein-described method of preserving shrimps, &c., preventing their discoloration, which consists in placing *textile fabric* between the can and its contents, and then sealing the can and subjecting the same to a boiling process, substantially as and for the purpose specified." (P. 9).

The complainants proceeded with their business under said patent and carried it on until 1881 (see bill of complaint, p. 2), when, without any particular reason whatever, that is disclosed either in the bill of complaint or the evidence, the complainants surrendered said original patent, and on 6th December, 1881, obtained Reissued Letters-Patent No. 9,957, for "preserving shrimps in metal cans." (See record, p. 10). From the specifications annexed, we learn the cause of the reissue, which was the discovery that instead of a lining of a *textile fabric* to preserve the contents from coming in contact with the can, that a lining of any kind would answer; hence, the ex-

pansion of complainants' claims, in their reissued letters, as follows: "What we claim as new, and desire to secure by Letters-Patent, is—as an improvement in the art of preserving shrimps in metal cans, the mode of preventing the discoloration of the shrimps, which consists in interposing between the metal can and the shrimps *an enveloping material* for the shrimps which is not itself capable of discoloring the shrimps, and then sealing the can and subjecting the same and its contents to a boiling process, substantially as described." (P. 13.)

We contend and submit that complainants' patents are void, for the purposes of this argument, for two reasons:

1st. The illegality of the Reissued Letters.

2d. The want of invention.

I.

In the case of Miller vs. Brass Company, 104 U. S., 350, it is held: "Where a *specific* device or combination is claimed, the non-claim of other devices or combinations apparent on the face of the specification is, in law, so far as the patentee is concerned, a dedication of them to the public, and will so be enforced, unless he, with all due diligence, surrenders his patent for reissue, and *proves* that his omission to claim them arose wholly from inadvertence, accident, or mistake. Such lapse of time as indicates his want of due diligence is fatal, and the reissue, if granted, will be void." Could any form of words better fit the case at bar? Here the complainants specifically claim a lining of a *textile fabric* in their original patent, therefore a lining of any other character or device was dedicated to the public, unless the patent was surrendered with all due diligence, &c. Complainants did business under their original patent from 1876 to 1881, five years, without applying for a reissue. Can this be called due diligence? And when they did apply for the reissue, and

surrendered their original patent, what inadvertence, accident, or mistake in the original did they allege and prove? Their bill of complaint does not specify or allege a single inadvertence, accident or mistake, and there are none even mentioned in the evidence! Certainly the lapse of five years in delaying to apply for the reissue was fatal, and the reissue having been granted, therefore was certainly void. In addition to all this, however, as we shall show hereafter, rights of the defendants had intervened between the date of the original patent, and that of the reissue.

And again, in James vs. Campbell, 104 U. S., 356, this Court says: "If letters-patent fully describe and claim a specific invention, *complete in itself*, so as not to be inoperative or invalid by reason of a defective or an insufficient specification, a reissue cannot be had for the purpose of expanding and *generalizing* the claim in order to embrace an invention not specified in the original." Complainants' letters-patent certainly fully described and claimed a specific invention which was complete in itself, that is, a lining of a *textile fabric;* it was as certainly operative and valid, for they worked under it for five years, and are still doing so, in the same manner as if they had no reissue (testimony of Dunbar, record, p. 76); and a comparison of the patents show that there was nothing defective or insufficient in the original specification; and the deduction is inevitable and apparent that the reissue was sought by complainants for the purpose of expanding and generalizing their claim. "Where it is apparent, on the *face of the patent*, or by cotemporary records, that no such inadvertence, accident, or mistake, as claimed in a reissue of it, could have occurred, an expansion of the claim cannot be allowed or sustained."—James vs. Campbell, 104 U. S., 370, 371. "In cases of reissues of patents, * * * it is imperative that the new patent, when issued, shall be for the same invention, and that *no new matter* shall be introduced into the specification."—Heald vs. Rice, 104 U. S., 748, 749.

See, also, Mathews vs. Machine Company, 105 U. S., 57; Bantz vs. Frantz, 105 U. S., 160.

In the case of Conklin vs. Stafford, Supreme Court of the District of Columbia, 5 O. G., 235, Judge McArthur says:

"It will be seen by the terms of this statute (sec. 4916, Revised Statutes U. S.), that in order to entitle a party to the reissue of a patent it is incumbent on him to show that it is inoperative or invalid by reason of a defective or insufficient specification, or that the patentee had claimed more than he had invented, and that the error had arisen by inadvertence, accident, or mistake, and without any fraudulent intention.

"Unless these circumstances exist in an appplication of this character, I can find no authority by which the Commissioner can reissue a patent.

"Therefore, if the original patent is neither inoperative nor invalid, and if no error has been occasioned by accident or mistake, then there must be a presumption of law and fact that the patentee has abandoned to the use of the public everything which he may have invented, but which he did not include in his claims and specifications."

This Court, in the case of the Giant Powder Co. vs. California Powder Works et al., 15 O. G., 289, say:

"A reissue can only be granted for the same invention which formed the subject of the original patent of which it is a reissue.

"The express words of the Statute are, 'a new patent for the same invention;' and 'no new matter shall be introduced into the specification.'

"If a party in a reissue attempts to expand the original invention, and cover what was not originally claimed in order that he may appropriate to himself what had since

been discovered and used outside of his invention by others, it will be void."

The statute embraces only the right to a reissue where, from an unintentional error in the description of the invention, the patent is wholly inoperative or invalid.

4 Fisher, 117; 7 Wallace, 685.

In the case at bar there is no pretense and can be none that the original patent was inoperative or invalid, or that there was either accident, mistake, or inadvertence in drawing the specifications or claims.

The surrender of valid patents and the granting of reissue patents thereon, with expanded or equivocal claims, where the original was clearly neither inoperative nor invalid, and whose specification is neither defective nor insufficient, is a great abuse of the privilege granted by the statute, and productive of great injury to the public.

This privilege was not given to the patentee in order that the patent may be rendered more elastic or expansive, and therefore more available for the suppression of all other inventions.

11 Wallace, 516 and 544.

1 Wallace, 577.

The doctrine laid down by the Courts in all the later cases is, that when a mistake is claimed, which is apparent upon the first inspection of the patent, if any correction is desired it should be applied for immediately.

In the case of Miller & Co. vs. The Bridgeport Brass Co., before referred to, it is held that "afterthoughts developed by the subsequent cause of improvement, and intended by an expansion of claims to sweep into one net all the appliances necessary to monopolize a profitable manufacture, are obnoxious to grave animadversion.

"Nothing but a clear mistake or inadvertence, and a speedy application for its correction, is admissible when it is sought merely to enlarge the claim.

"A claim cannot be enlarged except when an actual mistake has been made, such as a Court of Chancery would correct.

"In reference to reissues made for the purpose of enlarging the scope of the patent, the rule of laches should be strictly applied, and no one should be relieved who has slipped upon his rights, and thus led the public to rely on the implied disclaimer involved in the terms of the original patent; and when this is a matter apparent on the face of the instrument upon a mere comparison of the original patent with the reissue, it is competent for the Courts to decide whether the delay was unreasonable, and whether the reissue was, therefore, contrary to law and void."

In the case of James vs. Campbell, *et al.*, it is said that "the Court ought not to be called upon to explore the whole history of art, in order to ascertain what a patentee might have included in his patent had he been so disposed.

"If he was the author of any other invention than that which he specifically describes and claims, though he might have asked to have it patented at the same time and in the same patent, yet if he has not done so, and afterwards desires to secure it, he is bound to make a new and distinct application for that purpose, and make it the subject of a new and different patent.

"If by accident, mistake, or inadvertence the claim does not fully define the patentee's right in the invention, a speedy application for its correction, before adverse rights have accrued, may be granted."

21 O. G., 341.

In this case the reissue was obtained for the very purpose of embracing the invention now owned by the defendant, and years after the granting of the original. It must be declared void.

19 O. G., 62 and 425.

18 O. G., 1340.
7 Otto, 3 and 563.
O. G., July 17, 1883, p. 302.
3 Otto, 460.
8 Otto, 138.
1 Wallace, 531.
17 Wallace, 463.
21 O. G., 713.
9 Blatchford, 524.
2 B. & A. Patent Cases, 164.
22 O. G., 87.

A patent cannot be reissued to cover an invention *described*, but not *claimed*, in the original patent.

22 O. G., 1881.

A reissued patent is not valid for everything which might have been claimed in the original patent, nor does its validity depend wholly upon the fact that the new features attempted to be secured thereby were suggested in the models, drawings, or specifications of the original patent.

20 O. G., 1663.
93 U. S., 460.
102 U. S., 408.

In 23 O. G., 2029, the Commissioner of Patents says:

"As I understand the late decisions of the Supreme Court, when the only purpose of the reissue application is to broaden the claims, it must clearly appear that there was a mistake or error in the original preparation of the case, and that the applicant took immediate steps to have the same corrected..

"By a failure to take immediate steps towards correcting a patent, a patentee acquiesces in the terms of the grant and dedicates the invention to the public use."

Miller *et al.* vs. Bridgeport Brass Co., 11 Federal Reports, 595.

Where an application for a reissue was filed more than two years after the grant of the original patent, the Commissioner held that the application was not filed in time, although all the defects therein were distinctly pointed out and the errors accounted for.

O. G., Sept. 11, 1883, page 1089.

An unexplained delay of more than five years in applying for a reissue patent is altogether unreasonable in a case where the reissue is for the purpose of enlarging and expanding the scope of the claim.

23 O. G., 342.

If two years' public enjoyment of an invention with the consent and allowance of the inventor is evidence of abandonment and a bar to an application for a patent, a public disclaimer in the patent itself should be construed equally favorable to the public.

21 O. G., 201.

The granting a reissue for an enlargement after an unreasonable delay, even in case of a mistake, is clearly an abuse of the power to grant reissues, and may justly be declared illegal and void.

Again, in the case of Russell vs. Dodge, 93 U. S., p. 464, our very case is foreseen: "Judged by that law * * * there can be no doubt of the invalidity of the reissue. The original patent was not inoperative or invalid from any defective or insufficient specification. The description given of the process claimed was, as stated by the patentee, full, clear, and exact, and *the claim covered the specification;* the one corresponded with the other. The change made in the old specification by eliminating the necessity of using the fat liquor in a heated condition, and making in the new specification its use in that condition a mere matter of convenience, and the insertion of an

independent claim for the use of fat liquor in the treatment of leather generally, operated to enlarge the character and scope of the invention. The *evident object* of the patentee in seeking a reissue was not to correct any defects in specification or claim, but to *change both*, and thus obtain, in fact, a patent for a different invention. This result, the law, as we have seen, does not permit.".

Now, if we substitute in the above paragraph the words "textile fabric" for "fat liquor in a heated condition," and "enveloping material" for the words "fat liquor," the decision applies quite as well to the case at bar as to that decided. "The danger to be provided against was the temptation to amend a patent so as to cover improvements which might have come into use, or might have been invented by others after its issue."

Powder Comp'y vs. Powder Works, 98 U. S., 138.

But complainants make an effort to defend here by saying that their original patent is good enough for their purposes without the aid of their reissue, and that the use by defendants of paper to envelop the shrimps is a mere equivalent for their patented "*textile fabric*," and, therefore, an infringement of the original patent; but they allege in their bill, (p. 2), that they have *surrendered* their original letters-patent; hence they no longer belong to the complainants, and they cannot claim anything under what does not belong to them; and complainants in their bill, do not claim any rights under the original and surrendered letters-patent, but only under the *reissue*.

It was held in Moffitt vs. Garr, 1 Black, 283, that "A surrender of the patent to the Commissioner, within the sense of the provision, means an act, which, in judgment of law, extinguishes the patent. It is a *legal cancellation of it*, and hence can no more be the foundation for the assertion of a right after the surrender, than could an act of Congress which has been repealed."

And again: "The plaintiff, by a surrender of that patent, and the procurement of the patent of 1849, with amended specifications, abandoned his first patent and relied wholly on the one reissued."

Battin vs. Taggart, 17 Howard, 84.

From all which we take it, that if one deliberately surrenders his patent and obtains a reissue, he must stand upon that reissue, and if it be decreed illegally issued and therefore void, he has no patent, and must go out of Court; any other deduction would have the effect of offering a premium for efforts to evade the Statute.

But, suppose we are wrong in this, then we say that our substitution of paper for "*textile fabric*" is not the use of an equivalent; that by limiting their claim to the use of a "textile fabric," complainants left open the use of all other enveloping materials to the whole world.

In Aiken vs. Bemis, 3 Woodb. & Minot, 354, Judge Woodbury held: "That the patent extended only to the form or parts of the saw-set, combined as set out, and made of any kind of materials, or saying nothing as to the materials, the right would be violated by a machine of like form, as the form would be the sole matter patented. But when the patentee choses to go further, and cover with his patent the material of which a part of his machine is composed, he entirely endangers his right to prosecute when a different and inferior material is employed."

And in Harris vs. Allen, Judge Blodgett held: "The patent in question—an improvement in spring bed bottoms—construed and held to be limited to a *wooden frame*, and as defendants used an *iron frame*, there was no infringement."

15 Chicago Legal News, 174.

In this connection we may notice an objection to our argument made by the defendants to the effect that in all the recent cases in which were rendered decisions of this Court voiding reissued patents, there was more of an expansion than in the case at bar; we will rapidly review these decisions, presuming here that the expansion made by the reissued patent of complainants was from a "*textile fabric lining*" to an "*enveloping material.*"

In Miller vs. Brass Company the original was for a lamp with a double dome without a chimney; the reissue was for a single dome with a chimney.—104 U. S., 351.

In James vs. Campbell, the original among other things was for a post-office stamp, the cancelling device of which was "wood, cork or *similar* material," while the reissue was for cork, wood or other *suitable* material.—104 U. S, 361, 373.

In Russell vs. Dodge the original was for the use of *heated* fat liquor in treating *bark-tanned lamb or sheepskin*," the reissue was for the use of *fat liquor* (the word "heated" omitted) in the treatment of leather generally.—93 U. S., 460; 98 U. S., 126; 104 U. S., 748; 105 U. S., 57, 160.

In Searls vs. Benton the original letters were for a whip-socket having a bell-shaped top, the reissue was for whip-sockets generally, without any limitation as to the form of the top.—12 Fed. Rep., 874.

In Giant Powder Co. vs. Cal. Vigorit Powder Co. the original was for a compound of an *inexplosive* porous substance with nitro-glycerine; the reissue was for a compound of all porous substances, whether *explosive* or *inexplosive*, with nitro-glycerine.—6 Sawyer, 509.

There is, however, a still graver reason why the reissued letters-patent of the complainants should be decreed to be

invalid, and that is because the rights of other parties intervened before the reissue was applied for. The complainants never discovered that any "enveloping material" would answer in the place of their "textile fabric," therefore they obtained the expanded claim in their reissue for something which was the invention of another; because on the 13th of August, 1879, nearly two years before complainants made application for their reissue (April 9th, 1881) one of the defendants made application for a patent for "a new and useful improvement in canning shrimps, and other fish," and on the 6th of April, 1880, Letters-Patent No. 226,347 were issued to him (record p. 50); in the specifications annexed to the application for said patent the following declaration was made, showing that the attention of the officers of the Patent Office was called to the patent of the complainants, when defendants' patent was applied for:

"Heretofore it has been the practice in canning shrimps and like shell-fish to enclose the fish in a bag made of some textile fabric, to place the bag containing the fish within an ordinary tin can, and then to subject the can and its contents to the ordinary boiling and modes of treatment such as are ordinarily used in canning vegetable and animal substances" (p. 52); and the invention of the defendants is therein then described to be: "Instead of the ordinary bag of *textile material* which has heretofore been used to inclose the shrimps, *we* have found that a cheaper and better substitute may be made from *paper*," * * * "this paper lining being much more cheaply and expeditiously applied than the cloth bags heretofore used, as no sewing is required" (p. 52); and thereupon they claimed and were allowed by their patent, "an interior paper lining prepared with paraffine, as used for the purposes set forth" (p. 53).

There can be no doubt, from an examination of this

patent, that this, and this only, was the inducement which led the complainants nearly two years after to apply for a reissue that they wilfully and contemplatively asked for with a view to stop and hinder these defendants from the prosecution of their business by means of this suit.

But this cannot be tolerated by the law; it is the very case this Court had in view when it said, in Powder Company vs. Powder Works: "*The danger to be provided against was the temptation to amend a patent so as to cover improvements which might have come into use or might have been invented by others after its issue.*"—98 U. S., 138.

And in the case of Miller vs. Brass Company such an abuse of the privilege of applying for reissued letters-patent is thus denounced: "It will not do for the patentee to wait until other inventors have produced new forms of improvement, and then, with the new light thus acquired, under pretense of inadvertence and mistake, apply for such an enlargement of his claim as to make it embrace these new forms. Such process of expansion carried on indefinitely, without regard to lapse of time, would operate most unjustly against the public, and is totally unauthorized by the law. In such a case, even he who has rights, and sleeps upon them, justly looses them."—104 U. S., foot of p. 355.

II.

The patent is void for the want of invention.

What is the so-called invention? Simply the wrapping of something up in something before putting it in a box, for the purpose of keeping the first article from coming into contact with the box. Can that be called a new device? Is it not as old as boxes, as old as the act of putting things in boxes? The enveloping of tea in lead before putting it into its wooden box, to preserve the flavor of the

tea; the enveloping of winter clothes and furs in paper and various materials before consigning them to the familiar cedar chest for the summer, and a thousand other quite as familiar illustrations, show that there is no novelty or invention in complainants' device, and therefore they cannot legally appropriate it to themselves under the protection of a patent.

In the very familiar case of the Rubber-Tip Pencil Company vs. Howard there was a useful combination which conferred a benefit which the whole commercial world has availed itself of; but this Court held that it was no invention to force the end of a wooden pencil into a small hole made in a piece of rubber, and refused to sustain the patent, saying:

"Though an *idea* of a person, who afterwards obtains a patent for a device to give his idea effect, *may be a good idea*, yet, if the device is not new, his patent is void, even though it be useful."—20 Wallace, 498.

"The application of an old process to a new subject without any exercise of the inventive faculty, and without the development of any idea which can be deemed new or original in the sense of the patent laws, is not the subject of a patent."

Brown vs. Piper, 91 U. S., 37.

"The thing was within the circle of what was well known before, and belonged to the public. No one could lawfully appropriate it to himself and exclude others from using it in any usual way for any purpose to which it may be desired to apply it. This is fatal to the patent."

Brown vs. Piper, 91 U. S., 41.

"It requires no commentary to establish that the application of an old thing to a new use without any other invention is not a patentable contrivance."

Ames vs. Harner, 1 Sumner, 487.

"It is precisely the same as if a coffee-mill were now, for the first time, used to grind corn. The application of an old process to manufacture an article to which it had never before been applied is not a patentable invention. There must be some new process or some new machinery used to produce the result."

Howe vs. Abbott, 2 Story, 194.

"If it is old and well-known, and applied only to a new purpose, that does not make it patentable."

Bean vs. Smallwood, 2 Story, 411.
Winans vs. Boston R. R. Co., 2 Story, 412.

"We cannot fail to take judicial notice that the thing patented was known and in general use long before the issuing of the patent."

Terhune vs. Philips, 99 U. S., 593.

The disclaimer of the complainants of any invention contained in their reissued letters-patent, except for the "*enveloping material*," will be found in the testimony of George H. Dunbar (record, foot of page 74 and top of page 75, and the admission as to the testimony of F. B. Dunbar, at top of page 79).

By reference to the opinion of the judge who tried the case in the lower Court (record, p. 97), and which is a sufficient statement of facts for all the purposes of this motion, it will be seen that he states as the *sole question in this case* as follows: "In a case where the plaintiff's right to recover against the defendant would have been perfect under an original patent, can a surrender and a reissue invalidate that right?" And he answers that question in the negative. With all respect, we urge that his error is manifest, and that if the patentee has endeavored to illegally avail himself of the benefits of a provision in the patent law by obtaining a reissue to which he was not entitled, that reissue is stricken

with nullity, and his surrendered patent does not revive in his favor. Having made his choice, he must abide by it. He is left in possession of a void reissue, and his original has been surrendered. What rights can he enforce under either? The recent decisions of this Court have been rendered in vain if the proposition we have quoted can be sustained.

See Moffat vs. Garr, 1 Black, 283.
Battin vs. Taggart, 17 Howard, 84.

Under these circumstances, which must lead to the conclusion that when this Court reaches this case upon its docket it will declare the reissued letters-patent of the complainants illegally issued, and null and void, it seems to us that the provisions of Rule 30 should equitably be applied, and that the injunction should be released pending the appeal with or without bond, as your Honors may determine.

All of which is respectfully submitted.

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Of Counsel.

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Supreme Court of the United States.

No. 924, October Term, 1883.

T. T. WHITE, et als., Appellants,
vs.
GEORGE H. DUNBAR, et als., Appellees.

Appeal from the Circuit Court of the United States for the Eastern District of Louisiana.

BRIEF of Appellees upon the Application of Appellants to modify Injunction under Rule 30.

MELVILLE CHURCH,
Solicitor and of Counsel for Appellees.

WASHINGTON, D. C.
R. BERESFORD, PRINTER, 523 SEVENTH STREET.
1883.

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Brief of Appellees upon the Application of Appellants to modify Injunction under Rule 30.

The statement of facts upon which this application is based is comprehended in the first, second, third, fifth and sixth paragraphs of the statement printed by Appellants, in the opinion of Judge Billings, rendered in the court below, giving his reasons for granting the injunction in the Dunbar original and reissued patents of Appellees, and in the Pecor and Bartlett patent of Appellants.

The fourth paragraph of the statement printed by Appellants was not agreed to by counsel for Appellees nor adopted by Judge Billings, and should therefore be laid out of view.

Upon consideration of all the documents which go to make up the statement, it appears:

1. That Appellees were owners of Letters Patent. No. 178,916, issued June 20th, 1876, for a Method of Preserving Shrimps and other Shell Fish.

2. That on the 6th of December, 1881, they surrendered said original patent and obtained therefor reissued letters patent No. 9,957, dated said 6th day of December, 1881.

3. That Appellants were sued for infringement of the said reissued patent and defended.

4. That upon a preliminary hearing the court ordered an injunction, but subsequently modified its order by allowing Appellants to continue their business upon condition that they filed in court a monthly account of their manufactures and sales.

5. That upon final hearing the court found against the Appellants, on all the points presented by them, and found unqualifiedly that the said original and reissued patents were valid; that they covered a novel invention; that the reissued patent claimed the same invention as that claimed in the original patent; that the reissue was legal and legally issued, and that the Appellants infringed the reissued patent by practicing the process patented thereby.

6. That the court issued a perpetual injunction restraining the Appellants from further continuing their business in packing shrimp in accordance with Appellees' patented invention, and referred the case to a master.

7. That the master reported in favor of the Appellees for $1,205.98, and judgment was entered against Appellants for that amount, and they appealed.

The first, and in our opinion, the only question to be decided by this court, at this time is, Does this showing present a case such as the rule was designed to meet? It will be observed that the court below held, unqualifiedly, that the invention secured to Appellees was novel and useful; that the reissued patent is valid and claims the same inven-

tion as the original claimed, and that the Appellants do infringe the claim of the reissue and would have infringed the claim of the original.

There does not appear to have been the slightest doubt in the mind of the court on these points.

On the questions of novelty, utility and validity the presumptions are, from the outset, all in favor of the patentees, and these presumptions are strengthened, if indeed the facts are not to be deemed established, at least for the purposes of such an application as this, when a court of competent jurisdiction has passed affirmatively upon them as in the present case. So, too, on the question of infringement, the presumptions in this court are all in favor of a patentee after an affirmative judgment below, that is, the judgment below will be followed unless shown to be clearly erroneous.

We do not regard the rule as meaning that in *every case* where an injunction is issued below and an appeal taken this court will, upon application, vacate or modify the injunction order, for that would be contrary to all principle. It must appear that there was some doubt in the mind of the court below as to the propriety of issuing the injunction, or there must be shown some other strong equity demanding the intervention of this court.

The statute (Sec. 4,921) gave the court below express power to grant the injunction, and unless it plainly appears that it erred in the matter of law, its decision should not be disturbed.

"The appellate or revisory tribunal will not interfere "with or control the action of the court below in such mat- "ters, unless it has been guilty of a clear abuse of discretion, "and by abuse of discretion within the meaning of the rule "is meant an error in law committed by the court. Unless, "therefore, some established rule of law or principle of "equity has been violated the action of the court below will "not be interfered with upon such an appeal.

"High on Injunction, Vol. II, p. 1,069."

We believe this is but the third time an application has been made under this rule. The rule itself was adopted to meet the first case; in the second, the application was abandoned before submission.

The first case referred to was the *Sandusky Seat Company vs. Theodore Comstock, et al.* In the statement of facts submitted in that case it appeared that in the opinion of the court below, as set forth in 13 O. G., 230, (S. C. 3, Bann & Ard, 190,) the court expressed grave doubts as to the validity of Appellees' patent in the following language: "We are in "some doubt as to the point whether the invention is not, "in substance only the substitution of one material for "another—iron for wood—and whether, hence, there is not "a want of patentability. (Hotchkiss *vs.* Greenwood, 11 "How., 248.) This defense is not set up in the answer, as "it should have been, but possibly the bill shows no equity "on its face, and perhaps the facts are such that the court "can take judicial notice of them, (Brown *vs.* Piper, 1 Otto, "37.) But in view of the decision in Smith *vs.* Goodyear, "3 Otto, 486, we are inclined to think we ought to overrule "this objection and leave the respondents to raise the ques- "tion, if they think proper to do so, in the Supreme Court, "by appeal."

In acting upon the application this court vacated the injunction, but required appellants to give bond in the sum of $25,000, and to file in the court below a monthly account of manufactures and sales.

Here, then, we find in the very case which gave origin to the rule that there was doubt in the mind of the court below on a point going directly to the validity of the patent, and which the court said it would leave for this court to pass upon.

Upon such a presentation, it seems to us, this court was justified in substituting a bond for the injunction and in announcing a rule applicable to *like* cases in future.

But the difference between that case and the one at bar is radical and all important. There the court below expressed

a doubt as to the validity of the patent sued upon; here the court below was in no doubt, and unqualifiedly found the patent valid and the Appellants' process a clear infringement. There the Appellants had honestly embarked a large capital in their business and were manufacturing on a large scale, and, in view of the doubt expressed by the court as to the validity of the patent sued upon, a case calling for the interposition of this court was clearly made out; here it appears the Appellants, observing the value of Appellee's process—which had been continuously used by the latter since 1876—made a wanton and deliberate attempt to appropriate such process, and even patented a so-called improvement, to give them a color of right to practice the same. Here, again, the statement shows that the sum due for the infringement extending over a period of more than a year and a half amounts to only $1,205.98 or less than $800 a year, and consequently the possible injury to Appellants by a delay till final hearing of this cause on merits will be small as compared with the manifest inestimable and irreparable damage and injury which will result to Appellees if this court shall cast a cloud upon Appellees' patent by a modification or suspension of the injunction without any sufficient ground being shown by Appellants why the relief they pray for should be granted, without examining the evidence adduced in the cause, without inquiry as to the prior state of the art and the value of the patented process, and without the benefit of an oral hearing and the full presentation of the case by counsel for the respective parties.

In the present case no money recovery would indemnify the Appellees for the Appellants' unrestrained doings pending the appeal on its merits, as the raising of the injunction under the circumstances would make infringers bold and Appellees would be harassed with the necessity of bringing countless suits, besides being irreparably damaged in their business.

The presumption and probabilities are that the decree of the court is right, and between two possible evils it is better

to incur the risk of that which is least expected. (Walker on Patents, p. 478.)

AS TO THE VALIDITY OF THE REISSUE.

Appellants in their brief contend, in effect, as they did in the court below, (1) that Appellees' reissued patent is illegal and void, and (2) that it does not cover a patentable invention.

From the necessarily limited scope of the present inquiry the validity of the reissue can only be determined, if at all, by a comparison of the face of the two instruments themselves, that is, the original with the reissue.

It may not be regarded as yet *settled* whether or not, the granting of a reissue by the Commissioner of Patents concludes the inquiry into the question as to whether any statutory ground for the reissue existed, in an infringement suit, though the weight of authority is on the affirmative side of the proposition, as will be seen from an examination of the following cases:

R. R. Co. *vs.* Stimpson, 14 Pet., 448. Story, J.
Stimpson *vs.* R. R. Co., 4 How., 404. McLean, J.
Seymour *vs.* Osborne, 11 Wall., 516. Clifford, J.
Collar Co. *vs.* Van Dusen, 23 Wall., 558. Clifford, J.
Ball *vs.* Langles, 102 U. S., 129. Strong, J.

The presumption of rightful action on the part of the Commissioner undoubtedly exists, as all the authorities, to this extent, at least, agree.

But it is immaterial in the present case whether or not the Commissioner's act in granting the reissue be considered conclusive, and unnecessary to invoke any presumption in favor of the correctness and legality of his action, as a comparison of the original and reissued instruments will show the reissue to have been proper.

The statute regulating reissues (Sec. 4,916,) provides that

a reissued patent may be granted for the *same invention* where the specification of the original is "defective or insufficient." In order to show what insufficiency existed in the original here involved it will be necessary to thoroughly understand what the invention disclosed in that patent was.

The object of the invention as set forth in the original patent was "to provide an improved method of preserving "shrimps or prawns and, indeed, all kinds of shell fish pre- "venting their discoloration and insuring their original fresh- "ness and flavor." It was found that shell fish generally, and shrimps in particular, could not be preserved in ordinary metal cans because of the profuse precipitation of a black substance believed to be due to the presence of sulphur resulting from contact of the shrimp with the metal of the can and which precipitation not only discolored the shrimps but detracted from the freshness and richness of their flavor.

The patentees' improvement contemplated the "so placing "a suitable textile fabric between the fish or other article "of food to be preserved as to cause it to so intervene as to "prevent under all circumstances any direct contact between "the metallic surface of the can and its contents," and it was, in the language of the patent, "the employment of "such textile fabric in connection with the process herein- "after described of treating the fish or other article both "before and after the same is placed in the can and sealed," which constituted the nature or subject matter of their invention.

The patentees said that "material of the cheapest and "most inferior quality may be used" for the bag of textile fabric, "as *the sole object of its use is to prevent the article to be "preserved from coming in direct contact with the surface of the "can.*"

The original patent claimed "the herein described method "of preserving shrimps, &c., preventing their discoloration, "which consists in placing textile fabric between the can "and its contents, and then sealing the can and subjecting

"the same to a boiling process, substantially as and for the "purpose specified."

Now, it was necessary, for the effectual carrying out of the method or process, that there should be no liquid or gravy placed in the bag with the shrimps, for if a porous bag, or a bag from any cause not perfectly tight, were used, and free liquid or gravy were placed within it with the shrimps, the liquid would pass through the bag and form a medium of direct communication between the shrimps and the metal of the can, and thus defeat the result desired to be accomplished by the employment of the bag.

The only reference in the original patent to the desirability of their being no free liquid with the shrimps was as follows: "In a moist condition they are placed in the sack "B, the same having been previously arranged in the can "A, and without the addition of any salted or otherwise "prepared liquid." This was not considered a full enough description, though it conveyed the idea, and it was deemed important to amend the specification so as to bring out the point clearly and making it appear that the presence of free gravy was not only not desirable, but absolutely detrimental.

Accordingly the reissue was applied for, and this part of the process more clearly brought out in the following language:

We quote from the specification of the reissue.

"In canning the shrimps or prawns we have found that direct contact of the shrimps with the can and the presence of free liquid or gravy in the shrimps, after they are placed in the can, are very objectionable for the following reasons:

"First. The direct contact of the shrimps with the can causes, during the process of cooking and thereafter, a precipitation of black or dark matter which discolors the shrimps and detracts from their flavor and richness. This precipitation is believed to be caused by the action of sulphur contained in the shrimps on the metal of the can.

"Second. Free liquid or gravy in the shrimps constitutes a vehicle or medium to diffuse the dark precipitate or coloring matter throughout the entire mass of shrimps in the

can, so that all portions of the contents of the can are equally affected and discolored.

"Our invention has for its object to obviate the above named objections, and it consists in first providing the can with a lining to prevent direct contact of the shrimps with the metal; and, second placing the shrimps in the lined can while they are in a dry or moist condition and devoid of free liquid or gravy, sealing the can without adding any liquid to its contents, and cooking the contents of the can after sealing, all of which we will now proceed to describe."

This was but a restatement of the idea conveyed by the original and contained no new substantive matter.

In reclaiming their invention in the reissue the patentees did not use the exact language of the claim of the original patent, but employed words not differing at all therefrom in import and legal effect, words such as the Patent Office permitted or required them to use in compliance with the terms of the statute, (Sec. 4,916,) which provides that "the "specifications and claim in every such case shall be subject "to revision and restriction in the same manner as original "applications are."

Said reissued claim was as follows:

"As an improvement in the art of preserving shrimps in metal cans, the mode of preventing the discoloration of the shrimps, which consists in interposing between the metal can and the shrimp an enveloping material for the shrimp which is not itself capable of discoloring the shrimps, and then sealing the can and subjecting the same and its contents to a boiling process, substantially as described.

There can be no question but that the process or mode of preserving shrimps detailed in one claim is the same as that detailed in the other. In each the process is declared to be for the purpose of preventing discoloration of the shrimps; in each the interposition of the material between the metal of the can and the shrimp is called for, and in each the can after being sealed is required to be subjected to a boiling process. The only difference in words even is that while

the original says "placing textile fabric between the can "and its contents," "substantially as and for the purpose set "forth," the reissued claim says "interposing between the "metal can and the shrimp an enveloping material for the "shrimps which is not itself capable of discoloring the "shrimps," "substantially as described." In both cases we are referred back to the specification, and looking there we find that only "textile fabric" is mentioned as the material for the envelope or separating medium.

It is not contented by Appellees that the reissued claim is any broader or of more comprehensive scope than the claim of the original.

Though couched in a different form of words each is co-extensive with the other.

Speaking of the textile fabric, the original patent states that "the sole object of its use is to prevent the article to "be preserved from coming in direct contact with the sur-"face of the can." The textile lining was not claimed *per se*, but only as a single instrumentality employed in carrying out the described process and having for "the sole object "of its use" to prevent the article from touching the can. Any other material than textile fabric which would perform the function ascribed to the latter in working the process is in law an equivalent of it.

Tilghman *vs.* Proctor, 102 U. S., 730.
Mowry *vs.* Whitney, 14 Wall., 620.
O'Reilly *vs.* Morse, 15 How., 62.
Imhaeuser *vs.* Buerk, 97 U. S., 562.

It was not necessary for the patentee to claim equivalents in his claim, (Dental Vulcanite Co. *vs.* Davis, 102 U. S., 229; Tilghman *vs.* Proctor, 102 U. S., 730,) nor to describe them in his specification (Union Metallic Cartridge Co. *vs.* U. S. Cartridge Co., 2 Bann. and Ard., 594.) He was equally protected in the use of equivalents, whether he omitted to do either or both of these things. The doctrine of equivalents can always be invoked where a new pro-

cess carried out by old instrumentalities is involved. To borrow an illustration from another branch of the law, it is a "covenant running with the land."

The use of the words "textile fabrics," therefore, in the claim of the original patent meant the same, no more, no less, than would have the words "textile fabric or any equiv-"alent thereof;" and on the other hand, the use of the words "enveloping material" in the claim of the reissue taken in connection with the words "substantially as described," meant the same as "textile fabric or any equivalent there-"of."

The court below found the two claims to be for the same invention, the only difference between them being, to use the language of the court, "that of substituting the descrip-"tion of a thing by naming it with the addition of its essen-"tial quality, the description of a thing by naming its "qualities."

The first fourteen pages of Appellants' brief is devoted to a discussion of a phase or phases of the law of reissue which have no application to the case at bar.

We are aware, and the court below was aware, of the many decisions of this tribunal holding that a claim in a reissue not found in the original is invalid and void; also, that there can be no infringement of a reissued patent where the claim of the original patent did not, and the claim of the reissue does, cover the defendant's machine or process; but we are yet to be pointed to an authoritative case wherein it is held that a valid claim made in the original and distinctly repeated in a reissue will invalidate the latter.

As a matter of fact this court and the various circuit courts have always held to the contrary.

Powder Co. *vs.* Powder Works, 8 Otto, 138. Field, J.
Gage *vs.* Herring, 23 O. G., 2,119. Gray, J.
Brainerd *vs.* Cramme, 22 O. G., 769. Wallace, J.
Tyler *vs.* Galloway, 22 O. G., 2,072. Shipman, J.

Tyler *vs.* Welch, 3 Fed. Rep.
Schillinger *vs.* Greenway Brewing Co., 17 Fed. Rep., 244. Blatchford, J.
Fetter *vs.* Newbold, 25 O. G., 502.
Cote *vs.* Moffitt, 15 Fed. Rep., 345. Gray, J.
Gould *vs.* Spicer, 15 Fed. Rep., 344. Gray, J.
Gold and Stock Telegraph Co. *vs.* Wiley, 17 Fed. Rep. Shipman, J.
Wood *et al. vs.* Packer, 17 Fed. Rep., 650. Nixon, J.
National Pump Cylinder Co. *vs.* Gunnison, 17 Fed. Rep., 812.

The above cases also hold that the claim of a reissue should be construed, if possible, to be for the same invention as the original claim if that be necessary to save the patent. Such being the law, will this court upon an interlocutory motion of this kind undertake to change the law?

In the case at bar the court below decided the reissue claim to be for the same invention as that claimed originally, and also that the Appellants infringed as well one claim as the other, and therefore should be enjoined.

AS TO THE NOVELTY OF THE PATENTEE'S INVENTION.

The Appellants in their brief raise the question of novelty, but while we do not think for a moment this court will pass upon or even consider that question at this time, we cannot entirely ignore it since the Appellants have seen fit to discuss it. In the first place, aside from the presumption of novelty arising from the grant of the original and reissued patents and of the affirmative decision of that question by the court below, this court will not, we believe, undertake to decide upon the matter from a mere inspection of such papers as are now properly before it on this application.

The novelty or utility of the invention cannot be determined without a careful review of the state of the art as dis-

closed by the whole record, and this we do not presume the court at this time will do, though if it should, we are confident the interests of Appellees would not be at all prejudiced or jeopardized thereby.

The attempt of Appellants' counsel to convey the impression that the invention patented to Appellees consists in "simply wrapping up something in something before put-"ting it in a box, for the purpose of keeping the first article "from coming in contact with the box," indicates either that they wish purposely to mislead this court as to what the invention actually is, or that they themselves have not yet really comprehended it—a state of things in either view much to be deplored.

But a clear idea of what the invention is can fortunately be gathered from the patents themselves. Things have been wrapped up in something and put in a box time out of mind, and the familiar illustrations given by counsel for Appellants are such, no doubt, as this court can take judicial notice of.

Such, however, is not the invention of Appellees.

They observed that shrimp could not be preserved in marketable shape in metal cans by the old processes, because of their discoloration and loss of freshness. They made the discovery—for it is more in the nature of a discovery than an invention—that by placing the shrimps in a metal can with a material interposed so as to prevent actual contact of the shrimp with the metal surface of the can, and by then sealing the can and boiling it the shrimps might be preserved in ordinary metal cans, free from discoloration and in purity and freshness for a very long period, thus rendering it practicable to economically prepare for shipment and storage at a cost within the reach of all, an article of food much prized, but which, before their invention or discovery, could only be obtained in presentable form at points remote from the place of shipment at great expense.

The good housewife might have put up her jellies in jars of glass or wood with an interposing medium of paper to

prevent "sticking" from earliest antiquity, but the problem of preserving shrimps in metal cans would have remained unsolved. So too, the familiar cedar chest might have been opened and closed to receive and release the paper wrapped clothes and furs till it wore out without advancing that art.

The mistake occurs in confounding Appellants' claim to the improvement in the art of preserving shrimp, with a claim for the use of a lining generally. The claim is not, broadly, for a lining or for the use of a lining; but is limited to an improvement in a particular art, consisting in a method or process wherein the application of a lining material to a metal can for a particular purpose is but one step or factor in a series of steps going to make up the whole process.

It comes with very bad grace from Appellants to contend that Appellees' process does not involve invention when they have at great pains and expense obtained a patent on a *can*, not on a process, designed for use in practicing Appellees' process, such can, however, employing a material for performing the interposing function consisting of paper instead of textile fabric—a change so colorable, a deviation so trifling, as to not demand the slightest stretch of the doctrine of equivalents to enable the court below to pronounce it the baldest kind of infringement.

We feel satisfied that this court in considering the statement of facts offered to it will find no ground for modifying the injunction order of the court below, but will let it stand. Also, that if it inquires into the questions of novelty, validity and infringement, which we do not believe it will upon this interlocutory application, it will confirm the affirmative finding of the court below.

Respectfully submitted,

MELVILLE CHURCH,
Solicitor and of Counsel for Appellees.

Supreme Court of the United States.

T. T. WHITE ET ALS., *Appellants*,
vs.
GEORGE H. DUNBAR ET ALS., *Appellees.*

No. 924.
October Term, 1883.

BRIEF IN BEHALF OF APPELLEES.

This is a suit in equity brought in the Circuit Court for the Eastern District of Louisiana, on reissued letters patent No. 9,957, granted to James F. Emerson as administrator of George W. Dunbar, deceased, and George H. Dunbar and Francis B. Dunbar, December 6, 1881, for improvements in the art of preserving shrimps in metal cans, the original patent No. 178,916 having been granted to the said George W. and George H. and Francis B. Dunbar June 20th, 1876.

The defences set up in the answer are want of novelty, invalidity of the reissue and non-infringement.

The court below found the invention new and useful, the reissue valid, and that the defendants infringed and issued an injunction, and ordered an accounting (Record, p. 98). The Master reported the sum of $1,205.98 due the complainants, with interest, and his report was confirmed and the decree made final (Record, p. 103).

From this decree the present appeal is taken.

THE INVENTION.

The invention covered by the patent in suit is one of great utility and value. By means of it shrimps, an article of

food much prized, were for the first time enabled to be successfully preserved in metal cans in such condition as to render them merchantable and an article of commerce. This is abundantly proven in the record, (G. H. Dunbar, p. 17; Tournè, p. 19; Gelpi, pp. 20 and 23; Meader, pp. 21, 79, 82;) and not attempted anywhere to be denied. It is a fact of the greatest importance and should constantly be kept in view in treating this case.

In order that the invention may be thoroughly understood and that comparison may be conveniently made between the original and reissued patents, the specifications of said patents are given below in full in parallel columns, the portions of each not found in the other being printed in italics.

Original.

To all whom it may concern:

Be it known that *we*, GEORGE W. DUNBAR, GEORGE H. DUNBAR, and FRANCIS B. DUNBAR, residents of the city of New Orleans, and State of Louisiana, *have invented* a certain new and useful Improvement *in Linings for Cans;* and we do hereby declare the following to be a full, clear and correct description of the same, reference being had to the annexed drawing, making a part of this specification.

The object of our present invention is to provide an improved method of preserving shrimps or prawns, and indeed all kinds of shell-fish, preventing their discoloration, and insuring the retention of their original freshness and flavor.

Primarily, our improvement consists in so placing a suitable textile fabric between the fish or other article of food to be preserved as to cause it to so intervene as to prevent, under all circumstances, any direct contact between the metallic surface of the can and its contents; and it is the employment of such textile fabric in connection with the process

Reissue.

To all whom it may concern:

Be it known that GEORGE W. DUNBAR, GEORGE H. DUNBAR, and FRANCIS B. DUNBAR, residents of the city of New Orleans and State of Louisiana, *did, during the lifetime of said George W. Dunbar, invent* a certain new and useful improvement in *Methods of Preserving Shrimps in Metal Cans;* and we do hereby declare the following to be a full, clear, and correct description of the same, reference being had to the annexed drawings, making a part of this specification.

The object of our present invention is to provide an improved method of preserving shrimps or prawns, and, indeed, all kinds of shell-fish, preventing their discoloration and insuring the retention of their original freshness and flavor.

In canning the shrimps or prawns we have found that direct contact of the shrimps with the can and the presence of free liquid or gravy in the shrimps, after they are placed in the can, are very objectionable for the following reasons:

First. The direct contact of the

hereinafter described of treating the fish or other article, both before and after the same is placed in the can and sealed, which constitutes the nature or subject-matter of our present invention.

In the accompanying drawing is illustrated, at Figure 1, a metallic can, such as is ordinarily used for articles of food which are offered to the trade in a canned state. Fig. 2 is a *textile* lining which we propose usually to make (*although there is nothing arbitrary about the form, as other forms may be used*) in the form of a cylindrical bag or sack, the diameter of which, when filled, is to be such as will permit of its fitting snugly within the can.

A is the metallic can; *a*, its lid or cover. B is the *bag or sack*, constructed of cotton, muslin, *or any other suitable textile fabric.* Material of the cheapest and most inferior quality may be used, as the sole object of its use is to prevent the article to be preserved from coming in direct contact with the surface of the can, and which contact with the metal, in the case of the shrimp, causes, during the process of boiling, and all along thereafter until the can is opened, a profuse precipitation of a black substance, generally believed to be sulphur, and which supposition is based upon the fact that the shrimp is said to possess a much larger proportion of sulphur than other shell-fish. *The substance thus precipitated not only discolors the fish, (shrimp,) but detracts much from the color, freshness, and richness of its flavor. Now, practical experience has fully demonstrated the fact that by using a textile fabric, as described, the precipitation of the substance alluded to is prevented, or at least does not appear either on the fabric or metal, and hence the value and importance of this feature of our invention. b*, Fig. 3, is a circular piece cut out *shrimps with the can causes, during the process of cooking and thereafter, a precipitation of black or dark matter which discolors the shrimps and detracts from their flavor and richness. This precipitation is believed to be caused by the action of sulphur contained in the shrimps on the metal of the can.*

Second. Free liquid or gravy in the shrimps constitutes a vehicle or medium to diffuse the dark precipitate or coloring matter throughout the entire mass of shrimps in the can, so that all portions of the contents of the can are equally affected and discolored.

Our invention has for its object to obviate the above-named objections; and it consists in first providing the can with a lining to prevent direct contact of the shrimps with the metal, and, second, placing the shrimps in the lined can while they are in a dry or moist condition and devoid of free liquid or gravy, sealing the can without adding any liquid to its contents, and cooking the contents of the can after sealing, all of which we will now proceed to describe.

Such a can and lining as herein described are admirably adapted for the purpose attained by our present invention; but, as before stated, there is nothing arbitrary about the peculiar form and construction of the textile-fabric lining, as other forms and arrangements might be substituted therefor without in any manner altering the principle of the invention.

In canning the shrimps we employ the following process: The shell having been removed from the shrimp in the usual manner, the fish is thrown into salt water of about six degrees, and there remains for an hour, (more or less,) and from thence to kettles filled with water and brought to a boiling heat, after which they are placed on drippers and cooled and thoroughly rinsed with fresh, cold water, from which, so soon as

of material similar to that of which the bag B is made, and which is inserted within the mouth of the latter after the same is filled with the fish or other article to be preserved.

Such a can and lining as herein described are admirably adapted for the purpose attained by our present invention; but, as before stated, there is nothing arbitrary about the peculiar form and construction of the textile fabric lining, as other forms and arrangements might be substituted therefor without in any manner altering the principle of the invention.

Having now fully described, as it were, the mechanical features of the invention, we will briefly state the process employed in connection therewith, especially when shrimps are the articles to be preserved.

The shell having been removed from the shrimp in the usual manner, the fish is thrown into salt water of about six degrees, and there remains for an hour, more or less, and from thence to kettles filled with water, and brought to a boiling heat, after which they are placed on drippers and cooled, and thoroughly rinsed with fresh cold water, and from which, so soon *as thoroughly dripped, in a moist condition*, they are placed in the sack B, the same having been previously arranged in the can A, *and without the addition of any salted or otherwise prepared liquid.* So soon as the sack is filled, the mouth thereof being properly secured, the lid or head *a* is placed in position on the can A, and immediately sealed. The cans are then subjected to a steam bath or placed in kettles containing boiling water, and boiled for two hours at the highest temperature attainable, and which completes the process.

What we claim as new, and desire to secure by Letters Patent, is—

thoroughly dripped *and* in a moist condition, *and without the addition of any salted or otherwise prepared liquid*, they are placed in the sack B, the same having been previously arranged in the can A. So soon as the sack is filled, the mouth thereof being properly secured, the lid or head *a* is placed in position on the can A and immediately sealed. The cans are then subjected to a steam bath, or placed in kettles containing boiling water, and boiled for two hours at the highest temperature attainable, and which completes the process.

In the accompanying drawings is illustrated, at Figure 1, a metallic can, such as is ordinarily used for articles of food which are offered to the trade in a canned state. Fig. 2 is *the* lining, which we propose usually to make in the form of a cylindrical bag or sack, the diameter of which, when filled, is to be such as will permit of its fitting snugly within the can. *Fig.* 3 *represents a circular mouth piece for said lining.*

A is the metallic can. *a* its lid or cover. B is the *lining*, constructed *preferably*, of cotton *or* muslin. Material of the cheapest and most inferior quality may be used, as the sole object of its use is to prevent the article to be preserved from coming in direct contact with the surface of the can, which contact with the metal in the case of the shrimp causes, *as before stated*, during the process of boiling, and all along thereafter until the can is opened, a profuse precipitation of a black substance generally believed to be sulphur, and which supposition is based upon the fact that the shrimp is said to possess a much larger proportion of sulphur than *any* other shell-fish.

b, Fig. 3, is a circular piece cut out of material similar to that of which the bag B is made, and

The herein described method of preserving shrimps, &c., preventing their discoloration, which consists in placing textile fabric between the can and its contents, and then sealing the can and subjecting the same to a boiling process, substantially as and for the purpose specified.

which is inserted within the mouth of the latter after the same is filled with the fish or other article to be preserved.

What we claim as new, and desire to secure by letters patent, is:

As an improvement in the art of preserving shrimps in metal cans, the mode of preventing the discoloration of the shrimps which consists in interposing between the metal can and the shrimps an enveloping material for the shrimps, which is not itself capable of discoloring the shrimps, and then sealing the can and subjecting the same and its contents to a boiling process, substantially as described.

The Defense of Want of Novelty.

It is contended that the invention lacks novelty—

1st. In view of the patent to George H. Chinnock, No. 156,693, dated November 10th, 1874.

2d. In view of the method of putting up guava jelly, guava paste and articles of like nature, that had been practiced for years before the patentee's invention.

3d. In view of the well-known process of canning fish, &c., by cooking in cans.

The Chinnock Patent.

The Chinnock patent will be found in the record, (pp. 48–50.) It is for an improvement in Packages for Jellies, Jams, &c., and, in the language of the specification, "comprises a "sealed paper package of jelly, jam, marmalade, mince meat "or similar sweet meats, made and constituted as an article "of manufacture and trade, hitherto unknown, and embrac-"ing the combination with an external shell of stiff paper "or paper board, of an internal paper bag provided for the "immediate reception of the jelly, jam, or marmalade, as the "case may be."

The mode of practicing the invention is stated to be as

no further toward meeting the whole invention than the bag of enveloping material by itself separately considered.

No citation of authorities is believed to be necessary to the point that a patent cannot thus be anticipated piecemeal, by showing that this and that element, considered separately, are old.

The Chinnock patent, the guava jelly package and the old process of canning above referred to, show the highest development of the art of canning at the date of the patentees' invention, but, obviously, neither of them contained the patented improvement nor gave to the public nor to anybody, the key to the problem of how to successfully preserve shrimp in metal cans free from discoloration. The value of shrimps as an article of food had long been known, but their consumption was limited mostly to places at the sea board or in close communication therewith.

The old process of canning had been tried but had proven a failure because of the discoloration of the goods. The patentees, themselves, realizing the value of success in this direction had for years been trying to devise some solution of the difficulty. They had put up shrimps in metal cans, yet while their goods as an article of food were entirely wholesome, the discoloration resulting from contact with the metal rendered them unmerchantable and unsalable.

The Invention not Obvious.

The invention when disclosed is so simple and involves so little expense in its practice that it does not, of course, escape the criticism by defendants of being *obvious*. In passing we may say, that there never has been a meritorious, simple invention that has not been subjected to like criticism.

That the improvement of the patentees *did* involve invention is evidenced—

1. By the fact that, with the value of an efficient mode of preserving shrimps in metal cans without discoloration fully appreciated, and with full knowledge of the prior state of

the art, the patentees themselves, as well as others, were not able until after years of experimentation with various processes and methods to hit upon the patented idea and achieve success. And even after a conception of the invention, further experimentation and actual trial were necessary in order to demonstrate the practicability of the plan.

2. By the extreme utility of the invention as illustrated by the favor with which the goods put up in accordance with it have been received by the public and the great and continuous demand for the goods since 1876.

3. By the large business already done by defendants in practicing the patented process, their own statements showing them to have sold in fourteen months between four and five thousand cases of canned shrimp (Record, p. 101) put up in accordance with said process.

4. By the fact that the invention has been twice passed upon by the Patent Office and its novelty and patentability affirmed.

5. And by the affirmative adjudication of the court below.

We submit that under the authorities invention is sufficiently established:

Smith *v.* Goodyear Dental Vulcanite Co., 93 U. S., 486,

Loom Company *v.* Higgins, 105 U. S., 591.

Eppinger *v.* Richey, 14 Blatch.

The Defense of Invalidity of the Reissue.

Since the date of the reissue in this case the law of reissues has undergone a considerable change, and what would have then been regarded a good reissue would not necessarily be so regarded now.

Scarce any thinking man can be found who does not believe the privilege of reissue has in the past been much abused, and who does not regard with favor the present attitude of this Court upon the subject; but, on the other hand, all agree that the wind should be tempered to the

shorn lamb, that those who relied upon the old decisions—the old land marks—of this Court and the practice under them, and who, with full confidence, reissued their patents in view of the same, should now at the day of judgment, be treated with tenderness and mercy, and their patents sustained if possible.

This Court in recent cases has declared in effect:

1. That no claim can be sustained in a reissue which is broader than the claim or claims of the original *unless the reissue be applied for promptly:*

Torrent & Ames Lumber Co. *v.* Rodgers, 112 U. S., 659.
Coon *v.* Wilson, 5 S. C. R., 537.
Miller *v.* Brass Co., 104 U. S., 350.
Mahn *v.* Harwood, 112 U. S., 354.
McMurray *v.* Mallory, 4 S. C. R., 375.
Gage *v.* Herring, 2 S. C. R., 819.
Moffitt *v.* Rogers, 1 S. C. R., 70.

2. That no claim in a reissue can be valid which is for a different invention from that *claimed* in the original.

Coon *v.* Wilson, 5 S. C. R., 537.
Eachus *v.* Broomall, 6 S. C. R., 229.
Turner & Seymour M'f'g Co. *v.* Dover Stamping Co., 4 S. C. R., 401.
Clements *v.* Odorless Excavating App's Co., 3 S. C. R., 525.
Wing *v.* Anthony, 1 S. C. R., 93.

3. That a claim made in an original patent and repeated in a reissue is valid.

McMurray *v.* Mallory, 4 S. C. R., 375.
Gage *v.* Herring, 2 S. C. R., 819.

4. That the claim of a reissue will be so construed as, if possible, to cover no more than the claim of the original.

M'f'g Co. *v.* Ladd, 102 U. S., 408.

See also—

Brainard *v.* Cramme, 12 Fed. Rep., 623.

Examined critically in the light of these declarations as to what the law is, we think the reissue in suit will be found clearly valid.

Comparison of Reissue with Original.

We have seen that the statement of the object of the invention is in the same words in both instruments. It is as follows:

"The object of our present invention is to provide an improved method of preserving shrimps or prawns, and indeed all kinds of shell fish, preventing their discoloration and insuring the retention of their original freshness and flavor."

From this we learn that it is to provide "an improved "method" and not an improved can nor an improved lining, that is the object of the invention, and the new result designed to be accomplished is the preservation of the shrimps with their original freshness and flavor and without discoloration.

In the original after this statement of the object of the invention comes the following:

"Primarily, our improvement consists in so placing a suitable textile fabric between the fish or other article of food to be preserved as to cause it to so intervene as to prevent, under all circumstances, any direct contact between the metallic surface of the can and its contents; and *it is the employment of such textile fabric in connection with the process hereinafter described of treating the fish or other article, both before and after the same is placed in the can and sealed, which constitutes the nature or subject matter of our present invention.*"

The italics are ours.

Then follows a description of the can and its lining and

finally a statement of the process of canning the shrimps from the picking of them to the cooking in the cans.

Concerning the can, it is stated to be of metal.

As to the bag, it is described as being "constructed of "cotton, muslin or any other suitable textile fabric." Furthermore that "material of the cheapest and most in- "ferior quality may be used, *as the sole object of its use is to* "*prevent the article to be preserved from coming in direct contact* "*with the surface of the can.*"

The paragraph last above quoted is of vital importance. While it does not expressly state that any other material than textile fabric might be used, it plainly shows us that the *sole object of the use* of the lining is to prevent actual contact of the shrimps with the metal, and conveys to the mind at once the impression that any other material which would perform this office would answer as well and fall within the invention.

That the patentees by mentioning textile fabric were merely describing *one* means for carrying out their invention is further evident from a subsequent statement that "such a can and lining as herein described are admirably "*adapted for the purpose attained by our present invention;* but, "as before stated, there is *nothing arbitrary about* the peculiar "form or construction of the textile fabric lining, *as other* "*forms and arrangements might be substituted therefor without in* "*any manner altering the principle of our invention.*"

"*Other arrangements might be substituted therefor,*" (i. e., the textile lining,) is very broad language, and it is by no means a strained construction to hold it to mean that other material than textile fabric might be employed, especially as the patentees were so careful in the earlier parts of the specification to make the before quoted statement with reference to the lining, that the "sole object of its use is to "prevent the article, &c., from coming in direct contact with "the surface of the can." Again, in the clause "such a "can and lining are admirably adapted for the purpose "attained by our present invention," neither the can, nor

the lining, nor both, are referred to as constituting *the invention*, but only as a means of carrying the invention into practice.

In the description of the process employed in practical canning, with which the specification of the original concludes, the shrimps are described as being thoroughly dripped "before being placed in the lined cans," and that when so placed in the lined cans it is done "without the addition of any salted or otherwise prepared liquid." The importance of observing this step in the process is apparent, since the presence of free liquid within the can would in a measure defeat the object of the invention as it would supply a vehicle or medium for diffusing the dark precipitate throughout the entire mass of the shrimps, and all portions would therefore be discolored.

So much for the specification of the original.

In the reissue, after the paragraph relating to the object of the invention, copied verbatim from the original, occurs the following statement:

"In canning the shrimps or prawns, we have found that direct contact of the shrimps with the can, and the presence of free liquid or gravy in the shrimps, after they are placed in the can, are very objectionable for the following reasons:

"First. The direct contact of the shrimps with the can causes, during the process of cooking and thereafter, a precipitation of black or dark matter, which discolors the shrimps and detracts from their flavor and richness. This precipitation is believed to be caused by the action of sulphur contained in the shrimps on the metal of the can.

"Second. Free liquid or gravy in the shrimps constitutes a vehicle or medium to diffuse the dark precipitate or coloring matter throughout the entire mass of shrimps in the can, so that all portions of the contents of the can are equally affected and discolored.

"Our invention has for its object to obviate the above-named objections; and it consists in first providing the can with a lining, to prevent direct contact of the shrimps with the metal; and, second, placing the shrimps in the lined can while they are in a dry or moist condition and devoid of

finally a statement of the process of canning the shrimps from the picking of them to the cooking in the cans.

Concerning the can, it is stated to be of metal.

As to the bag, it is described as being "constructed of "cotton, muslin or any other suitable textile fabric." Furthermore that "material of the cheapest and most in- "ferior quality may be used, *as the sole object of its use is to* "*prevent the article to be preserved from coming in direct contact* "*with the surface of the can.*"

The paragraph last above quoted is of vital importance. While it does not expressly state that any other material than textile fabric might be used, it plainly shows us that the *sole object of the use* of the lining is to prevent actual contact of the shrimps with the metal, and conveys to the mind at once the impression that any other material which would perform this office would answer as well and fall within the invention.

That the patentees by mentioning textile fabric were merely describing *one* means for carrying out their invention is further evident from a subsequent statement that "such a can and lining as herein described are admirably "*adapted for the purpose attained by our present invention;* but, "as before stated, there is *nothing arbitrary about* the peculiar "form or construction of the textile fabric lining, *as other* "*forms and arrangements might be substituted therefor without in* "*any manner altering the principle of our invention.*"

"*Other arrangements might be substituted therefor,*" (i. e., the textile lining,) is very broad language, and it is by no means a strained construction to hold it to mean that other material than textile fabric might be employed, especially as the patentees were so careful in the earlier parts of the specification to make the before quoted statement with reference to the lining, that the "sole object of its use is to "prevent the article, &c., from coming in direct contact with "the surface of the can." Again, in the clause "such a "can and lining are admirably adapted for the purpose "attained by our present invention," neither the can, nor

the lining, nor both, are referred to as constituting *the invention*, but only as a means of carrying the invention into practice.

In the description of the process employed in practical canning, with which the specification of the original concludes, the shrimps are described as being thoroughly dripped "before being placed in the lined cans," and that when so placed in the lined cans it is done "without the addition of any salted or otherwise prepared liquid." The importance of observing this step in the process is apparent, since the presence of free liquid within the can would in a measure defeat the object of the invention as it would supply a vehicle or medium for diffusing the dark precipitate throughout the entire mass of the shrimps, and all portions would therefore be discolored.

So much for the specification of the original.

In the reissue, after the paragraph relating to the object of the invention, copied verbatim from the original, occurs the following statement:

"In canning the shrimps or prawns, we have found that direct contact of the shrimps with the can, and the presence of free liquid or gravy in the shrimps, after they are placed in the can, are very objectionable for the following reasons:

"First. The direct contact of the shrimps with the can causes, during the process of cooking and thereafter, a precipitation of black or dark matter, which discolors the shrimps and detracts from their flavor and richness. This precipitation is believed to be caused by the action of sulphur contained in the shrimps on the metal of the can.

"Second. Free liquid or gravy in the shrimps constitutes a vehicle or medium to diffuse the dark precipitate or coloring matter throughout the entire mass of shrimps in the can, so that all portions of the contents of the can are equally affected and discolored.

"Our invention has for its object to obviate the above-named objections; and it consists in first providing the can with a lining, to prevent direct contact of the shrimps with the metal; and, second, placing the shrimps in the lined can while they are in a dry or moist condition and devoid of

free liquid or gravy, sealing the can without adding any liquid to its contents, and cooking the contents of the can after sealing, all of which we will now proceed to describe."

This statement, as will be seen, contains no new substantive matter. It is clearer and more pointed, perhaps, than any statement in the original, but there is nothing in it unauthorized. Two points are brought out prominently, namely, first, the necessity of preventing the direct contact of the shrimps with the metal by the intervention of the lining; and secondly, the necessity of having no free liquid or gravy in the cans, by which indirectly the shrimps may be brought into contact with the metal.

The first of these points is fully elaborated in the original, but the second not so much so, the only reference to it being contained in the statement with reference to the details of the process wherein the shrimps are described as being placed in the sack previously arranged in the can, "without the addition of any salted or otherwise prepared liquid."

We think it cannot be doubted that the patentees were entirely justified in curing the "insufficiency" of their original specification in this respect. They added nothing new, but merely brought into merited prominence a feature of their invention, which, while not entirely overlooked in the original, was not given by the draughtsman of the specification due importance.

After the statement above criticised, the specification of the reissue proceeds to the end in almost the exact words of the original, the portions omitted being found transferred in substance to other parts of the specification. We deem it only necessary to refer specifically to the slight change in the description of the lining where first mentioned.

The original says, "B is the bag or sack, constructed of cotton, muslin, or any other suitable textile fabric," while the reissue says, "B is the lining, constructed *preferably* of cotton or muslin."

So far as the use of the term "lining" for "bag or sack"

is concerned, warrant is found in the original, where these terms are applied indifferently to the same thing.

The elimination of the words "textile fabric," and the use of the word "preferably" in the reissue, is susceptible of satisfactory explanation. The reissue says, "B is the lining, preferably of cotton or muslin." Assume for a moment that that when the word "lining" was used, a lining of textile fabric was intended, would the use of "preferably" then have been warranted? Certainly, for the original says "cotton, muslin, or any other textile fabric." *Other* textile fabrics than cotton or muslin were unquestionably in the contemplation of the patentees, and that they *preferred* cotton or muslin is apparent, since they are the materials specifically described and illustrated in both original and reissue. That when the word "lining" was used at the place mentioned it was intended to mean a lining of textile fabric, is clearly shown by a statement occurring later in the reissue, and copied verbatim from the original, which reads as follows:

"Such a can and lining as herein described are admirably adapted for the purpose attained by our present invention; but, as before stated, there is nothing arbitrary about the peculiar form and construction of *the textile-fabric lining*, as other forms and arrangements might be substituted therefor without in any manner altering the principle of the invention."

Now, the only lining "herein (therein) described," or rather the only description of a lining which precedes the above quoted statement, is referred to in the clause under discussion, that is to say, "B is the lining constructed pre-
"ferably of cotton or muslin." The textile fabric lining was therefore the lining B.

We have perhaps given more importance to this clause of the reissue than it deserves, but it seemed to us necessary, in order to meet the probable criticism on the part of the defendants, that the reissue was so explicitly broader than

the original as to be incapable of being considered to be for the same invention.

We come now to a comparison of the claims.

The claim of the original is as follows:

"The herein described method of preserving shrimps, &c., preventing their discoloration, which consists in placing textile fabric between the can and its contents, and then sealing the can and subjecting the same to a boiling process, substantially as and for the purpose specified."

That of the reissue as follows:

"As an improvement in the art of preserving shrimps in metal cans, the mode of preventing the discoloration of the shrimps, which consists in interposing between the metal can and the shrimps an enveloping material for the shrimps, which is not itself capable of discoloring the shrimps, and then sealing the can and subjecting the same and its contents to a boiling process, substantially as described."

Both are for a mode or method of preserving shrimps whereby discoloration of the shrimps is prevented.

The claim of the original on its face without reference to its accompanying specification is, in one sense, broader than the reissue, and the claim of the reissue is likewise, on its face and without reference to its specification, broader than the original, yet both claims, when considered with reference to their respective specifications are of equal scope and for the same invention.

The claim of the original is broader on its face than that of the reissue in this, that while in the reissue, the application of the improvement is limited to "*metal cans*" *alone*, in the claim of the original the larger and comprehensive term "can" is used, without reference to the material of which the can is composed.

On the other hand, the claim of the reissue is, on its face, broader than that of the original, in this, that while the original claims "placing textile fabric between the can and

" its contents," the reissued claims " interposing between the " metal can and the shrimps an enveloping material for the " shrimps which is not itself capable of discoloring the " shrimps."

Both claims, however, refer back by the words "substan- " tially as described" or their equivalent, to their respective specifications, and must be construed in the light of the same—as this Court has decided.

" When a claim immediately follows a description of an invention, it may be construed in connection with the explanations contained in the specification and when it contains words referring to the specification, it cannot properly be construed in any other way."

Seymour *v.* Osborne, 11 Wall., 516.
Curtis on Patents, Secs. 225, 227.

Applying this rule to the claims in hand, there is no difficulty whatever in ascertaining their scope.

The broad term " can," employed in the original claim, we find must be construed to mean metal can, else the whole object of the invention which is to prevent discoloration of the shrimps by the *metal of the cans* is defeated.

From this illustration furnished by the original patent itself, we see that the rule of construction is a rule of law, because it is a rule of common sense. A claim is simply the epitome of the specification, and unless reference could be made back to the latter for explanation, it would nearly always be meaningless.

Take, for instance, the claim of the Cummings patent, sustained by this Court in Smith *v.* Goodyear Dental Vulcanite Co., 93 U. S., 486, and in Goodyear Dental Vulcanite Co. *v.* Davis, 102 U. S., 222, which reads as follows:

" The plate of hard rubber or vulcanite or its equivalent, for holding artificial teeth, or teeth and gums, substantially as described."

In the first named case the Court said:

"If then, the claim be read as it should be, in connection with the preceding part of the specification, and construed in the light of the explanation which that gives, the invention claimed and patented is 'a set of artificial teeth as a new article of manufacture, consisting of a plate of hard rubber, with teeth or teeth and gums secured thereto in the manner described in the specification, by embedding the teeth and pins in a vulcanizable compound, so that it shall surround them while in a soft state, before it is vulcanized, and so that when it has been vulcanized, the teeth are firmly and inseparably secured in the vulcanite and a tight joint is effected between them, the whole constituting but one piece.'"

Here the Court had to draw largely upon the specification in the interpretation of the claim, much more so than is required in the present case.

Now, applying the rule we have been considering to the claim of the reissue in suit, what do we find it to cover?

If it is broader than the original, it is bad. If it covers what the original did not cover, it is bad.

Let us examine it:

It purports to be for "An Improvement in the Art of Preserving Shrimps in Metal Cans." This is exactly what we have found by construction that the original claim was for. So far, in substance, it corresponds to the original, though, as we have seen, as to mere phraseology, it is narrower, being in terms limited to *metal* cans.

Then it goes on to state that the improvement is "the "mode of preventing the discoloration of the shrimps, which "consists in interposing between the metal can and the "shrimps an enveloping material for the shrimps, which is "not itself capable of discoloring the shrimps."

Here an enveloping material is spoken of, but the only idea we get of it from the claim is in the statement of the purpose of its employment and its quality of imparting no color to the shrimps. But it is idle to speculate what the patentees had in mind by the use of such language, for we are, by the words "substantially as described," referred back

to the specification for fuller information, and going there, we find that the enveloping material mentioned in the claim is cotton or muslin, made up into a bag and placed within the metal can, so as to intervene between the can and the shrimps when the latter are placed in the former. And, further, we find that "material of the cheapest and most "inferior quality may b used, as the *sole object of its use* is to "prevent the article to be preserved from coming in direct "contact with the metal." Also that "other forms and "arrangements might be substituted" for the described bags "without in any manner altering the principle of the "invention."

Comparing this part of the claim, thus construed by the specification, with the original claim we find, as before, different phraseology but substantial identity.

As to the remainder of the reissued claim it is exactly the same as the original claim, except that for the words "sub- "stantially as and for the purpose specified," of the latter, the words "substantially as described" are substituted.

Thus it will be seen the reissue, properly construed, follows the original, substantially repeats its claim and covers nothing more than the original covered.

The court below held that the difference between the claim of the original and the claim of the reissue was only "that "of substituting for the description of a thing by naming it "with the addition of its essential quality, the description of "the thing by naming its qualities."

Suppose the claim of the original had, like the claim of the reisue, used the words "enveloping material" instead of "textile fabric," and textile fabric had been the only material specifically mentioned in the specification, would not this Court promptly have held as an infringer one who used the entire process, only substituting paper for textile fabric? Would it not have regarded paper as the equivalent of textile fabric? How, then, is the case made different where, with the same specification, textile fabric is not only described but claimed? Will this Court not hold paper to be

still an equivalent of the textile fabric? Is the rule not once an equivalent always an equivalent? And does it make any difference that the claim to be construed is in a reissue? It would indeed be a novelty for this Court to hold that the doctrine of equivalents could be invoked only in the case of infringement of original patents and not in the case of reissued patents.

The Infringement.

Exactly what the defendants do is described in their answer, (Record, p. 61.) We quote the statement:

"The common tin cans being ready for packing, three pieces of paper, previously boiled in paraffine wax or coated with same, are cut and placed in the can, so that one piece covers the bottom, another piece the sides, and a third piece the top of the contents when the can is filled; the shrimps are then picked raw, then washed and thoroughly cooked for about twenty minutes, until fit to eat; they are then placed in the cans, which are soldered, and then put into a steam retort, without water, which is heated to 240° Fahrenheit, where they remain from two and a half to three hours, which process has the effect of condensing the air and liquids in the can, and exterminating any animal or vegetable life that may remain in the contents of the can, after which they are ready to be labeled and sold."

From this description two things are clearly apparent: First, that defendants have appropriated boldly the gist and principle of the patentees' invention, as claimed in both the original and reissued patents; and, secondly, that they *have not been* practicing the patented invention of Pecor & Bartlett, under which they claim to be operating. More on the latter point presently.

They use ordinary metal cans; they employ a lining to prevent contact of the shrimps with the metal; they pick and preliminarily cook and otherwise prepare the shrimps in substantially the same way as the Dunbars do before placing them in the lined cans; then place them in the cans

without liquid or gravy, seal the can, and subject the same and its contents to a cooking process, in which substantially the same temperature is maintained.

They contend, however, that by the use of paper instead of textile fabric for preventing the contact of the shrimps with the metal of the can, they evade the process claimed by the patentees and avoid the charge of infringement.

The Doctrine of Equivalents.

To meet this defense we invoke the doctrine of equivalents.

This Court has decided that two things are equivalents when they perform the same function in substantially the same manner:

Machine Co. *vs.* Murphy, 97 U. S., 125.
Mason *vs.* Graham, 23 Wall., 275.
Clough *vs.* Manufacturing Co., 106 U. S.
Water Meter Co. *vs.* Desper, 101 U. S., 332.
Rowell *vs.* Landrey, 113 U. S., 97.

There can be no question about the equivalency of paper and textile fabric in practicing the patentees process. The court below expressed no doubt about it.

The patentees have stated in their patent respecting the lining material that " the sole object of its use is to prevent " the article to be preserved from coming in direct contact " with the surface of the (metal) cans." The paper prevents this contact just as the textile fabric does, and performs no other function. It does the same thing in the same way, and is, therefore, an equivalent.

It was not necessary for the patentee to claim equivalents in his claim, (Dental Vulcanite Co. *vs.* Davis, 102 U. S., 229, Tilghman *vs.* Proctor, 102 U. S., 730,) nor to describe them in his specification, (Union Metallic Cartridge Co. *vs.* U. S. Cartridge Co., 2 Bann & Ard, 594.) He was equally protected in the use of equivalents whether he omitted to do either or both of these things.

When the patentees had solved the problem of how to prevent the discoloration of the shrimps, and by trying textile fabric had made a full reduction of their invention to practice, it required only the most ordinary discernment to see that any other well known material which itself would not discolor the shrimps might be used as a substitute for the textile fabric. There was no invention involved in the change. It was a case of mere *substitution.*

The defendants selected paper, an old material, well known in the arts as a substitute for textile fabric. They might with equal propriety have selected raw hide, parchment, the larger intestines of animals, hard rubber, vulcanite, asbestos, vulcanized fibre, celluloid, or any one of a dozen other materials ready at hand.

They were determined to can shrimps by the approved way. They doubtless said to themselves here is a new and valuable invention out of which has grown an immense and profitable business. How can we reap some of the advantages?

The patentees are operating under a patent and have an established trade. It will not do for us to go before the public with the same identical goods. We must have something seemingly different. We must have, at least, a "talking "difference," or we can make no sales. We realize that the use of something to keep the shrimps from the metal is the secret of the process, and paper will do as well as anything else. So paper was adopted. They knew it would work. No experiments were necessary to determine this. If textile fabric would do, so would paper.

They had a color of right to use paper too, for had not Chinnock in his air and water tight paper package of sweet meats used paper, and was not paper used as a lining for the wooden boxes used time out of mind to contain guava jelly, guava paste, and the like? Given the idea of how to accomplish the desired result, any number of practical equivalents at once suggested themselves.

But the selection of paper as a lining material was not all

they needed. The Dunbars had a patent, and would threaten their customers and ruin their trade. They must have a patent too. They accordingly bought the Pecor & Bartlett patent. This patent was for the alleged invention of two men of Galveston, Tex., the one a grocer and cotton factor, the other a photographer, who had, in 1878–'9, by examination of the Dunbars' canned shrimps, conceived of so-called improvements upon the means employed by them in putting them up, and had obtained a patent for the same, April 6th, 1880, No. 226,347. (Record p. 51.)

They never put up a can of shrimps in accordance with this patent, but only used it to give them, in the eyes of the public, a color of right.

They were now, seemingly, ready for business, but yet did not dare to begin till they had secured the services of William Wallace, (record p. 31–3), the foreman of the Dunbars canning establishment, by offering him the same wages he was then getting at the Dunbars with the promise of an increase at the end of three months, and of a still further increase at the end of six months—(record p. 33). Wallace was skilled in the art of canning under the Dunbars' patented process, and was, doubtless, of great service in making their efforts successful.

Could a more deliberate and systematically planned attempt to appropriate another's invention be conceived of?

The Use of Paper a Mere Substitution and Not an Invention.

But let us examine a little further this question of equivalency.

Defendants contend that the use of paper in the process of canning shrimps is not the use of an equivalent for textile fabric.

1. Because paper is better and cheaper than textile fabric and—

2. Because the discovery that paper could be so used amounted to a separate invention and the Patent Office by the grant of the Pecor & Bartlett patent had so held.

1. The testimony as to the relative merits of paper and textile fabric in preventing the discoloration of the shrimps by the metal is, as might be expected, conflicting. The defendants contend that paper is better, and the complainants, with equal warmth, assert the contrary. A dissection of the testimony on this point would not be profitable since it is agreed by all, that both complainants and defendants put up merchantable and salable goods, and that, while in some instances there is a slight discoloration in the goods of each, it is the rare exception and not the rule, and results either from carelessness in applying the lining material or in attending to some other detail of the process.

But, even if it be admitted, for the sake of argument, that the paper is a better and cheaper material for the purpose, its use would still not amount to independent invention and it would nevertheless be an infringement.

The following extract from the opinion of Mr. Justice Nelson in the case of Hotchkins *v.* Greenwood, 11 How., 248, is apposite:

"Now, it may very well be that by connecting the clay or porcelain knob with the metallic shank in this well known mode, an article is produced *better and cheaper* than in the case of a metallic or wood knob, but this does not result from any new mechanical device or contrivance, but from the fact that the material of which the knob is composed happens to be better adapted to the purpose for which it is made. The improvement consists in the superiority of the material, and which is not new, over that previously employed in making the knob. But this of itself can never be the subject of a patent. No one will pretend that a machine made, in whole or part of materials better adapted to the purpose for which it is used than the materials of which the old one is constructed, and for that reason *better and cheaper*, can be distinguished from the old one, or, in the sense of the patent law, can entitle a manufacturer to a patent.

"The difference is formal, and destitute of ingenuity or invention. It may afford evidence of judgment and skill in the selection and adaptation of the material in the manufac-

ture of the instrument for the purpose intended, but nothing more."

See also the comments of Mr. Justice Bradley in the Wagon Reach case, (Hicks *v.* Kelsey, 18 Wall., 670.)

2. The defendants, in their answer, say with reference to the Pecor & Bartlett patent, (Record, p. 62):

"That in the schedule of specifications annexed to the application for said patent, and which is made part of said letters patent, the following declaration is made, showing that the attention of the proper officers of the Patent Office was primarily called to the patent of the complainants when the patent of the said Pecor was applied for: 'heretofore it has been the practice in canning shrimps and like shell fish to enclose the fish in a bag of some textile fabric, to place the bag containing the fish within an ordinary tin can, and then to subject the can and its contents to the ordinary boiling and mode of treatment, such as is ordinarily used in canning vegetables and animal substances,' and the said invention of Pecor & Bartlett is then described to be, instead of the ordinary bag of textile material which has heretofore been used to enclose the shrimps, we have found that a *cheaper and better* substitute may be made from paper, which we prepare and apply in the following manner; and then follows a description of the use of the paper just as these defendants use it, and as hereinbefore set forth, and said specification goes on to say 'that the subsequent treatment is in accordance with the well-known practice in canning vegetables and animal substances, this paper lining being much more cheaply and expeditiously applied than the cloth bags heretofore used, as no sewing is required,' whereupon said inventors, Pecor & Bartlett, made the following claim, which was allowed by said letters patent: 'An interior paper lining prepared with paraffine as and for the purpose set forth.'"

Now, this statement was evidently put into the answer for the purpose of conveying to the court the impression that Pecor & Bartlett had asked for and obtained a claim to "An "interior paper lining prepared with paraffine, as and for

" the purpose set forth," notwithstanding the prior patent to the Dunbars, in which a textile lining for cans was described, and that the granting of such claim was evidence that the Patent Office regarded the paper lining as an independent invention not embraced in Dunbars' patent, and not the equivalent of the textile fabric; but the fact is that Pecor & Bartlett *never made nor obtained such a claim.*

The claims they did obtain are as follows:

" 1. In a flexible metallic can for shrimps and like fish, a coating of asphaltum cement covering the inner surface of the cans and adhering to the metal, as and for the purpose set forth.

" 2. In combination with the metallic can lined with asphaltum cement in the manner described, an interior paper lining prepared with paraffine, as and for the purpose set forth."

It will be observed that the paper lining alleged to have been separately secured by a broad claim in the patent thus turns out to be claimed only *in combination with an asphaltum lined metal can*, and that the whole patent, instead of hinging upon the paper lining, as the marked improvement, centers upon the asphaltum lined can.

In passing, we cannot refrain from observing that this incorrect and untrue statement in the answer must have been inserted either through ignorance of the nature of claims in letters patent for inventions, or else with the intention of deceiving the court. We would fain believe the former reason to be the true one, though the perpetuation of the error in the affidavits filed in opposing the motion for the preliminary injunction, and in the brief filed in this Court on the motion to modify the injunction under Rule 30 of the old rules, somewhat shakes our faith in its correctness.

The Defendants Did Not Begin to Infringe till after the Reissue was Granted.

The reissue upon which suit is brought was granted on the 6th day of December, 1881, (record, 11,) but the assign-

ment of the Pecor & Bartlett patent to defendants was not made till January 4th, 1882, and no canning was done by the latter until the 4th day of February, 1882. (Record, pp. 32, 38, 46.)

It will thus be seen that they commenced infringing *after* the reissue had been granted two months. They cannot, therefore, now consistently assume the position of innocent purchasers for value without notice, and in that character claim special indulgence.

The Process of Canning Practised by Defendants is not in any way covered by the Pecor & Bartlett patent, under ~~what~~ which they claim.

The defendants claim to be operating under and by virtue of the Pecor & Bartlett patent, and that while they practice the Pecor & Bartlett invention they do not practice the Dunbar invention. But the exact reverse of this is true. They do practice the Dunbar invention, with the colorable deviation of substituting paper for textile fabric as the lining material, and do not practice the Pecor & Bartlett invention at all, and, according to their answer, never have done so.

There are only two claims to the Pecor & Bartlett patent, one of them covering a metal can lined with a coating of asphaltum, and the other the combination with an asphaltum lined can of a paraffine paper lining. In both of these claims the asphaltum coating figures as an element, and inasmuch as defendants do not use asphaltum coated cans at all, but simply ordinary plain metal cans, it goes without saying that they do not proceed according to the Pecor & Bartlett patent, and, should a rival manufacturer spring up and use exactly what they use, the Pecor & Bartlett patent would not avail them to stop him.

More than this, by marking their goods in a manner to lead the public to suppose such goods, or the process of manufacturing them, is covered by said Pecor & Bartlett patent, they commit a fraud upon the public, and render

themselves liable to a criminal prosecution under the statute. (Sec. 4900 Rev. Stat.)

Recapitulation.

In conclusion we would reiterate:

1. That the invention is shown to be of great utility and value, and to have revolutionized the art of canning shrimps.

2. That there is nothing in the prior state of the art to suggest the invention.

3. That the reissue and the original patent are of equal scope and for the same invention.

4. That the defendants' process is an equivalent of that patented to complainants.

5. That the defendants not only infringe the reissue, but would also have infringed the original.

6. That defendants cannot assume the attitude of innocent purchasers having no knowledge of the patentees' claims, since they did not commence to infringe till sometime after the reissue was granted.

7. That defendants' position that they are operating under a patent covering the paper lining as an independent invention is untenable, in view of the fact that their patent covers no such thing, but is limited to asphaltum lined metal cans, which they do not use, and, so far as the record shows, never have used.

An affirmance of the decree below is asked.

Respectfully submitted.

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